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1 A

(Filed May 25, 1962)

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1688-62

HAZELTINE RESEARCH, INC., 5445 West Diversey Avenue  
Chicago 39, Illinois,

and

ROBERT REGIS, 193-15B, 69th Avenue Fresh Meadows,  
New York

*Plaintiffs,*

v.

DAVID L. LADD, Commissioner of Patents,  
Washington 25, D. C.

*Defendant.*

COMPLAINT TO OBTAIN LETTERS PATENT  
TO THE HONORABLE JUDGES OF THE UNITED  
STATES DISTRICT COURT FOR THE DISTRICT OF  
COLUMBIA

The plaintiffs herein for their complaint state:

JURISDICTION

1. This action is brought under the provisions of the Patent Act of July 19, 1952 (Public Law 593, 82nd Congress, 2d sess., ch. 950; 66 Stat. 792); and, more particularly, Section 145 of said Act (Title 35 U.S. Code, Section 145), and under the provisions of the Administrative Procedure Act as enacted June 11, 1949, as amended, and more particularly Section 9 of said Act (Title 5 U.S. Code, Section 1009).

## PARTIES

2. The plaintiff Hazeltine Research, Inc. is a corporation duly organized under the laws of the State of Illinois and has a principal place of business in Chicago, Illinois.

3. Plaintiff Robert Regis is a resident of the City of New York, County of Queens, and State of New York, is the applicant in patent application, Serial No. 704,770, filed in the United States Patent Office on December 28, 1957 and entitled "Microwave Switch", and is the original and first inventor of the invention disclosed and claimed in said application.

4. The defendant, David L. Ladd, is Commissioner of Patents of the United States, has his official residence in the District of Columbia, and this action is brought against him in his official capacity as Commissioner of Patents of the United States.

## GROUNDS OF COMPLAINT

5. Prior to December 23, 1957, plaintiff Robert Regis, invented new and useful improvements in microwave switches and on or about December 20, 1957, Robert Regis, the plaintiff herein, executed an application for letters patent for the said inventions made by him and entitled "Microwave Switch".

6. On or about December 20, 1957, plaintiff Robert Regis assigned, by instrument in writing, all right, title and interest in and to his said inventions and his said application for letters patent therefor executed on or about December 20, 1957, to the plaintiff, Hazeltine Research, Inc., which assignment has not been recorded in the assignment records of the United States Patent Office. The plaintiffs herein, hereby make profert of the original copy of said assignment.

7. On or about December 23, 1957, plaintiff, Robert Regis, duly made application in writing in the United States Patent Office for the grant of letters patent to him on his invention, which application was given Serial No. 704,770. Said application Serial No. 704,770 was thereafter duly prosecuted in accordance with the requirements of law and the rules of practice of the United States Patent Office.

8. Said application Serial No. 704,770 contains the claims to which plaintiffs believe themselves entitled, such claims being numbered 1, 2 and 3.

9. Said application Serial No. 704,770 was examined by the Primary Examiner in charge thereof and he on June 24, 1959 finally rejected claims 1, 2 and 3. On September 22, 1959, plaintiffs appealed to the Board of Appeals from the Primary Examiner's final rejection of claims 1, 2 and 3. On March 28, 1962, the Board of Appeals rendered a decision which affirmed the Primary Examiner's final rejection of claims 1, 2 and 3.

10. Plaintiffs allege that the decision of the Board of Appeals adjudging them not entitled to letters patent for the invention recited in claims 1, 2 and 3 was erroneous and contrary to law and the plaintiffs are dissatisfied with the aforesaid decision of the Patent Office Board of Appeals.

11. Plaintiffs further allege that no appeal has been taken by them to the United States Court of Customs and Patent Appeals from the refusal of the Commissioner of Patents to issue Letters Patent to plaintiffs.

12. Plaintiffs make profert of a certified copy of application for Letters Patent, Serial No. 704,770, and all proceedings and papers in the file thereof, together with certified copies of the patents forming the basis for the decision of the Board of Appeals refusing to allow said claims 1, 2 and 3 and issue Letters Patent on the in-

vention in such claims, said certified copies to be produced as and when this Honorable Court shall direct.

WHEREFORE, plaintiffs pray this Honorable Court:

1. To adjudge or decree that plaintiffs are entitled to receive Letters Patent on the invention claimed in claims 1, 2 and 3 of said application Serial No. 704,770, in due form of law as prescribed by the patent statutes.
2. For a judgment pursuant to Title 35, U.S. Code Section 145 (66 Stat. 792), authorizing the Commissioner of Patents to issue Letters Patent to plaintiffs on the invention claimed in claims 1, 2 and 3 of said application Serial No. 704,770, in due form of law and as prescribed by the statutes.
3. That plaintiffs have such other and further relief as the nature of this case may admit or require and as may be just and equitable.

Respectfully,

ROBERT REGIS

/s/ Edward B. Beale  
By: EDWARD B. BEALE  
BEALE AND JONES  
425 Thirteenth Street, N.W.  
Washington 4, D. C.  
Telephone NAtional 8-4304

*Of Counsel:*

EDWARD A. RUESTOW  
59-25 Little Neck Parkway  
Little Neck 62, New York

GEORGE R. JONES  
425 Thirteenth Street, N.W.  
Washington 4, D. C.

(Filed June 15, 1962)

\* \* \* \* \*  
ANSWER TO COMPLAINT

To the Honorable the Judges of the United States District Court for the District of Columbia

1. The defendant admits that this action is brought under the provisions of the Patent Act of July 19, 1952, (Public Law 593, 82nd Congress, 2d sess., ch. 950; 66 Stat. 792); and, more particularly, Section 145 of said Act (Title 35 U.S. Code, Section 145). Otherwise, however, the defendant denies the allegations of paragraph 1 of the complaint.
2. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 2 of the complaint.
3. The defendant admits that the plaintiff, Robert Regis, is a resident of the City of New York, County of Queens, and State of New York, and is the applicant in patent application, Serial No. 704,770, filed in the United States Patent Office on December 23, 1957, and entitled "Microwave Switch". Otherwise, however, the defendant denies the allegations of paragraph 3 of the complaint.
4. The defendant admits the allegations of paragraph 4 of the complaint.
5. The defendant admits that on December 20, 1957, Robert Regis, the plaintiff herein, executed an application for Letters Patent entitled "Microwave Switch". The defendant asserts that, otherwise, he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 5 of the complaint.
6. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 6 of the complaint.

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7. The defendant admits the allegations of paragraph 7 of the complaint.

8. The defendant admits that application, Serial No. 704,770, contains claims numbered 1, 2, and 3. Otherwise, however, the defendant denies the allegations of paragraph 8 of the complaint.

9. The defendant admits the allegations of paragraph 9 of the complaint.

10. The defendant denies the allegations of paragraph 10 of the complaint.

11, 12. The defendant admits the allegations of paragraph 11 and 12 of the complaint.

FURTHER ANSWERING, the defendant asserts that the plaintiffs are not entitled to a patent containing any of claims 1, 2, and 3 of the application involved in this civil action, for the reasons given and in view of the references cited in the Examiner's answer and the decision of the Board of Appeals in that application. Proffer hereby is made of copies of the said answer, decision and references.

Respectfully submitted,

/s/ C. W. Moore  
Solicitor, U. S. Patent Office  
Attorney for Defendant

June 14, 1962

I hereby certify that two copies of the foregoing ANSWER TO COMPLAINT were mailed today to Edward B. Beale, 425 Thirteenth St., N.W., Washington, D. C., attorney for the plaintiffs.

/s/ C. W. Moore  
Solicitor

## Plaintiff's Exhibit 1

\* \* \* \*

This is to certify that annexed hereto is a true copy from the records of the United States Patent Office of File Wrapper and Contents of the file identified above.

By authority of the  
**COMMISSIONER OF PATENTS**

/s/ **L. G. Lanham, Jr.**  
Certifying Officer

Date May 15, 1963

Serial No. (Series of 1948)—704770

Assistant examiner—Roe

Class—333

Subclass—81

Division No.—65

Filed complete (Date)—Dec. 23, 1957

Serial No. 704 770

Applicant(s)—Regis, Robert of Fresh Meadows, N.Y.

Title of invention—Microwave Switch

Principal attorney(s)—Laurence B. Dodds

Associate attorney(s)—Edward A. Ruestow, Andrew L.  
Ney

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HAZELTINE RESEARCH CORPORATION  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

December 20, 1957

Re: Docket 2533

Honorable Commissioner of Patents,  
Washington 25, D. C.

Sir:

I enclose, for filing, an application of ROBERT REGIS for improvements in MICROWAVE SWITCH. The application papers comprise a specification, claims, Oath, Power of Attorney, and Petition, and one (1) sheet of drawing, and were executed December 20, 1957.

Enclosed also is check No. 1601, for Thirty Dollars (\$30.00), to cover the filing fee.

Respectfully,

/s/ L. B. Dodds  
Attorney for Applicant.

sk  
Encs.

\* \* \* \* \*  
**SPECIFICATION****TO ALL WHOM IT MAY CONCERN:**

**BE IT KNOWN** that I, ROBERT REGIS, a citizen of the United States, residing at Fresh Meadows, in the county of Queens, State of New York, have invented certain new and useful improvements in

**MICROWAVE SWITCH**

of which the following is a specification:

This invention relates to microwave switches and, more particularly, to such switches of the type which selectively isolates a microwave source from its load.

For some applications, it is desired to isolate a microwave transmitter from its antenna load while maintaining an impedance match to the transmitter. Thus, the transmitter may be maintained continuously operative and may instantaneously radiate energy by actuating the switch without a delay due to a warm-up period.

It is an object of the invention to provide a microwave switch of the type described of simplified construction and suitable selectively to isolate a microwave transmitter from its load antenna while maintaining an approximate impedance match to the transmitter.

In accordance with a particular form of the invention, a microwave switch for selectively isolating a microwave source from its load comprises a microwave signal guide for connection to a microwave source at one end and to a load at the other end. The switch includes an attenuator vane of resistive material having a tapered end extending toward the source and having a high conductance strip at the other end thereof and displaceable in and out of

the guide for selectively isolating the source from its load when in the guide while maintaining an approximate impedance match to the source.

For a better understanding of the present invention, together with other and further objects thereof, reference is had to the following description taken in connection with the accompanying drawing, and its scope will be pointed out in the appended claims.

Referring to the drawing:

Fig. 1 represents one view of a microwave switch constructed in accordance with the invention, and

Fig. 2 represents another view of a switch constructed in accordance with the invention.

Referring now more particularly to Fig. 1 of the drawing, a microwave transmitter 10 of conventional construction is coupled to a microwave signal guide 11 of conventional construction having a microwave antenna 12 also of conventional construction at the other end thereof. An attenuator vane 13 of resistive material and disposed in a slot in the guide will be described with reference to Fig. 2. The vane has a tapered end 14 extending toward the transmitter 10 and has a highly conductive or shorting strip 15 of suitable material at the other end thereof. The vane is displaceable in and out of the guide 11 in the plane of maximum electric field intensity for providing an effective short circuit across the guide by means of strip 15 for selectively isolating the transmitter from its load antenna when in the guide while maintaining an approximate impedance match to the transmitter.

A suitable control device 16 may be employed to displace the vane 13 in and out of the guide 11 or, for some applications, the vane may be manually displaceable.

When the vane is out of the guide, the transmitter is coupled to the load antenna in a conventional manner.

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When the vane is in the guide, as represented in Fig. 2, the resistive material of the vane absorbs energy from the transmitter while its tapered configuration causes a gradual change of impedance along the guide and thus maintains an approximate impedance match to the transmitter to minimize reflections back to the transmitter which would disrupt its operation. Thus, energy at an attenuated level reaches the shorting strip 15 where it is reflected toward the transmitter and is still further attenuated while passing the vane.

It has been found that an over-all attenuation in the order of 30 to 80 decibels may be provided by means of a vane 4½ inches long at a broad band of frequencies of the order of 8,200 to 9,600 megacycles. In providing the effective short circuit across the guide, the shorting strip 15 may or may not touch the walls of the wave guide as desired.

From the foregoing description it will be seen that a microwave switch constructed in accordance with the invention has the advantages of being of simple construction and being capable of isolating the transmitter from its load antenna while maintaining an approximate impedance match to the transmitter.

While there has been described what is at present considered to be the preferred embodiment of this invention, it will be obvious to those skilled in the art that various changes and modifications may be made therein without departing from the invention, and it is, therefore, aimed to cover all such changes and modifications as fall within the true spirit and scope of the invention.

### WHAT IS CLAIMED IS:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of

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resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

2. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a shorting strip at the other end thereof and displaceable in and out of said guide in the plane of maximum electric field intensity for providing an effective short circuit across said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

3. A microwave switch for selectively isolating a microwave transmitter from its antenna load comprising: a microwave signal guide for connection to a microwave transmitter at one end and to an antenna load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said transmitter and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said transmitter from its load when in said guide while maintaining an approximate impedance match to said transmitter.

4. A microwave switch of the type specified and substantially as illustrated in the drawing and described in the specification with reference thereto.

Oath, Power of Attorney, and Petition

Being duly sworn, I, ROBERT REGIS depose and say that I am a citizen of the United States residing at Fresh Meadows, New York; that I have read the foregoing specification and claims and I verily believe I am the original, first, and sole inventor of the invention or discovery in MICROWAVE SWITCH described and claimed therein, that I do not know and do not believe that this invention was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that this invention or discovery has not been patented in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months before this application; and that no application for patent on this invention or discovery has been filed by me or my representatives or assigns in any country foreign to the United States, except as follows: No exceptions.

And I hereby appoint LAURENCE B. DODDS (Registration No. 12,982), whose address is 59-25 Little Neck Parkway, Little Neck 62, N.Y., my principal attorney with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith.

It is requested that all communications from the Patent Office in connection with the above-entitled application be addressed to LAURENCE B. DODDS at 59-25 Little Neck Parkway, Little Neck 62, N. Y.

Wherefore I pray that Letters Patent be granted to me for the invention or discovery described and claimed in the foregoing specification and claims, and I hereby subscribe my name to the foregoing specification and claims, oath, power of attorney, and this petition, this 20th day of December, 1957.

Inventor: /s/ Robert Regis

Post Office Address: 193-15B 69th Avenue  
Fresh Meadows 62, New York

State of New York ) SS.  
County of Queens )

*Before me personally appeared ROBERT REGIS to me known to be the person described in the above application for patent, who signed the foregoing instrument in my presence, and made oath before me to the allegations set forth therein as being under oath, on the day and year aforesaid.*

/s/ Caroline B. Scott  
CAROLINE B. SCOTT  
Notary Public

SEAL

Notary Public State of New York  
No. 30-8887200  
Qualified in Nassau County  
Cert. Filed with Queens County Clerk  
Commission Expires March 30, 1968

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704770 DIV. 69

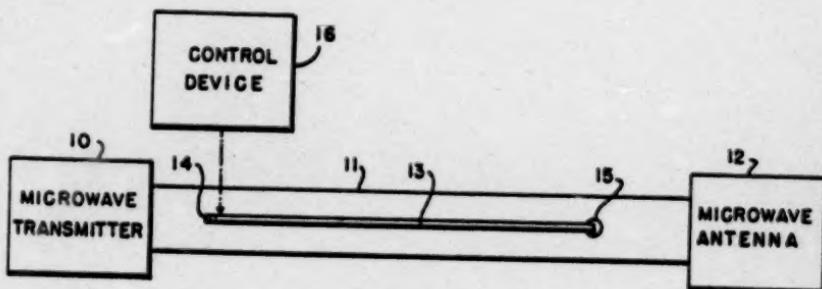


FIG.1

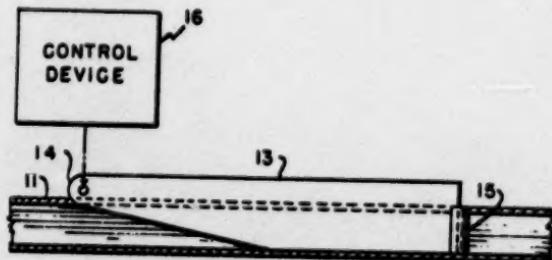


FIG.2

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IN THE UNITED STATES PATENT OFFICE  
Division 69

In re application of  
**ROBERT REGIS**  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

ASSOCIATE POWER OF ATTORNEY

Honorable Commissioner of Patents  
Washington 25, D. C.

Sir:

The undersigned attorney of record in the above-entitled application hereby appoints

**EDWARD A. RUESTOW**

(Registration No. 15,014), whose address is 59-25 Little Neck Parkway, Little Neck 62, New York, his associate attorney, with full power to prosecute said application, to make alterations and amendments in said application, to receive the patent, and to transact all business in the Patent Office connected therewith.

It is requested that all communications from the Patent Office in connection with the above-entitled application be addressed to **LAURENCE B. DODDS** at 59-25 Little Neck Parkway, Little Neck 62, New York.

Respectfully,

/s/ **L. B. Dodds**  
*Attorney for Applicant*

Little Neck, New York  
Dated: January 15, 1958

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U. S. DEPARTMENT OF COMMERCE  
PATENT OFFICE  
Washington

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

Paper No. 4

Applicant: Robert Regis  
Ser. No. 704,770  
Filed December 23, 1957  
For MICROWAVE SWITCH  
Mailed July 7, 1958—Pat. Div. 69

*Please find below a communication from the EXAMINER in charge of this application.*

/s/ Robert C. Watson  
*Commissioner of Patents.*

This application has been examined.

References applied:

Carlson 2,491,644 Dec. 20, 1949 333-81B

Bollinger, abstract of application Serial number 694,044  
published November 21, 1950 640 O.G. 1032. 333-988

Claims 1-3 are rejected as being unpatentable over Carlson in view of Bollinger. No invention is seen in using the switch of Bollinger in the attenuator of Carlson since no new or unobvious result is produced thereby.

Claim 4 is rejected as being obviously nonstatutory.

/s/ J. E. Sax  
*Examiner*

HSH  
HSHertz:ap

IN THE UNITED STATES PATENT OFFICE

Division 69

In re application of  
**ROBERT REGIS**  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

Honorable Commissioner of Patents  
Washington 25, D. C.

Sir:

In response to the Office Action dated July 7, 1958,  
please amend the above-identified application as follows:  
Cancel claim 4.

REMARKS

Reconsideration and allowance of claims 1-3, inclusive,  
rejected as being unpatentable over patent 2,491,644—  
Carlson in view of abstract of application Serial No.  
694,044—Bollinger, are respectfully requested.

Bollinger discloses a device comprising a series-resonant circuit which is effectively connected in shunt with the wave propagation system. Applicant believes this inherently causes his device to be a narrow band shunt. Applicant in his invention makes use of a shorting strip of suitable material which is highly conductive. This strip acts as a broad band shunt.

It is submitted that each of the claims under consideration does define invention over the cited references which lack one or more of the essential features of applicant's invention. Considering claim 1 as typical, that claim distinguishes from the references in that the references taken alone or in combination do not show:

"\* \* \* and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximately impedance match to said source."

Carlson, taken alone, cannot achieve the degree of attenuation that applicant's invention is capable of achieving because the reference lacks the shorting strip. Combining Bollinger with Carlson, the degree of attenuation would be increased but only over a narrow band since Bollinger discloses a series-resonant circuit. Neither of the references discloses a highly conductive shorting strip.

This amendment is believed to place the application in condition for allowance, which action is respectfully solicited.

Respectfully submitted,

/s/ L. B. Dodds  
*Attorney for Applicant*

Little Neck, New York

Dated: October 29, 1958

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U. S. DEPARTMENT OF COMMERCE  
PATENT OFFICE  
Washington

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

Paper No. 6

Applicant: Robert Regis

Ser. No. 704,770

Filed December 23, 1957

For MICROWAVE SWITCH

Mailed Jan. 20, 1959—Pat. Div. 69

*Please find below a communication from the EXAMINER in charge of this application.*

/s/ Robert C. Watson  
*Commissioner of Patents.*

Responsive to amendment filed October 30, 1958.

Reference applied:

Wallace 2,822,526 Feb. 4, 1958 333-81B

(Filed Mar. 24, 1954)

Claims 1-8 are rejected as being unpatentable over Wallace cited in view of Carlson. No invention is seen in designing the switch of Wallace in shape of a vane as suggested by Carlson of record since no new or unobvious result would be produced thereby.

/s/ J. E. Sax  
*Examiner*

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HSHertz:ap

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IN THE UNITED STATES PATENT OFFICE

Division 69

In re application of  
**ROBERT REGIS**  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

Honorable Commissioner of Patents  
Washington 25, D. C.

Sir:

This is in response to the Office Action dated January 20, 1959.

REMARKS

Reconsideration and allowance of claims 1-3, inclusive, rejected as being unpatentable over Wallace, et al., patent No. 2,822, 526, in view of Carlson, patent No. 2,491,644, are respectfully requested.

The Carlson reference discloses an attenuator vane which, while attenuating the signal, also presents a match to the source. Basically, the Carlson disclosure is not a switch but rather an attenuator. Since the attenuator lacks a shorting stub, a portion of the signal will still pass the attenuator even when the vane is inserted into the guide for minimum attenuation.

Wallace et al disclose two embodiments of a wave guide shutter. The first embodiment is subject to the same shortcoming as is the Carlson disclosure. More particularly, when the semicylindrical member 14 of Fig. 1 is inserted into the guide, a portion of the signal will still pass the shutter. In addition, the member 14 presents a mismatch while being inserted into the guide. In the second embodiment, the operation of which is sim-

ilar to the first, there is shown in Figs. 3 and 4 a metallic member which may inherently act as a shorting stub. However, the reference makes no mention of this as the function of the metallic member. The reference only refers to the energy-absorbing material 19 of Figs. 3 and 4 as that member which functions to attenuate the signal. The only reference made to the metallic member 26 is in explaining it to serve to close the opening in the wall of the wave guide when the shutter is in the open position. No reference is made to this metallic member with respect to attenuating the signal. It is, therefore, not known whether such a member will function to provide such results. Applicant, therefore, submits that the Wallace et al reference should not be considered as anticipating applicant's invention.

Applicant further submits that the Wallace et al reference is an improper reference in that it was a co-pending application. The issue date of February 4, 1958 is after applicant's filing date of December 23, 1957. Consequently, Wallace et al are not part of the prior art and can only be considered under Section 102 (e) from the standpoint of whether it alone "describes" applicant's invention. Section 102 (e) enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 290, to the same effect. Wallace et al are not part of the prior art because it was secret in the Patent Office when applicant filed as 35 U.S.C. 122 provides.

This application is now believed to be in condition for allowance, which action is respectfully requested.

Respectfully submitted,

/s/ E. A. Ruestow

Attorney for Applicant

Little Neck, New York

Dated: June 2, 1959

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U. S. DEPARTMENT OF COMMERCE  
PATENT OFFICE  
Washington

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

Paper No. 8  
Applicant: Robert Regis  
Ser. No. 704,770  
Filed December 23, 1957  
For MICROWAVE SWITCH  
Mailed Jun. 24, 1959—Pat. Div. 65

*Please find below a communication from the EXAMINER in charge of this application.*

/s/ Robert C. Watson  
Commissioner of Patent.

Responsive to letter filed June 4, 1959.

Claims 1-3 are again rejected as being unpatentable over Wallace in view of Carlson. No invention is seen in designing the switch of Wallace in the shape of a vane as suggested by Carlson since no new or unobvious result is produced thereby.

Applicant's argument on page 2, lines 15-20 of paper No. 7 is untenable. When the member 26 of Wallace is in the position shown in Fig. 4, it necessarily functions as a short circuit across the wave guide 22. There is no showing in the case to the contrary.

Applicant's argument on the bottom of page 2 and page 3 of paper No. 7 (filed June 4, 1959) that Wallace is an improper reference is also untenable. See *In re Gregg* 1957 C.D. 284.

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This action has been taken up out of its regular turn under the authority of Commissioner's Order No. 3084, October 29, 1928 (708.01 M.P.E.P.).

Since an issue has clearly been reached, this action is made **FINAL**.

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE SEPTEMBER 25, 1959.**

*/s/ J. E. Sax  
Examiner*

HSH  
HSHertz:ap

25 A

IN THE UNITED STATES PATENT OFFICE

Division 65

In re application of  
ROBERT REGIS  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

APPEAL TO THE BOARD OF APPEALS

Honorable Commissioner of Patents  
Washington 25, D. C.

Sir:

Appeal is hereby taken to the Board of Appeals from  
the decision of the Primary Examiner finally rejecting  
claims 1-3, inclusive, of the subject application.

Check in the amount of Twenty-five Dollars (\$25.00)  
covering the appeal fee is enclosed herewith.

Respectfully submitted,

/s/ E. A. Ruestow  
*Attorney for Applicant*

Little Neck, New York

Dated: September 21, 1959

Enclosure

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

In re application of  
ROBERT REGIS  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

BRIEF ON APPEAL

This is an Appeal from the Final Rejection of claims 1-3, inclusive, rejected as being unpatentable over Wallace et al—Patent No. 2,822,526 in view of Carlson—Patent No. 2,491,644. Oral hearing is requested. Accordingly, this Brief is submitted in triplicate (Rule 192). A copy of the claims in issue is appended to the Brief.

THE INVENTION

This invention relates to microwave switches and, more particularly, to the type which selectively isolate a microwave source from its load.

Referring to Fig. 1, a microwave source such as the microwave transmitter 10 is coupled to a microwave antenna 12 through a wave guide 11. An attenuator vane 13 of resistive material is disposed in a slot in the guide. As shown in Fig. 2, the vane has a tapered end extending toward the transmitter and has a highly conductive or shorting strip 15 of suitable material at the other end thereof. While the vane is in the slot an effective short circuit exists across the guide. When the vane is removed from the slot the transmitter is coupled to the antenna in a conventional manner.

## 27 A

When the vane is in the guide the resistive material absorbs the energy from the transmitter. Because of the configuration of the vane the signal reaching the shorting strip is attenuated. After reflection at the shorting strip the signal is further attenuated, thereby causing no disruption of the operation of the transmitter.

### THE REJECTION

The Examiner contends that claims 1-3, inclusive, are unpatentable over Wallace et al in view of Carlson.

There is no need to discuss the actual disclosures of Wallace et al and Carlson in view of the arguments which follow. Suffice it to say that Examiner asserts that it is possible to combine them as an engineering matter to arrive at applicant's invention. We shall accept the assertion as valid for purposes of argument.

### COPENDING REFERENCES

Applicant contends that the Wallace et al reference cannot be combined with any other reference because it was copending with applicant's application. The issue date of February 4, 1958, is after applicant's filing date of December 23, 1957. Applicant insists that any copending reference, such as Wallace et al, is not part of the prior art and must stand alone against the present application on the limited question of whether it actually describes applicant's invention. Admittedly, the case law is in conflict. But, the Patent Act of 1952 turns the balance.

The status of all patents relied on by the Examiner is determined solely by 35 USC 102 and 35 USC 103.

Section 102 begins with the statement:

"A person shall be entitled to a patent unless \* \* \* clearly indicating that the immediately following list (a), (b), (c), (d), (e), (f) and (g) of such grounds for invalidation is exclusive of all others not stated there or in Section 103. Grounds (b), (c), (d) and (f) are obviously inapplicable to the present issue. The others read in pertinent part:

"(a) *the invention* was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(e) *the invention* was described in a patent granted on *an* application for patent by *another* filed in the United States before the invention thereof by the applicant for patent, or

"(g) before the applicant's invention thereof *the invention* was made in this country by another who had not abandoned, suppressed, or concealed it. \* \* \*"

The wording of the list, particularly in view of the under-scored\* portions which find their counterpart in some of the grounds not quoted, clearly indicates that for any one of the grounds of invalidation to be applicable, *the invention* must be found in one reference as an integrated whole—all in one place, so to speak—not synthesized from separate references. If emphasis of this point were needed, it would be found in the first three lines of Section 103 which states in pertinent part:

"A patent may not be obtained though the invention is not *identically* disclosed or described as *set forth* in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.  
\* \* \*"

\*—Italicized Herein

and also in the following reference to Section 103 in the Report of the Committee on the Judiciary:

“\* \* \* An invention which has been made, and which is new in the sense that the *same thing* has not been made before, may still not be patentable \* \* \*.” (82nd Congress, House Report, No. 1923, May 12, 1952).

This can only mean that Section 102 was intended to refer to *a disclosure of the complete invention in one reference* and that Section 103 was intended to supply the only exception.

Particularly as to Section 102(a), the fact that the case law on prior knowledge and use requires a complete integrated disclosure, shows that this is what the Act also contemplates.

Section 103 adds a more general ground of invalidation since it is the only provision permitting one to synthesize an anticipation from scattered elements of the prior art.

The very existence of Section 102(e) makes it obvious that copending patents are recognized as a special situation. In this situation, by standard canons of interpretation, the juxtaposition of Sections 102 and 103 leads to the conclusion that only Section 102(e) is applicable to a copending patent reference, such as Wallace et al, which was filed before the immediate application but issued thereafter.

It has always been held that specific terms of a statute prevail over general terms. Thus in *Fourco v. Trans-mirra* (1957), 353 U.S. 222; 113 USPQ 234, the Supreme Court held that the general corporation venue statute 28 USC 1391(c) was inapplicable in patent infringement actions by virtue of the special venue statute 28 USC

1400(b) which prescribes venue in patent actions. The Court said:

"We think it is clear that Section 1391(c) is a general corporation venue statute, whereas Section 1400(b) is a special venue statute applicable, specifically, to *all*\* defendants in a particular type of actions, i.e., patent infringement actions. In these circumstances the law is settled that '*However inclusive may be the general language of a statute, it "will not be held to apply to a matter specifically dealt with in another part of the same enactment. \* \* \* Specific terms prevail over the general in the same or another statute which otherwise might be controlling.*'" *Ginsberg & Sons v. Popkin*, 285 U.S. 204, 208; *MacEvoy Co. v. United States*, 322 U.S. 102, 107." (\*Emphasis Court's)

By its very terms Section 102(e) is specific to the situation of a copending patent. Moreover, it is specific for the further reason of its very history. This paragraph (e), as the Reviser's notes (House Report 1923; 35 U.S.C.A. 102) state, enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390. In that case the Court ruled that a copending United States patent, which gives "*a complete and adequate description of the thing*" (p. 399, again on p. 400), claimed in a later filed patent, dates from the date of filing of the copending application for the purpose of showing that the later applicant could not be the first inventor even though the copending patent issued after the later inventor filed.

*Moreover, if Section 103 were applicable to copending patents, Section 102(e) would be rendered meaningless; if a copending patent is prior art under Section 103, there is no need for Section 102(e).* An interpretation which renders any provision meaningless has always been held to be improper:

"\* \* \* We are not at liberty to construe any statute so as to deny effect to any part of its lan-

guage. It is a cardinal rule of statutory construction that significance and effect shall, if possible, be accorded to every word. (p. 115)

“\* \* \* Another rule equally recognized is, that every part of a statute must be construed in connection with the whole, so as to make all the parts harmonize, if possible, and give meaning to each.” (p. 116) *Washington Market Co. v. James A. Hoffman*, 101 U.S. 112, (followed in *Ex parte Public National Bank of New York*, 278 U.S. 101, 104.)

It is clear then that Section 102(e) is to stand alone. And if it is to stand alone, we ought to examine its precise words. It says: “the invention was described”. This language stands out. It has a peremptory command in it; *the invention* must be pointed out. That is the ordinary meaning of the word “describe”. The language does not say that it will suffice if one can look at the copending patent and synthesize the missing parts from true prior art.

The conclusion that Section 103 is inapplicable to copending patents is reinforced by Section 122 and by numerous prior decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available knowledge until the patent issues. Copending patent applications have always been kept in secrecy in the Patent Office and Section 122 now specifically so provides. Section 122 reads:

“Section 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out

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the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." 35 USC 122

Respectfully submitted,

/s/ E. A. Ruestow  
*Attorney for Applicant*

Little Neck, New York  
Dated: October 29, 1959

## APPENDIX

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.
2. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a shorting strip at the other end thereof and displaceable in and out of said guide in the plane of maximum electric field intensity for providing an effective short circuit across said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.
3. A microwave switch for selectively isolating a microwave transmitter from its antenna load comprising: a microwave signal guide for connection to a microwave transmitter at one end and to an antenna load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said transmitter and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said transmitter from its load when in said guide while maintaining an approximate impedance match to said transmitter.

U. S. DEPARTMENT OF COMMERCE  
UNITED STATES PATENT OFFICE  
Washington

Appeal No. 29098

Before the Board of Appeals

Paper No. 11  
In re application of  
Robert Regis  
Ser. No. 704,770  
Filed December 23, 1957  
For MICROWAVE SWITCH  
Mailed Nov. 10, 1959—Pat. Div. 65

Mr. Laurence B. Dodds for Appellant

Examiner's Answer

This is an appeal from the final rejection of claims 1-3.  
No claims are allowed.

A correct copy of the appealed claims appears on page 1a of the applicant's brief.

The references of record relied on are:

Carlson 2,491,644 Dec. 20, 1949  
Wallace et al. 2,822,526 Feb. 4, 1958  
(Filed Mar. 24, 1954)

A description of the claimed switch, of the devices shown in the references and the application of the references to the claims are not believed to be necessary for the following reason. The instant appeal raises only a question of law, namely whether or not the two references, one of which was copending with the instant application, may be combined in the holding that claims 1-3 are unpatentable. The rejection was on one patent issued on an application filed prior to the filing date of the instant application, but issued subsequent to such

date, in view of a second patent issued prior to the filing date of the instant application. Appellant concedes that if these two patents are available for use as references that can be combined, their combination negatives patentability on the claim. This concession is expressed in the brief in the sentences on page 2, lines 14-19, as follows:

"There is no need to discuss the actual disclosures of Wallace et al. and Carlson in view of the arguments which follows. Suffice it to say that Examiner asserts that it is possible to combine them as an engineering matter to arrive at applicant's invention. We shall accept the assertion as valid for purposes of argument."

*The facts to this issue are as follows:*

- (1) The Carlson patent was issued prior to the filing date (December 23, 1957) of the present application, while the Wallace et al. patent issued after the filing date of the present application, but was filed (March 24, 1954) earlier than the present application.
- (2) The two patents are to inventors different from the one in the present application and no common assignment is apparent.
- (3) Applicant has not sworn back of either reference under the provision of Rule 131.
- (4) In utilizing the Carlson and Wallace et al. patents as references the Examiner followed the instruction set forth in the third paragraph of Section 706.02 of the Manual of Patent Examining Procedure, as supported by the decisions cited therein and also the decision of *In re Gregg*, 1957 C.D. 284.

Applicant's arguments have been considered, but are not seen as being persuasive as to the alleged intent of the Patent Act of 1952. It appears to have been well settled law prior to the 1952 Patent Act that co-pending

patents having valid effective dates taken singly or in combination, were available as references and that nothing in the Patent Act of 1952 effected a change in this procedure. For authority as to this conclusion, the Examiner cites the following Board of Appeals decisions:

Ex parte Teague and De Padova 108 U.S.P.Q. 380.  
Ex parte Machlarski 111 U.S.P.Q. 459.  
Ex parte Kuzmitz 113 U.S.P.Q. 255.

In each of the above cases, substantially the same arguments as advanced in applicant's brief were raised, and in each case, it was held that the Patent Act of 1952 did not change the established policy of utilizing co-pending patents having valid effective dates as references.

In addition the following statement by the Court of Customs and Patent Appeals (In re Gregg 1957 C.D. 284) appears to be directly in point and is quoted in its entirety.

"We are unable to agree with appellant that the prior art referred to in section 103 of the 1952 Act is limited to art which was available to the public prior to the date of the applicant's invention. The section clearly does not make any express statement to that effect, and no reason appears for reading such a limitation into it. It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. In re Seid, 34 C.C.P.A. (Patents) 1039, 161 F. 2d 229, 73 USPQ 431, and cases there cited. There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952."

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For the above reasons, the Carlson and Wallace et al. patents are believed to be properly combined. Therefore, since applicant does not otherwise contend that these references are not applicable to claims 1-3, the rejection of these claims is considered proper and should be affirmed.

Respectfully submitted,

/s/ J. E. Sax  
Examiner, Div. 65

HSH  
HSHertzziap

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

U. S. DEPARTMENT OF COMMERCE  
UNITED STATES PATENT OFFICE  
Washington

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, New York

Paper No. 12  
Appeal No.: 290-98  
Appellant: REGIS, ROBERT  
Serial No.: 704,770

Hearing

Date: May 31, 1962  
Time: 9:30 A.M.

**NOTICE OF HEARING**

The appeal in the above identified case will be heard by the Board of Appeals on the date indicated.

The hearings will commence at the time set and as soon as the argument in one case is concluded, the succeeding case will be taken up.

The time allowed for argument is thirty minutes unless additional time is requested and permitted before the argument is commenced.

By Order of the Board of Appeals.

/s/ Nicholas Hahn  
Administrative Officer

IN THE UNITED STATES PATENT OFFICE

Division 65

Appeal No. 290-98

In re application of  
ROBERT REGIS  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

ASSOCIATE POWER OF ATTORNEY

Honorable Commissioner of Patents  
Washington 25, D. C.

Sir:

The undersigned attorney of record in the above-entitled application hereby appoints

ANDREW L. NEY

(Registration No. 20,300), whose address is 59-25 Little Neck Parkway, Little Neck 62, New York, his associate agent, with full power to prosecute said application, to make alterations and amendments in said application, to receive the patent, and to transact all business in the Patent Office connected therewith.

It is requested that all communications from the Patent Office in connection with the above-entitled application be addressed to LAURENCE B. DODDS at 59-25 Little Neck Parkway, Little Neck 62, New York.

Respectfully,

/s/ L. B. Dodds

Attorney for Applicant

Little Neck, New York

Dated: September 27, 1961

U. S. DEPARTMENT OF COMMERCE  
PATENT OFFICE  
Washington 25, D.C.

January 11, 1962

Paper No. 14

Appeal No.: 290-98

Appellant: Regis, Robert

Serial No.: 704,770

Hearing

Date: March 20, 1962

Time: 9:30 A.M.

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

NOTICE OF HEARING

The appeal in the above identified case will be heard by the Board of Appeals on the date indicated.

The hearings will commence at the time set and as soon as the argument in one case is concluded, the succeeding case will be taken up.

The time allowed for argument is thirty minutes unless additional time is requested and permitted before the argument is commenced.

By Order of the Board of Appeals.

/s/ Nicholas Hahn  
Administrative Officer

Hearing in this case re-set in view of the increase in personnel permitting the Board to advance hearing dates of some cases.

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

In re application of  
ROBERT REGIS  
Serial No. 704,770  
Filed December 23, 1957  
For: MICROWAVE SWITCH

APPEAL TO THE BOARD OF APPEALS

On review, the request for oral hearing is withdrawn for the reason that it is believed that the brief filed on this appeal adequately clarifies the issues.

Accordingly, it is requested that the hearing set for March 20, 1962 be cancelled.

Respectfully submitted,

/s/ Andrew L. Ney  
Associate Agent for Applicant

Little Neck, New York

Dated: January 30, 1962

Paper No. 16

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

BEFORE THE BOARD OF APPEALS

Mailed Mar. 28, 1962

U.S. Patent Office, Board of Appeals

*Ex parte* Robert Regis

Application for Patent filed December 23, 1957, Serial No. 704,770. Microwave Switch.

Messrs. Laurence B. Dodds, Edward A. Ruestow, and Andrew L. Ney for appellant.

Before McCann, Kreek and Keely, Examiners-in-Chief. Keely, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1, 2 and 3, all the claims now in the case.

Claim 1 is representative and reads as follows:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

The references relied upon are:

Carlson 2,491,644 Dec. 20, 1949  
Wallace et al. 2,822,526 Feb. 4, 1958

The rejected claims relate to a microwave switch which is adequately described in appellant's brief to which reference is made.

The claims stand rejected as being unpatentable over Wallace et al. in view of Carlson.

It is asserted by the Examiner that appellant has conceded that if the patent to Wallace et al. is available as a reference then it may be combined with Carlson and that the combination negatives invention in the instant case.

It is the position of the Examiner that prior to the 1953 (sic) Patent Act copending patents either singularly or in combination were valid references. He contends that said Act has not changed this situation and he cites our decisions *Ex parte* Teague et al., 108 USPQ 380; *Ex parte* Machlanski, 111 USPQ 459; and *Ex parte* Kuzmitz, 113 USPQ 255 as well as the Court of Customs and Patent Appeals decision in *In re Gregg*, 44 CCPA 904, 1957 C.D. 284, 720 O.G. 227, 244 F.(2d) 316, 113 USPQ 526 as supporting his position.

Appellant challenged the rejection contending that Wallace et al. is not prior art and for this reason cannot be combined with Carlson.

It is urged by appellant that 35 U.S.C. 102 requires that an appellant must be granted a patent unless one of the prohibitions of the seven sub-paragraphs of this section applies. He considers sub-paragraphs (a), (e) as being the only ones applicable. Pointing to the term "the invention" of these paragraphs he argues that the quoted term requires that his complete device must be found in a single reference before Section 102 is applicable.

He submits that his arguments are fortified by the terms of 35 U.S.C. 103, which uses the following language in referring to 35 U.S.C. 102,

"... not identically disclosed or described as set forth in section 102 . . ."

He concludes that Section 102 restricts the prior art to a single reference, and that Section 103 was intended to supply the only exception.

Turning next to Section 103, he urges that if this Section relates to copending patents then it would be in conflict with Section 102(e) and the latter would be unnecessary. He contends that such an interpretation of the statutes is improper and that Section 102(e) is to stand alone in relation to copending patents.

He considers that his reasoning that Section 103 is inapplicable to copending patents is reinforced by Section 122 which requires that patent applications be kept in secrecy, as well as by numerous decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available until the patent issues.

We have reviewed the pertinent sections of the statutes and case law in the light of the Examiner's and appellant's remarks and as a result of our review are in full accord with the position of the Examiner.

It appears to us that the issues raised by appellant have been decided by the Court of Customs and Patent Appeals in *In re Gregg* as well as by us in our previous decisions cited above.

The arguments in appellant's brief appear to be pointless. On page 6, appellant admits that 35 U.S.C. 102(e) enacts the rule of *Milburn Co. v. Davis Bournonville Co.*, 1926 C.D. 303, 344 O.G. 817, 270 U.S. 390, which held that a patent was a reference for what it disclosed as of its filing date.

It is obvious that Wallace et al., as of his filing date, had the structure necessary for modifications in the light of Carlson to achieve the disputed claimed structure. Appellant has admitted that the modification is ob-

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vious. Under these circumstances the claimed structure was obviously within the grasp of Wallace et al. about three years and nine months prior to appellant's entry into the field.

Section 103, as we view it, concerns itself only with the circumstances under which a reference that is not anticipatory of the claimed device or method may be used. This section complements sub-paragraphs (a), (b), (e) and (g) of 102 without indicating the type of evidence which will be used to establish obviousness, the qualification of the evidence being found in other sections of the statute and pertinent case law, as for example the cases cited above.

Accordingly, we will sustain the rejection of the claims.

We have carefully considered the contentions and arguments presented in appellant's brief but we are of the opinion that the Examiner's rejection was proper and it will be sustained.

The decision of the Examiner is affirmed.

**AFFIRMED**

/s/ L. P. McCann  
Examiner-in-Chief

/s/ Louis F. Creek  
Examiner-in-Chief

/s/ J. E. Keely  
Examiner-in-Chief  
Board of Appeals

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, New York

U. S. DEPARTMENT OF COMMERCE  
PATENT OFFICE  
Washington

Re: Application of  
Robert Regis  
Serial No. 704,770  
Filed December 23, 1957  
For: Microwave Switch

NOTICE OF CIVIL ACTION UNDER 35 U. S. C. 145

A civil action No. 1688-62, under 35 U.S.C. 145, entitled Hazeltine Research, Inc. and Robert Regis v. David L. Ladd, Commissioner of Patents, involving this application, was filed in the United States District Court for the District of Columbia, on May 25, 1962.

/s/ C. W. Moore  
Solicitor

\* \* \* \*

## Plaintiff's Exhibit 2

## ASSIGNMENT

In consideration of One Dollar and other good and valuable consideration, the receipt of which is hereby acknowledged, I, ROBERT REGIS, of Fresh Meadows, New York, sell and assign to HAZELTINE RESEARCH, INC., a corporation of Illinois, of 5445 West Diversey Avenue, Chicago 39, Illinois, its successors, assigns and nominees, the invention relating to improvements in

## MICROWAVE SWITCH

invented by me, and the application for United States Patent therefor executed concurrently herewith, and all divisions and continuations thereof, and all Patents which may be granted therefor and all reissues and extensions thereof, and authorize and request the Commissioner of Patents to issue all Patents on said invention or resulting therefrom to said Company as assignee of the entire interest, and covenant that I have full right so to do, and agree that I will communicate to said Company or its representatives any facts known to me respecting said invention and testify in any legal proceeding, execute all divisional, continuing and reissue applications and all assignments of said invention and of the right to apply for Letters Patent therefor in all countries, make all rightful oaths, sign all other lawful papers, and generally do everything reasonably possible to aid said Company, its successors, assigns and nominees, to obtain and enforce proper patent protection for said invention in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 20th day of December, 1957.

/s/ Robert Regis

L. S.

State of New York ss.:  
County of Queens

On this 20th day of December, 1957, before me, a Notary Public in and for the State and County aforesaid, personally appeared ROBERT REGIS, to me known and known to me to be the person of such name, who signed and sealed the foregoing instrument, and who acknowledged the same to be his free act and deed.

/s/ Caroline B. Scott  
CAROLINE B. SCOTT

Notary Public, State of New York  
No. 30-8887200

Qualified in Nassau County  
Cert. filed with Queens County Clerk  
Commission Expires March 30, 1968

### Notarial Seal

Plaintiff's Exhibit 3

STATE OF ILLINOIS

OFFICE OF THE SECRETARY OF STATE

To all to whom these Presents Shall Come, Greeting:

I, CHARLES F. CARPENTIER, Secretary of State of the State of Illinois do hereby certify that HAZELTINE RESEARCH, INC., a domestic corporation, incorporated under the laws of this State March 28, 1946, appears to have complied with all the provisions of the Business Corporation Act of this State, relating to the filing of annual reports and payment of franchise taxes, and as of this date, is in Good Standing as a domestic corporation of the State of Illinois.

In Testimony Whereof. I hereto set my hand and cause to be affixed the Great Seal of the State of Illinois, Done at the City of Springfield this 27th day of March A.D. 1963.

[SEAL]

/s/ Charles F. Carpentier  
Secretary of State

\* \* \* \*

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**Defendant's Exhibit 1A**

Dec. 20, 1949

**C. P. CARLSON**

**2,491,644**

## ATTENUATOR

Filed Aug. 24, 1945

2 Sheets-Sheet 2

FIG. 5

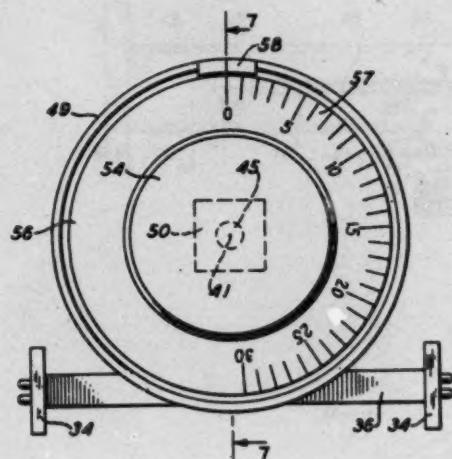


FIG. 6

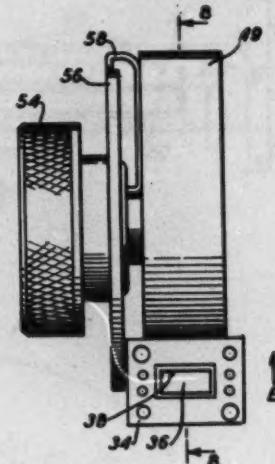


FIG. 7

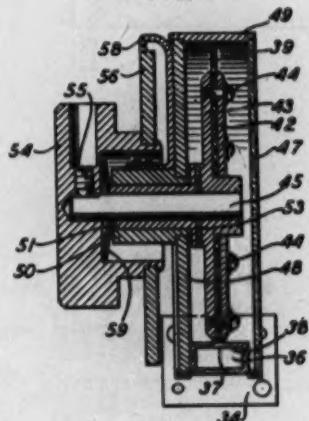
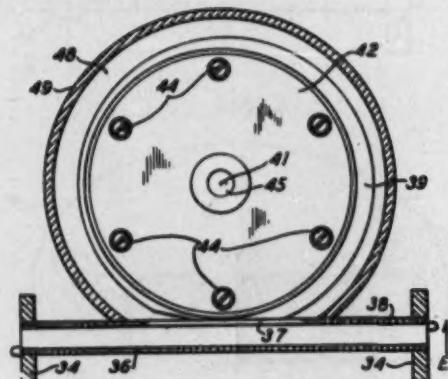


FIG. 8



INVENTOR  
C. P. CARLSON

*Ralph T. Holcomb*  
ATTORNEY

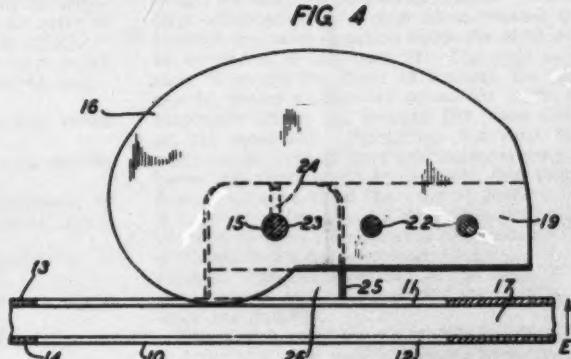
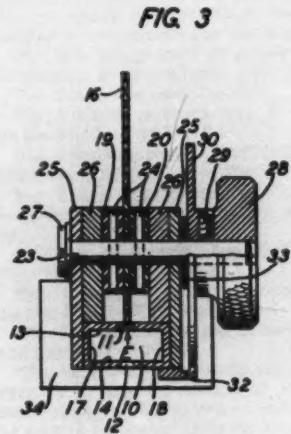
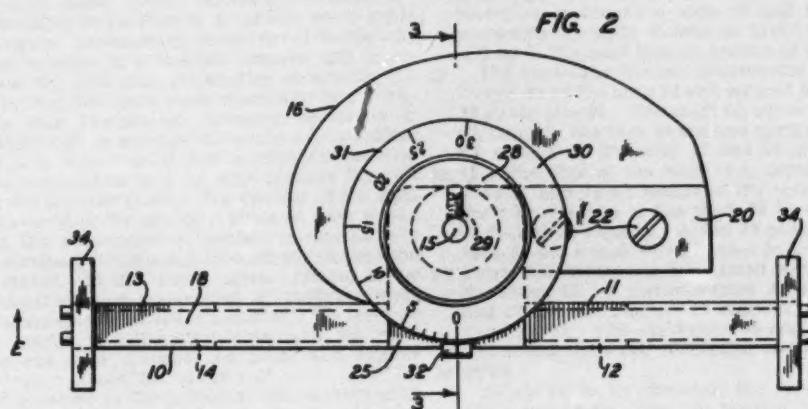
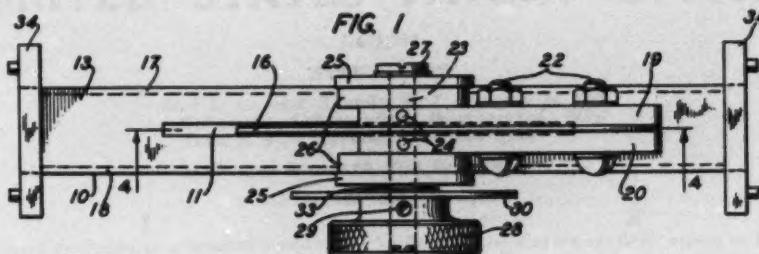
Dec. 20, 1949

C. P. CARLSON  
ATTENUATOR

2,491,644

Filed Aug. 24, 1945

2 Sheets-Sheet 1

INVENTOR  
C. P. CARLSONBY  
Ralph J. Holcomb  
ATTORNEY

Patented Dec. 20, 1949

2,491,644

## UNITED STATES PATENT OFFICE

2,491,644

## ATTENUATOR

Carl P. Carlsen, Tenafly, N. J., assignor to Bell Telephone Laboratories, Incorporated, New York, N. Y., a corporation of New York

Application August 24, 1945, Serial No. 612,394

13 Claims. (Cl. 175—44)

1

This invention relates to attenuators and more particularly to variable attenuators for use with wave guides.

The principal object of the invention is to attenuate electromagnetic energy flowing in a hollow wave guide. Other objects are to make the attenuation in decibels of a variable wave guide attenuator substantially proportional to the angular rotation of a resistive element and to increase the maximum attenuation obtainable.

The variable wave guide attenuator in accordance with the present invention comprises a straight, hollow wave guide having a longitudinal slot in a wall thereof and a rotatable resistive vane mounted so that its edge projects through the slot into the guide. The contour of the vane deviates from the arc of a circle in such a way that the attenuation in decibels is substantially proportional to the angle through which the vane is rotated. In this way, congested regions in the attenuation scale are avoided, permitting a more accurate setting of the attenuator. To increase the maximum attenuation obtainable the vane may cut clear through the guide and emerge through a second slot in the wall.

The nature of the invention will be more fully understood from the following detailed description and by reference to the accompanying drawing, in which like reference characters refer to similar or corresponding parts and in which:

Fig. 1 is a top view of a two-slot wave guide attenuator in accordance with the invention;

Fig. 2 is a side view thereof;

Fig. 3 shows a transverse cross-section taken on the line 3—3 of Fig. 2;

Fig. 4 shows a partial longitudinal cross-section taken on the line 4—4 of Fig. 1;

Fig. 5 is a side view of another attenuator in accordance with the invention, employing only a single slot;

Fig. 6 is an end view of the attenuator of Fig. 5;

Fig. 7 shows a transverse cross-section taken on the line 7—7 of Fig. 5; and

Fig. 8 is a longitudinal cross-section taken on the line 8—8 of Fig. 6.

The variable wave guide attenuator shown in Figs. 1, 2, 3 and 4 comprises a hollow, straight wave guide 10 having two oppositely disposed slots 11 and 12 in the opposite sides 13 and 14, respectively, and a resistive vane 16 rotatably mounted about the pivot point 15 so that its edge will enter the guide 10 through the upper slot 11 and emerge through the lower slot 12. The vane 16 is preferably positioned parallel to the transverse electric

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field of the electromagnetic waves to be attenuated. In the guide 10, which is of rectangular cross-section with unequal cross-sectional dimensions, this field is ordinarily parallel to the narrower sides 17 and 18, as indicated by the arrow E in Figs. 2, 3 and 4. The slots 11 and 12 are, therefore, in the wider sides 13 and 14 and are preferably centrally located so that the vane 16 will be in the most intense portion of the field.

10 The vane 16 is clamped between the two blocks 19 and 20 by the bolts 22 and secured to the shaft 23 by the pins 24. The shaft 23, which has a head 27, turns in bearings in the two upright supports 26, secured to the sides 17 and 18 of the guide 10. The edge of the vane 16 is centered in the slots 11 and 12 by means of the spacers 28. A knob 28 attached to the shaft 23 by a set screw 29 facilitates turning. A dial 30 attached to the knob 28 has a scale 31 calibrated in decibels upon 20 which the attenuation introduced may be read at the index 32. A spring washer 33 between the dial 30 and the support 26 takes up end play in the shaft 23. The end flanges 34 are provided for connecting the guide 10 to other sections of wave 25 guide.

As shown in the drawing, the vane 16 is entirely withdrawn from the interior of the guide 10 and the attenuation reading is zero. To introduce attenuation, the vane 16 is rotated in a counter-clockwise direction about the pivot point 15 by means of the knob 28. The edge of the vane 16 enters the guide 10 through the upper slot 11, passes all the way across the guide, and eventually comes out through the lower slot 12 on the other side. Permitting the vane 16 to extend clear through the guide increases the maximum attenuation obtainable with the attenuator. The contour of the vane 16 preferably so deviates from the arc of a circle that the attenuation in decibels introduced is substantially proportional to the angle through which the vane is rotated. Congested regions in the scale 31 are thus avoided and more accurate attenuation settings are possible.

45 Figs. 5, 6, 7 and 8 show a modified embodiment of a variable wave guide attenuator in accordance with the invention in which the guide has only a single slot. The attenuator comprises a straight, hollow, rectangular wave guide 38 having a slot 37 centrally located in one of the wider sides 38 and a resistive vane 39 mounted for rotation about the pivot point 41 so that its edge will project through the slot 37 into the interior of the guide 38.

The vane 39 is clamped between two circular

plates 42 and 43 by means of six screws 44 and the assembly is secured to the inner end of the shaft 45. This assembly is enclosed in a metallic shield formed of the two circular plates 47 and 48 and a short cylinder 49 securely attached at its base to the guide 38. The plate 48 carries a journal box 50 in which rotates the flanged cylindrical bearing 51 surrounding a portion of the shaft 45. The edge of the vane 39 is centered in the slot 37 by the washer 52. A knob 54 attached to the outer end of the shaft 45 by a set screw 55 carries a dial 56 with a scale 57, calibrated in decibels of attenuation, which may be read at the index 58. A spring washer 59 between the bearing 51 and the knob 54 prevents end play in the shaft 45.

As shown in Figs. 5, 6, 7 and 8 the attenuator is set at zero and therefore the vane 39 is entirely withdrawn from the guide 38. However, as the knob 54 is turned in a counter-clockwise direction the edge of the vane 39 gradually passes through the slot 37 into the interior of the guide 38 and the attenuation is increased correspondingly. In this attenuator, also, the contour of the vane 39 preferably so deviates from the arc of a circle that the attenuation in decibels is a substantially linear function of the angular rotation.

What is claimed is:

1. A variable attenuator for electromagnetic waves comprising a hollow wave guide having a longitudinal slot in a wall thereof, a rotatable resistive vane mounted so that its edge projects through said slot into said guide, and a metallic shield enclosing said vane, the contour of said vane so deviating from the arc of a circle that the attenuation in decibels is substantially proportional to the angular rotation of said vane.

2. An attenuator in accordance with claim 1 in which said guide has a substantially straight longitudinal axis.

3. An attenuator in accordance with claim 1 which includes a second slot in the wall of said guide, said slots being oppositely disposed and said vane being so shaped that, upon rotation, it cuts clear through said guide and emerges through said second slot.

4. An attenuator in accordance with claim 1 in which said vane is parallel to the transverse electric field of the electromagnetic waves to be attenuated.

5. An attenuator in accordance with claim 1 in which said guide is of rectangular cross-section and said slot is centrally located in one of the sides thereof.

6. An attenuator in accordance with claim 1 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slot is in one of the wider sides thereof.

7. An attenuator in accordance with claim 1 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slot is centrally located in one of the wider sides thereof.

8. A variable attenuator for electromagnetic waves comprising a hollow wave guide having two oppositely disposed longitudinal slots in the wall thereof and a rotatable resistive vane mounted so that, upon rotation, its edge enters said guide through one of said slots and emerges therefrom through the other of said slots.

9. An attenuator in accordance with claim 8 in which the contour of said vane is so shaped that the attenuation in decibels is substantially proportional to the angular rotation of said vane.

10. An attenuator in accordance with claim 8 in which said vane is parallel to the transverse electric field of the electromagnetic waves to be attenuated.

11. An attenuator in accordance with claim 8 in which said guide is of rectangular cross-section and said slots are centrally located in opposite sides thereof.

12. An attenuator in accordance with claim 8 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slots are in the wider sides thereof.

13. An attenuator in accordance with claim 8 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slots are centrally located in the wider sides thereof.

CARL P. CARLSON.

#### REFERENCES CITED

45 The following references are of record in the file of this patent:

#### UNITED STATES PATENTS

Number	Name	Date
50 2,151,157	Schelkunoff	Mar. 21, 1939

54 A  
Defendant's Exhibit 1B

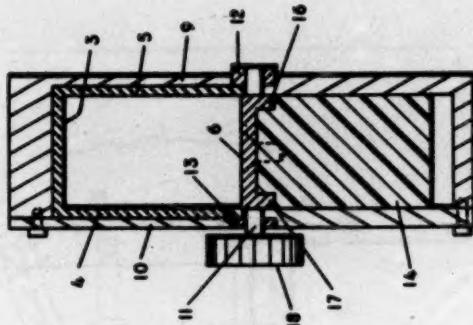
Feb. 4, 1958

B. E. WALLACE ET AL  
WAVEGUIDE SHUTTER

2,822,526

Filed March 24, 1954

2 Sheets-Sheet 1



Feb. 4, 1958

B. E. WALLACE ET AL

2,822,526

## WAVEGUIDE SHUTTER

Filed March 24, 1954

2 Sheets-Sheet 2

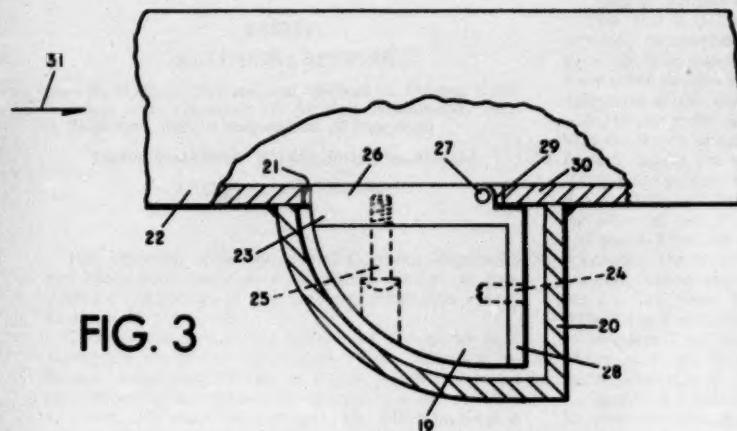


FIG. 3

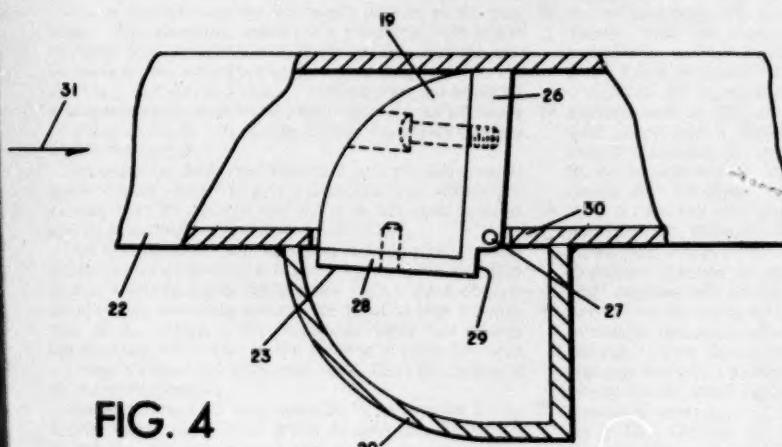


FIG. 4

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## United States Patent Office

2,822,526

Patented Feb. 4, 1958

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2,822,526

## WAVEGUIDE SHUTTER

Bert E. Wallace, Towson, and William A. Scanga, Baltimore, Md., assignors to Aircraft Armaments, Inc., Baltimore, Md., a corporation of Maryland

Application March 24, 1954, Serial No. 418,334

11 Claims. (Cl. 333—98)

This invention relates in general to power attenuators and more particularly to a waveguide shutter for producing a step change of attenuation of microwave energy flowing in a waveguide.

Conventional devices for attenuating the energy in a waveguide are of two basic types. One employs a reflective metal plate serving as a gate which is inserted into the waveguide transversely thereof to either partially or completely close the passage. The other employs a glass or phenolic plate having a resistive coating thereon which is inserted into the waveguide parallel to the passage. The maximum attenuation attainable with either of these types is approximately 30 decibels and the mechanical means for actuating the attenuating elements are relatively complex and bulky. Furthermore, conventional waveguide attenuators unavoidably decrease the efficiency of a waveguide by introducing abrupt impedance changes within the section.

An object of the instant invention is to provide a waveguide shutter which will give a step change of attenuation of well over 80 decibels and which in the open position has an insertion loss less than 0.3 decibel.

Another object of this invention is to provide a waveguide shutter employing a flange on a movable wall portion of a waveguide in combination with a block of electrical energy absorbing material for effecting high attenuation of the energy in the waveguide while maintaining the standing wave ratio in the guide at a value less than 1.1 over a 10 percent frequency band when the shutter is in the open position.

Another object of this invention is to provide a fast acting waveguide shutter which is mechanically simple to actuate, which is rugged and which occupies a relatively small space.

Still another object of this invention is to provide a waveguide shutter which is economical to manufacture.

Further and other objects will become apparent from a reading of the following detail description, especially when considered in combination with the accompanying drawing, wherein like numerals refer to like parts.

In the drawing:

Fig. 1 is a fragmentary top elevation view of the waveguide shutter.

Fig. 2 is a sectional view taken on line 2—2 of Fig. 1.

Fig. 3 is a fragmentary top elevation view of a modified form of the shutter shown in the open position.

Fig. 4 is a fragmentary top elevation view of the modified shutter shown in the closed position.

Referring to Figs. 1 and 2, a section of rectangular waveguide 1 is shown having a pair of narrow walls 2 and 3, and a pair of wide walls 4 and 5 wherein micro-

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wave energy applied to the waveguide will flow through the passage defined by the four walls. A segment 6 of narrow wall 2 is cut from the waveguide to provide a generally rectangular opening 7, the length of which is equal to substantially twice the wide dimension of the waveguide and the width of which is equal to the narrow dimension of the waveguide.

A tubular metal housing 8 slightly larger in diameter than the length of opening 7 and having a transverse slot 10 formed therein for receiving the waveguide is arranged relative to opening 7 such that the centerline of housing 8 is located medially of the opening and coincident with the plane of wall 2. A pair of generally circular metal end plates 9 and 10 are secured to housing 8 for rigidly connecting the latter to the waveguide and for forming a closed semicircular cavity in communication with opening 7. End plates 9 and 10 are contiguous with wide walls 4 and 5 and have a step increase in thickness beyond narrow wall 2 as best shown in Fig. 2 so that the height 15 of the cavity will be substantially the same as the narrow inside dimension of the guide.

Segment 6 is carried by housing 8 to serve as a revolving door for closing opening 7. Specifically, this is accomplished by a shaft 11 secured to segment 6 medially 20 thereof and extending transversely of the waveguide and parallel with the plane of the segment. Shaft 11 is mounted in suitable bearings 12 and 13 carried by end plates 9 and 10 respectively.

A block 14 of suitable microwave energy absorbing 25 material such as "polyiron," having a semicircular plan-form shape and a thickness substantially equal to the narrow dimension of the waveguide is secured at its base to the outside surface of segment 6 by means such as screws 15. As shown in the drawing, by rotating segment 6 from the open position shown in Fig. 1 to a new position 180° disposed therefrom, block 14 will be inserted into waveguide 1, completely blocking the passage.

Continued rotation of segment 6 throughout a second 30 180° segment will return block 14 to the original position within the cavity formed by housing 8 and open the waveguide passage to allow the free flow of energy therethrough. With the shutter in this latter open position segment 6 closes opening 7 in the side of waveguide 1 except for the small gap required to permit unobstructed 35 rotational movement of the segment and its associated block 14. Due to the manner in which energy flows through the waveguide, the gaps extending in a direction parallel to the guide will normally tend to produce a power loss and set up an undesirable standing wave in the area of the shutter as a result of energy leakage there-through into housing 8. This undesirable effect is obviated through the use of transverse flanges 16 and 17 formed on the outer edges of segment 6. These flanges 40 16 and 17 extend outwardly and generally parallel with segment 6 to produce a very low impedance path for the waveguide energy such that the effect of the gap is substantially eliminated. That is, energy in the waveguide will flow as though no gap were present. For 45 most satisfactory results the width of the flanges 16 and 17 should be at least  $\frac{1}{4}$  of the wave length of the energy flowing in the waveguide and preferably their width should be in the neighborhood of  $\frac{1}{4}$  of a wave length.

The amount of attenuation of microwave energy in a 50 waveguide through the use of an absorbing material such as "polyiron" is directly proportional to the quantity of 55

3 absorption material inserted in the guide. For this reason, block 14 is made semicircular with a diameter at its base substantially equal to the length of segment 6 to provide the maximum quantity of absorption material for insertion in the guide while allowing unobstructed rotation of segment 6.

A modification of the waveguide shutter shown in Figs. 1 and 2 is shown in Figs. 3 and 4 wherein the block of energy absorbing material 19 has a planform shape which is approximately a 90° segment of a circle. This configuration, while not providing as large a quantity of absorbing material for attenuating the energy in the waveguide, operates very efficiently, particularly at the lower microwave frequencies, because energy leakage into shutter housing 20, when the shutter is in the closed position as shown in Fig. 4, can be more effectively eliminated. In the modified shutter, the length of opening 21 in the narrow side of waveguide 22 is substantially equal to the wide dimension of the waveguide. The block of energy absorbing material 19 is secured to an L-shaped metal base 23 by means of a positioning dowel 24 and a bolt 25 which threadedly engages leg 26 of base 23. The base is swingably carried by a shaft 27 for free movement between the open and closed positions shown in Figs. 3 and 4, respectively, for selectively attenuating the energy traveling in the waveguide in the direction indicated by arrow 31. Shaft 27 is secured to leg 26 and spaced from the point of intersection of leg 26 with the other leg 28 of base 23 so that when the shutter is rotated approximately 90°, to the closed position, leg 28 is spaced from the waveguide as shown in Fig. 4. This avoids the possibility of leg 28 contacting waveguide 22 even with large dimensional tolerances and fills opening 21 with absorbing material to effectively prevent energy leakage around the shutter through housing 20.

Leg 26 of base 23 serves to close opening 21 in the narrow wall of the waveguide when the shutter is in the open position in the same manner that segment 6 closes opening 7 in the configuration shown by Figs. 1 and 2. Instead of using flanges as segment 6 does to negative the effects of the gaps by producing a low impedance path, base 23 is made sufficiently thick to serve the same function without the use of flanges.

A rectangular notch 29 is formed in base 23 at the point of intersection of the legs 26 and 28 which allows waveguide wall 30 to serve as a stop to limit the movement of the shutter and also to reduce the air gap between the waveguide and the shutter when the latter is in the open position.

The operation of the waveguide shutter shown in Figs. 1 and 2 is believed obvious from a reading of the foregoing description. When the shutter is in the open position shown in the drawing, energy will flow through the waveguide with substantially the same efficiency as with a continuous guide having no discontinuities. When it is desired to stop the flow of energy through the waveguide, actuation of a pinion drive means 18 is effected to cause rotation of segment 6 through shaft 11 for a full 180° causing the block of energy absorption material 14 to be inserted in the waveguide passage. The energy flowing in the guide thus contacts the absorption material which causes a very high dissipation of such energy to produce an attenuation in the power level of well over 80 decibels. To again allow the transmission of energy through the waveguide it is only necessary to rotate segment 6 through a second 180° segment to position the absorbing material outside the waveguide and close opening 7.

The operation of the shutter shown in Figs. 3 and 4 is similar to that previously described for the configuration shown by Figs. 1 and 2, except that maximum attenuation is obtained with only 90° of shutter rotation.

It is to be understood that certain alterations, modifications and substitutions may be made to the instant dis-

closure without departing from the spirit and scope of this invention as defined by the appended claims.

We claim:

1. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a rectangular waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having a pair of narrow and a pair of wide walls, one of said narrow walls having a segment thereof rotatable relative to the waveguide about an axis located medially of the segment and arranged generally parallel with said narrow wall and transversely of said waveguide, said segment having an inner and outer surface and a length no greater than substantially twice the wide dimension of said waveguide 10 whereby rotation of the segment is unobstructed by said waveguide, a semicircular block of microwave absorbing material secured at its base to the outer surface of the waveguide segment, the thickness of said semicircular block being substantially equal to the width of said narrow 15 walls, and means connecting with said waveguide segment for rotating the latter to insert said absorbing material into said waveguide for attenuating the microwave energy flowing therein.

2. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a section of rectangular waveguide, said waveguide having a generally rectangular opening formed in one wall thereof, the length of said opening being substantially twice the width of the walls adjoining said one wall, the width of 20 said opening being substantially equal to the width of said one wall, a generally rectangular metallic plate substantially the size of said opening carried by said waveguide for closing said opening, said metallic plate being rotatable about an axis located medially of said plate and arranged generally parallel with said one wall and normal to said waveguide, a semicircular block of microwave absorbing material secured to one side of said plate, and means for rotating said plate whereby said absorbing material is removably inserted into said waveguide for 25 closing the same and attenuating the energy flowing therein.

3. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a rectangular waveguide defining a hollow passage for the transmission of microwave energy, a semicircular block of microwave absorbing material secured to one wall of said waveguide 45 on the exterior thereof, the radius of said block being substantially equal to the width of the adjoining walls, the thickness of said block being substantially equal to the width of said one wall, the portion of said one wall contiguous with said semicircular block being rotatable relative to said waveguide about an axis located medially of said portion and arranged parallel with said one wall and normal to said waveguide for selectively inserting said 50 absorbing material into said waveguide to attenuate the energy flowing therein, and means connecting with said portion of the waveguide for rotating the same.

4. A waveguide shutter for attenuating microwave energy flowing in a waveguide defining a hollow passage 60 for the transmission of microwave energy, said waveguide having an opening formed in one wall thereof, a metallic plate swingably carried by said waveguide for closing said opening and effectively forming an uninterrupted path for the flow of electrical energy within the waveguide, a block of microwave absorbing material secured to said plate on the exterior surface thereof, and means for swinging said plate whereby said absorbing material is inserted within said waveguide for attenuating the flow of energy therethrough.

5. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a generally rectangular waveguide having a pair of narrow and a pair of wide walls, a segment of one of the narrow walls being rotatable relative to said waveguide about an axis located medially of said segment and arranged generally

parallel to said narrow walls and transversely of said waveguide, said segment being substantially rectangular in shape wherein the length thereof is twice the width of said wide walls and the width thereof is substantially equal to the width of said narrow walls, laterally extending flanges formed on said segment at the longitudinal edges thereof for substantially eliminating the electrical discontinuity in the waveguide caused by the gaps between said segment and the adjacent waveguide walls, and a block of microwave energy absorbing material secured to said segment on one side thereof contiguous with said flanges for movement into and out of said waveguide in response to rotation of said segment for selectively attenuating the microwave energy flowing in the waveguide.

6. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow waveguide for conducting microwave energy, said waveguide having an opening formed therein, a door swingably carried by said waveguide for closing said opening, a housing secured to said waveguide and forming an enclosed cavity contiguous with said door, a block of microwave energy absorbing material secured to the outer surfaces of said door within said cavity, means for selectively swinging said door from a position allowing transmission of energy through said waveguide to an attenuating position inserting said block of absorbing material into said waveguide, and flanges projecting laterally from said door and cooperating with said housing for minimizing the electrical discontinuity between said door and said waveguide.

7. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a generally rectangular waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having a pair of narrow and a pair of wide walls, one of said narrow walls having a segment rotatable relative to the waveguide about an axis located medially of the segment and arranged generally parallel with said narrow wall and transversely of said waveguide, said segment having inner and outer surfaces and a length substantially equal to twice the wide dimension of said waveguide, a semicircular block of microwave energy absorbing material secured at its base to the outer surface of said segment, the thickness of said block being substantially equal to the narrow dimension of said waveguide and the radius thereof being substantially equal to the wide dimension of said waveguide whereby rotation of said segment a half revolution will position said block within said waveguide and close said passage to attenuate the flow of energy therethrough, wall projections carried by said waveguide and projecting outwardly adjacent said segment in a direction generally parallel with said wide walls, and laterally extending flanges carried by said segment on the outer surface thereof and cooperating with said wall projections to minimize the electrical discontinuity between said segment and the adjacent waveguide walls, the width of said projections and flanges being at least  $\frac{1}{4}$  of the wave length of the energy in the waveguide.

8. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a generally rectangular waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having a pair of narrow and a pair of wide walls, one of said narrow walls having a segment rotatable relative to the waveguide about an axis located medially of the segment and arranged generally parallel with said narrow wall and transversely of said waveguide, said segment having inner and outer surfaces and a length no greater than twice the wide dimension of said waveguide, a semicircular block of microwave energy absorbing material secured at its base to the outer surface of said segment, the thickness of said block being substantially equal to the narrow dimension of said waveguide and the radius thereof being no greater than the wide dimension of said waveguide whereby said segment may be freely rotated to position said block within said waveguide to close said passage

and attenuate the flow of energy therethrough, a housing carried by said waveguide and forming a closed cavity adjacent said segment for receiving said block of energy absorbing material, and laterally extending flanges carried by said segment on the outer surface thereof for cooperating with said housing to minimize the electrical discontinuity caused by the gap between said segment and said waveguide.

9. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow rectangular waveguide for conducting microwave energy having a pair of narrow and a pair of wide walls, one of said narrow walls having an opening formed therein, the width of which is substantially equal to the narrow dimension of said waveguide and the length of which is at least equal to the wide dimension of said waveguide, a door swingably carried by said waveguide for closing said opening, a housing secured to said waveguide and forming an enclosed cavity contiguous with said door, a block of microwave energy absorbing material secured to the outer surface of said door within said cavity, and means for selectively swinging said door from a position closing said opening and allowing transmission of energy through said waveguide to an attenuating position closing said opening and inserting said block of absorbing material into said waveguide.

10. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow rectangular waveguide for conducting microwave energy having a pair of narrow and a pair of wide walls, one of said narrow walls having an opening formed therein, the width of which is substantially equal to the narrow dimension of said waveguide and the length of which is at least equal to the wide dimension of said waveguide, a door swingably carried adjacent one end thereof by said waveguide for closing said opening, a housing secured to said waveguide and forming an enclosed cavity contiguous with said door, the thickness of said door adjacent the longitudinal edges thereof being at least  $\frac{1}{4}$  of the wave length of the energy flowing in the waveguide to effectively close the air gap of the opening between said door and said waveguide, a block of microwave absorbing material secured to the outer surface of said door within said cavity, the width of said block of absorbing material as measured perpendicular to the plane of said door tapering from a maximum adjacent one end of said door to a minimum adjacent the opposite end thereof whereby inward swinging movement of said door will freely admit said block of absorbing material into the waveguide passage through said opening, the thickness of said block of absorbing material being substantially equal to the narrow dimension of said waveguide whereby movement thereof into the waveguide passage by rotating said door will substantially completely close both the waveguide passage and the opening for attenuating microwave energy, and actuating means connecting with said door for selectively swinging the same from a position closing said opening and allowing transmission of energy through said waveguide to an attenuating position closing said opening and inserting said block of absorbing material into said waveguide.

11. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow rectangular waveguide for conducting microwave energy having a pair of narrow and a pair of wide walls, one of said narrow walls having an opening formed therein, the width of which is substantially equal to the narrow dimension of said waveguide and the length of which is at least equal to the wide dimension of said waveguide, a door for closing said opening, a hinge carried by said door and spaced from either end thereof a distance no greater than the wide dimension of said waveguide and connecting with said waveguide for allowing swinging movement of the door into the waveguide passage, a housing secured to said waveguide and forming an enclosed cavity con-

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tiguous with said door, a block of microwave absorbing material secured to the outer surface of said door within said cavity, the maximum radial length of said block as measured from the axis of said hinge being no greater than the wide dimension of said waveguide whereby inward swinging movement of said door will freely admit said block of absorbing material into the waveguide passage through said opening, the thickness of said block of absorbing material being substantially equal to the narrow dimension of said waveguide whereby movement 10 thereof into the waveguide passage by rotating said door will substantially completely close both the waveguide passage and the opening for attenuating microwave en-

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ergy, and actuating means connecting with said door for selectively swinging the same from a position closing said opening and allowing transmission of energy through said waveguide to an attenuating position closing said opening and inserting said block of absorbing material into said waveguide.

## References Cited in the file of this patent

## UNITED STATES PATENTS

2,588,934	Miller	Mar. 11, 1952
2,629,048	Dyke et al.	Feb. 17, 1953
2,646,551	Roberts	July 21, 1953

60 A  
Defendant's Exhibit 1C

704770 DIV. 69

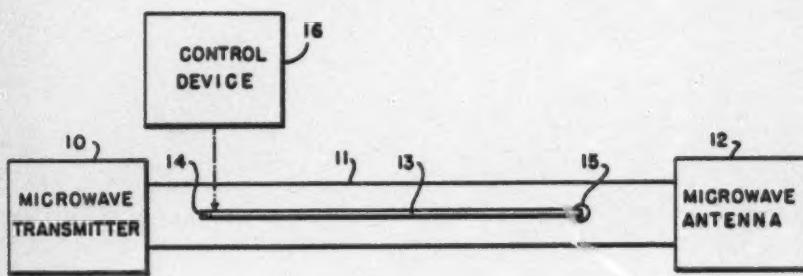


FIG.1

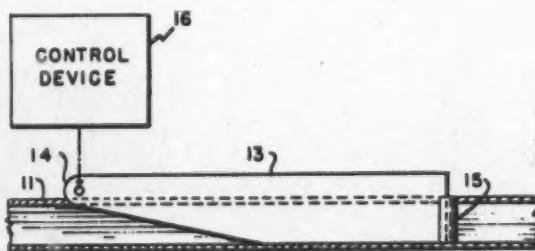


FIG.2

**Defendant's Exhibit 1D**

**U. S. DEPARTMENT OF COMMERCE  
UNITED STATES PATENT OFFICE  
Washington**

**Appeal No. 29098**

**Before the Board of Appeals**

**Paper No. 11**

**In re application of**

**Robert Regis**

**Ser. No. 704,770**

**Filed December 23, 1957**

**For MICROWAVE SWITCH**

**Mailed Nov. 10, 1959—Pat. Div. 65**

**Mr. Laurence B. Dodds for Appellant**

**Examiner's Answer**

This is an appeal from the final rejection of claims 1-3. No claims are allowed.

A correct copy of the appealed claims appears on page 1a of the applicant's brief.

The references of record relied on are:

Carlson 2,491,644 Dec. 20, 1949

Wallace et al. 2,822,526 Feb. 4, 1958  
(Filed Mar. 24, 1954)

A description of the claimed switch, of the devices shown in the references and the application of the references to the claims are not believed to be necessary for the following reason. The instant appeal raises only a question of law, namely whether or not the two references, one of which was copending with the instant application, may be combined in the holding that claims

1-3 are unpatentable. The rejection was on one patent issued on an application filed prior to the filing date of the instant application, but issued subsequent to such date, in view of a second patent issued prior to the filing date of the instant application. Appellant concedes that if these two patents are available for use as references that can be combined, their combination negatives patentability on the claim. This concession is expressed in the brief in the sentences on page 2, lines 14-19, as follows:

"There is no need to discuss the actual disclosures of Wallace et al. and Carlson in view of the arguments which follows. Suffice it to say that Examiner asserts that it is possible to combine them as an engineering matter to arrive at applicant's invention. We shall accept the assertion as valid for purposes of argument".

*The facts to this issue are as follows:*

- (1) The Carlson patent was issued prior to the filing date (December 23, 1957) of the present application, while the Wallace et al. patent issued after the filing date of the present application, but was filed (March 24, 1954) earlier than the present application.
- (2) The two patents are to inventors different from the one in the present application and no common assignment is apparent.
- (3) Applicant has not sworn back of either reference under the provision of Rule 131.
- (4) In utilizing the Carlson and Wallace et al. patents as references the Examiner followed the instruction set forth in the third paragraph of Section 706.02 of the Manual of Patent Examining Procedure, as supported by the decisions cited therein and also the decision of *In re Gregg*, 1957 C.D. 284.

Applicant's arguments have been considered, but are not seen as being persuasive as to the alleged intent of

the Patent Act of 1952. It appears to have been well settled law prior to the 1952 Patent Act that co-pending patents having valid effective dates takes singly or in combination, were available as references and that nothing in the Patent Act of 1952 effected a change in this procedure. For authority as to this conclusion, the Examiner cites the following Board of Appeals decisions:

Ex parte Teague and De Padova 108 U.S.P.Q. 380,  
Ex parte Machlarski (sic) 111 U.S.P.Q. 459,  
Ex parte Kuzmitz 113 U.S.P.Q. 255.

In each of the above cases, substantially the same arguments as advanced in applicant's brief were raised, and in each case, it was held that the Patent Act of 1952 did not change the established policy of utilizing co-pending patents having valid effective dates as references.

In addition the following statement by the Court of Customs and Patent Appeals (In re Gregg 1957 C.D. 284) appears to be directly in point and is quoted in its entirety.

"We are unable to agree with appellant that the prior art referred to in section 103 of the 1952 Act is limited to art which was available to the public prior to the date of the applicant's invention. The section clearly does not make any express statement to that effect, and no reason appears for reading such a limitation into it. It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. In re Seid, 34 C.C.P.A. (Patents) 1039, 161 F. 2d 229, 73 USPQ 431, and cases there cited. There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952."

For the above reasons, the Carlson and Wallace et al. patents are believed to be properly combined. Therefore, since applicant does not otherwise contend that these references are not applicable to claims 1-8, the rejection of these claims is considered proper and should be affirmed.

Respectfully submitted,

/s/ J. E. Sax  
Examiner, Div. 65

HSH  
HSHertz:ap

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, N.Y.

Defendant's Exhibit 1E

Paper No. 16

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

BEFORE THE BOARD OF APPEALS

Mailed Mar. 28, 1962

U. S. Patent Office, Board of Appeals

*Ex parte* Robert Regis

Application for Patent filed December 23, 1957, Serial No. 704,770. Microwave Switch.

Messrs. Laurence B. Dodds, Edward A. Ruestow, and Andrew L. Ney for appellant.

Before McCann, Kreek and Keely, Examiners-in-Chief. Keely, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1, 2 and 3, all the claims now in the case.

Claim 1 is representative and reads as follows:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

The references relied upon are:

Carlson 2,491,644 Dec. 20, 1949

Wallace et al. 2,822,526 Feb. 4, 1958

The rejected claims relate to a microwave switch which

is adequately described in appellant's brief to which reference is made.

The claims stand rejected as being unpatentable over Wallace et al. in view of Carlson.

It is asserted by the Examiner that appellant has conceded that if the patent to Wallace et al. is available as a reference then it may be combined with Carlson and that the combination negatives invention in the instant case.

It is the position of the Examiner that prior to the 1953 (sic) Patent Act copending patents either singularly or in combination were valid references. He contends that said Act has not changed this situation and he cites our decisions *Ex parte* Teague et al., 108 USPQ 380; *Ex parte* Machlanski, 111 USPQ 459; and *Ex parte* Kuzmitz, 113 USPQ 255 as well as the Court of Customs and Patent Appeals decision in *In re* Gregg, 44 CCPA 904, 1957 C.D. 284, 720 O.G. 227, 244 F.(2d) 316, 118 USPQ 526 as supporting his position.

Appellant challenged the rejection contending that Wallace et al. is not prior art and for this reason cannot be combined with Carlson.

It is urged by appellant that 35 U.S.C. 102 requires that an appellant must be granted a patent unless one of the prohibitions of the seven sub-paragraphs of this section applies. He considers sub-paragraphs (a), (e) as being the only ones applicable. Pointing to the term "the invention" of these paragraphs he argues that the quoted term requires that his complete device must be found in a single reference before Section 102 is applicable.

He submits that his arguments are fortified by the terms of 35 U.S.C. 103, which uses the following language in referring to 35 U.S.C. 102,

" . . . not identically disclosed or described as set forth in section 102. . . ."

He concludes that Section 102 restricts the prior art to a single reference, and that Section 103 was intended to supply the only exception.

Turning next to Section 103, he urges that if this Section relates to copending patents then it would be in conflict with Section 102(e) and the latter would be unnecessary. He contends that such an interpretation of the statutes is improper and that Section 102(e) is to stand alone in relation to copending patents.

He considers that his reasoning that Section 103 is inapplicable to copending patents is reinforced by Section 122 which requires that patent applications be kept in secrecy, as well as by numerous decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available until the patent issues.

We have reviewed the pertinent sections of the statutes and case law in the light of the Examiner's and appellant's remarks and as a result of our review are in full accord with the position of the Examiner.

It appears to us that the issues raised by appellant have been decided by the Court of Customs and Patent Appeals in *In re Gregg* as well as by us in our previous decisions cited above.

The arguments in appellant's brief appear to be pointless. On page 6, appellant admits that 35 U.S.C. 102(e) enacts the rule of *Milburn Co. v. Davis Bouronville Co.*, 1926 C.D. 303, 344 O.G. 817, 270 U.S. 390, which held that a patent was a reference for what it disclosed as of its filing date.

It is obvious that Wallace et al., as of his filing date, had the structure necessary for modification in the light of Carleton to achieve the disputed claimed structure. Appellant has admitted that the modification is obvious.

Under these circumstances the claimed structure was obviously within the grasp of Wallace et al. about three years and nine months prior to appellant's entry into the field.

Section 103, as we view it, concerns itself only with the circumstances under which a reference that is not anticipatory of the claimed device or method may be used. This section complements sub-paragraphs (a), (b), (e) and (g) of 102 without indicating the type of evidence which will be used to establish obviousness, the qualification of the evidence being found in other sections of the statute and pertinent case law, as for example the cases cited above.

Accordingly, we will sustain the rejection of the claims.

We have carefully considered the contentions and arguments presented in appellant's brief but we are of the opinion that the Examiner's rejection was proper and it will be sustained.

The decision of the Examiner is affirmed.

**AFFIRMED**

/s/ L. P. McCann  
Examiner-in-Chief

/s/ Louis F. Kreek  
Examiner-in-Chief

/s/ J. E. Keely  
Examiner-in-Chief  
Board of Appeals

Laurence B. Dodds  
59-25 Little Neck Parkway  
Little Neck 62, New York

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION

No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,  
*Plaintiffs,*  
vs.

DAVID L. LADD, Commissioner of Patents,  
*Defendant.*

(Filed Feb. 14, 1964)

OPINION

This civil action was brought pursuant to 35 U.S.C. 145 to obtain judgment authorizing the defendant, Commissioner of Patents, to issue a patent containing claims 1 to 3 of an application Serial No. 704,770 filed December 23, 1957, by the co-plaintiff, Robert Regis. The invention relates to microwave switches.

The tribunals of the Patent Office rejected the claims as unpatentable over the Wallace et al patent No. 2,822,526, in view of the Carlson patent No. 2,491,644. Counsel for plaintiffs concedes that if Wallace et al is available as "prior art" under 35 U.S.C. 103, the combination of Wallace et al with Carlson negates the patentability of the claims. Thus, the sole issue before this Court is whether the Wallace et al patent is "prior art" within the meaning of that term as used in 35 U.S.C. 103.

Counsel for plaintiffs strongly contend that since Wallace et al was a "copending patent",<sup>1</sup> it is "prior art" only with regard to 35 U.S.C. 102(e),<sup>2</sup> and not with regard to 35 U.S.C. 103.<sup>3</sup> If that contention is correct, the judgment here must be in favor of the plaintiffs since neither the Wallace et al patent, nor the Carlson patent alone anticipates the invention described in the claims in suit.

Before specifically considering plaintiffs' contention, it may be noted that prior to the 1952 Patent Act, the Supreme Court in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, recognized that "copending patents" could be used to invalidate the claims involved in the infringement suit even though none of those patents anticipated the claims.

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<sup>1</sup> Although this term is indefinite, it will be used hereinafter to designate patents issued on applications filed *before*, but issuing *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable. For instance, in this case the Wallace, et al application was filed on March 24, 1954, the Regis application was filed on December 23, 1957, and the Wallace, et al application matured into a patent on February 4, 1958.

<sup>2</sup> This paragraph is a codification of the rule of the first important case in this area, *Alexander Milburn v. Davis-Bournonville*, 270 U.S. 390. Revisor's Note—35 U.S.C.A. 102.

The paragraph reads as follows:

"A person shall be entitled to a patent unless—

\* \* \* \*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the application (sic) for patent, . . . ."

<sup>3</sup> The pertinent portion of this section reads as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention having ordinary skill in the art . . . ." (sic)

Moreover, in this Circuit, it was well settled that "copending patents", either singly or in combination with other "copending patents", or other patents, or both, are available as references to show that the claimed advance over the prior art required only the exercise of the skill of the art. *Sherwin-Williams Co. v. Marzall*, 190 F.2d 606, 89 U.S.P.Q. 208 (D.C. Cir. 1951); *Dyer v. Coe*, 125 F.2d 192, 52 U.S.P.Q. 52 (D.C. Cir. 1941), and *Minnesota Mining & Manufacturing Co. v. Coe*, 100 F.2d 429, 38 U.S.P.Q. 513 (D.C. Cir. 1938). But see *Hazeltine Corp. v. Coe*, 87 F.2d 558, 31 U.S.P.Q. 405 (D.C. Cir. 1936).<sup>4</sup>

The Court of Customs and Patent Appeals had also consistently held that "copending patents" were available as references. *In re Downs*, 45 F.2d 251, 7 U.S.P.Q. 316 (C.C.P.A. 1930); *In re Seid*, 161 F.2d 229, 73 U.S.P.Q. 431 (C.C.P.A. 1947), and *In re Youker*, 77 F.2d 624, 25 U.S.P.Q. 421 (C.C.P.A. 1935).

Thus, prior to the Patent Act of 1952, it is clear that as far as the Patent Office and this Court were concerned, a "copending patent" could be used as evidence to show that claims are unpatentable because the differences between the claims' subject matter and the disclosure of the "copending patent" were within the ingenuity and skill possessed by an ordinary mechanic acquainted with the art.

Counsel for plaintiffs contends that the Patent Act of 1952 changed this area of the law. More specifically,

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<sup>4</sup> It should be noted that *Minnesota Mining & Manufacturing Co.*, *supra*, and *Dyer*, *supra*, both distinguish the *Hazeltine* case by stating that it "merely held that . . . (since) all of the copending references relied upon therin failed, either singly or in combination to disclose the claims of the later applicant, they did not prevent the issuance of a patent to him as the first inventor. (Furthermore) . . . the Court held, on the merits, that the facts of that case clearly revealed invention." At 100 F.2d 429, 432.

counsel states that since 35 U.S.C. 103 sets forth that "a patent may not be obtained . . . if the difference between the (claimed) subject matter . . . and the prior art . . . would have been obvious *at the time the invention was made . . .*", (Emphasis added), a "copending patent" may not be considered a part of the prior art under Section 103 because "at the time the invention was made" the disclosure therein was not publicly available knowledge due to requirements of 35 U.S.C. 122.

However, counsel for plaintiffs overlooks the fact that "Section 103 . . . is not concerned with the psychological aspects of inventing, but rather with the legal concepts involving hypothetical situations in which the prior art is assumed to include those things dealt with in Section 102". *In re Kander*, 312 F.2d 834, 136 U.S.P.Q. 477 (C.C.P.A. 1963). In other words, that section contemplates an objective standard of patentability, and "the inventor may indeed have made an invention in the psychological sense, but it would nevertheless not be patentable if the quantum of novelty over the prior art material of which he may have been in total ignorance was not sufficient". Federico, *Commentaries On The New Patent Act*, 35 U.S.C.A., at p. 21. Thus, where the technology in a particular art has developed to such a state that "a person having ordinary skill in the art" would find that a certain invention was obvious in view of this state of the art, the invention is not patentable regardless of whether or not it would have been possible for that particular inventor to know the entire state of the art.

Therefore, in view of the fact that the "prior art" under 35 U.S.C. 103 is not limited to materials which an inventor knows or could reasonably be expected to know, the question of whether a copending patent is to be considered a part of the "prior art" under 35 U.S.C. 103 is a matter of policy. Because of the fact that the policy,

the case law, prior to the 1952 Act was to include "copending patents" in the prior art in situations analogous to those now covered by Section 103, it is the opinion of the Court that there would have to be clear, unmistakable language in the Patent Act of 1952, or in its legislative history\* before a Court would be warranted in holding that "copending patents" are not "prior art" under 35 U.S.C. 103.

The Court has not found, nor has Counsel for plaintiffs directed its attention to any such language. The Patent Act is unclear on this point; however, the legislative history noted by the Court indicates that the draftsmen of the 1952 Act intended to have "copending patents" be considered as part of the prior art under Section 103. See *Legislative History—Title 35, United States Code* in 2 U. S. Code Cong. & Ad. News, at p. 2399. Moreover, one of the draftsmen\* of the 1952 Act, states that "the antecedent of the words 'the prior art' (in 35 U.S.C. 103), . . . lies in the phrase 'disclosed or described as set forth in Section 102', and hence these words refer to material specified in Section 102 as the basis for comparison." Federico, *Commentary On The New Patent Act*, 35 U.S.C.A., p. 20.

While neither the Supreme Court nor the Court of Appeals in this Circuit have ruled on this specific point, the Court of Customs and Patent Appeals has held that the term "prior art" in 35 U.S.C. 103 is assumed to include "copending patents". *In re Gregg*, 244 F.2d 316, 113 U.S.P.Q. 526 (C.C.P.A. 1957), and *In re Kander*, supra. That Court in *In re Gregg*, supra, stated:

"It was well settled prior to the 1952 Act that a patent issued on an application which was copending

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\* See generally, Rich, *Congressional Intent, or, Who Wrote The Patent Act of 1952?*, in *PATENT PROCUREMENT AND EXPLOITATION* 61 (BNA 1963).

\* *Ibid.*

with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. (Citation omitted.) There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952." At p. 318.

In view of the above, the Court holds that the Patent Act of 1952 did not change the prior law and that "copending patents" are included in the "prior art", as that term is used in 35 U.S.C. 103.

Counsel for plaintiffs has also contended that if this Court holds, as it has above, that copending patents are prior art under Section 103, Section 102(e) will be rendered meaningless because there would be no need for it. That contention is not sound. If it were, the same rationale would apply, for example, to the publications and patents specified in 35 U.S.C. 102(a) and (b). However, it is beyond question that such publications and patents are a part of the prior art under 35 U.S.C. 103.

Therefore, for the reasons set forth above, the Court finds for the defendant and against the plaintiff, and hereby dismisses the Complaint in this case.

The foregoing Opinion includes Findings of Fact and Conclusions of Law.

Dated: February 14, 1964.

JOSEPH R. JACKSON  
*United States District Judge*

75 A

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION  
No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,  
*Plaintiffs,*  
vs.

DAVID L. LADD, Commissioner of Patents,  
*Defendant.*

(Filed Feb. 14, 1964)

ORDER

This cause came on for trial on October 30, 1963. Upon consideration of the record herein, as well as the oral arguments and briefs which the Court accorded counsel for plaintiffs and defendant an opportunity to file, it is this 14th day of February, 1964,

ORDERED, that judgment be, and the same is hereby entered in favor of defendant, and that the Complaint be, and it is hereby dismissed, with costs to be assessed against plaintiffs.

JOSEPH R. JACKSON  
*United States District Judge*

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,  
*Plaintiffs,*  
vs.

DAVID L. LADD, Commissioner of Patents,  
*Defendant.*

NOTICE OF APPEAL

Notice is hereby given that Hazeltine Research, Inc. and Robert Regis, plaintiffs in the above-entitled action, hereby appeal to the United States Court of Appeals for the District of Columbia from the judgment entered in this action on February 14, 1964.

HAZELTINE RESEARCH, INC.  
and ROBERT REGIS

By Edward A. Ruestow  
EDWARD A. RUESTOW  
59-25 Little Neck Parkway  
Little Neck 62, New York  
*Attorney for Plaintiffs*

/s/ George R. Jones  
GEORGE R. JONES  
BEALE AND JONES

425 Thirteenth Street, N.W.  
Washington, D.C. 20004  
Telephone NAtional 8-4304  
*Attorney for Plaintiffs*

**CERTIFICATE OF SERVICE**

I, George R. Jones, counsel for Hazeltine Research, Inc. and Robert Regis, hereby certify that, on the 12th day of March, 1964, I served the foregoing "Notice of Appeal" upon the Commissioner of Patents, United States Patent Office, Washington 25, D. C., by leaving a copy thereof with the clerk or person in charge at the office of the Solicitor of the United States Patent Office, Commerce Building, Washington 25, D. C.

/s/ George R. Jones  
GEORGE R. JONES

Service acknowledged  
March 12, 1964

/s/ C. W. Moore  
C. W. MOORE, Solicitor  
United States Patent Office  
*Attorney for Defendant*

\* \* \* \* \*  
STATEMENT OF POINTS UNDER RULE 15

Under the provisions of Rule 15 of this Court, Appellants state the following as the points on which they intend to rely on appeal:

1. That the District Court erred in not ruling as a matter of law that a "copending patent"\*\* is not prior art within the meaning of 35 USC 103; and that a "copending patent" is available as a bar to an application only if it describes the invention of that application as provided in 35 USC 102(e).
2. That consequently the District Court erred in not ruling that the Wallace, et al patent No. 2,822,526, as a "copending patent", is not evidence of the prior art under 35 U.S.C. 103 and therefore may not be combined with

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\* Using the District Court's definition as follows found in footnote 1 of its opinion:

"Although this term is indefinite, it will be used herinafter to designate patents issued on applications filed *before*, but issuing *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable. For instance, in this case the Wallace, et al application was filed on March 24, 1954, the Regis application was filed on December 23, 1957, and the Wallace, et al. application matured into a patent on February 4, 1958."

\*\*\*

Carlson patent No. 2,491,644 to bar appellants' application Serial No. 704,770 here in issue.

Respectfully submitted,

April 23, 1964

/s/ George R. Jones  
GEORGE R. JONES  
BEALE AND JONES  
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Telephone - NAtional 8-4304  
*Attorney for Appellants*

*Of Counsel:*

EDWARD A. RUESTOW  
59-25 Little Neck Parkway  
Little Neck 62, New York

\* \* \* \*

**STIPULATION AS TO CONTENTS OF  
JOINT APPENDIX**

It is hereby stipulated by and between counsel for the parties to the above-entitled action that the following parts of the record in this action be printed in the joint appendix in accordance with provisions of Rule 16(c) of the Rules of the United States Court of Appeals for the District of Columbia Circuit:

1. The complaint of the plaintiffs filed May 25, 1962.
2. The answer of the defendant to the complaint filed June 15, 1962.

3. Plaintiffs' exhibits offered and introduced in evidence at the trial of this action on October 30, 1963, as follows:

- (a) Plaintiffs' exhibit 1—Certified copy of the pending application for Letters Patent of Robert Regis, Serial No. 704,770, filed December 23, 1957.
- (b) Plaintiffs' exhibit 2—Copy of the unrecorded assignment of the invention of Robert Regis relating to improvements in MICRO SWITCH and the application for United States patent therefor Serial No. 704,770.
- (c) Plaintiffs' exhibit 3—Certification of the Secretary of State of the Senate of Illinois of the good standing of Hazeltine Research, Inc. as a domestic corporation of the State of Illinois.

4. Defendant's exhibit offered and introduced in evidence at the trial of this action on October 30, 1963, as follows:

- (a) Defendant's exhibit 1—
  - (A) U.S. Patent No. 2,491,644, granted December 20, 1949, to C. P. Carlson.
  - (B) U.S. Patent No. 2,822,526, granted February 4, 1958, to B. E. Wallace et al. on application Serial No. 418,334, filed March 24, 1954.
  - (C) Print of sheet of drawings (Fig. 1 and Fig. 2) from application of Robert Regis Serial No. 704,770.
  - (D) Examiner's Answer of November 10, 1959, Paper No. 11, cf application of Robert Regis, Serial No. 704,770.
  - (E) Decision of Patent Office Board of Appeals of March 28, 1962, Paper No. 16, in application of Robert Regis, Serial No. 704,770.

5. Opinion of the United States District Judge in this action filed February 14, 1964.
6. Judgment of the United States District Judge in this action filed February 14, 1964.
7. The notice of appeal in this action filed March 12, 1964.
8. The statement by the appellants under Rule 15 of the Rules of the United States Court of Appeals for the District of Columbia of the points on which they intend to rely on appeal.

March 12, 1964

/s/ George R. Jones  
GEORGE R. JONES  
BEALE AND JONES  
425 Thirteenth Street, N.W.  
Washington, D. C. 20004  
Telephone NAtional 8-4304  
*Attorney for Plaintiffs*

March 12, 1964

/s/ C. W. Moore  
C. W. MOORE, Solicitor  
United States Patent Office  
*Attorney for Defendant*

[fol. 82] [File endorsement omitted]

IN THE UNITED STATES COURT OF APPEALS  
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,563

HAZELTINE RESEARCH, INC., et al., Appellants,

v.

DAVID L. LADD, Commissioner of Patents, Appellee.

Appeal from the United States District Court for the District of Columbia.

OPINION—Decided November 25, 1964

*Mr. Edward A. Ruestow*, with whom *Mr. George R. Jones* was on the brief, for appellants.*Mr. S. William Cochran*, Attorney, United States Patent Office, with whom *Mr. C. W. Moore, Solicitor*, United States Patent Office, was on the brief, for appellee.

Before Bastian, Wright and McGowan, Circuit Judges.

PER CURIAM: The question involved in this case is whether a copending patent is part of the "prior art" within the meaning of that term as used in 35 U.S.C. §103, and whether a copending patent is a bar to a patent application only if it actually describes the invention for which patent is sought.

Having been unsuccessful in the Patent Office in their [fol. 83] application for patent, appellants [plaintiffs] filed suit in the District Court to obtain a judgment authorizing appellee [defendant], Commissioner of Patents, to issue the patent applied for by them. The District Court, after a full hearing, rendered an opinion finding for appellee and against appellants, and dismissing the complaint. *Hazelton Research, Inc. v. Ladd*, 226 F. Supp. 459 (D.D.C. 1964).

We are in agreement with the opinion of the District Court. Accordingly, it follows that the judgment of the District Court must be and is

*Affirmed.*

[fol. 84] [File endorsement omitted]

IN THE UNITED STATES COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,563—September Term, 1964

Civil 1688—62

HAZELTINE RESEARCH, INC., et al., Appellants,

v.

DAVID L. LADD, Commissioner of Patents, Appellee.

Appeal from the United States District Court for the District of Columbia.

Before: Bastian, Wright and McGowan, Circuit Judges.

JUDGMENT—November 25, 1964

This cause came on to be heard on the record on appeal from the United States District Court for the District of Columbia, and was argued by counsel.

On consideration whereof It is ordered and adjudged by this Court that the judgment of the District Court appealed from in this cause be, and it is hereby, affirmed.

Per Curiam.

Dated: Nov 25 1964.

[fol. 85]

IN THE UNITED STATES COURT OF APPEALS  
FOR THE DISTRICT OF COLUMBIA CIRCUIT  
Appeal No. 18,563

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HAZELTINE RESEARCH, INC. and ROBERT REGIS, Appellants,

v.

DAVID L. LADD, Commissioner of Patents, Appellee.

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DESIGNATION OF RECORD—Filed January 26, 1965

The Clerk is respectfully requested to prepare a certified transcript of record for use on petition to the Supreme Court of the United States for writ of certiorari in the above-entitled cause, and include therein the following:

1. Joint appendix to briefs
2. Opinion
3. Judgment
4. This designation
5. Clerk's certificate

Hazeltine Research, Inc. and Robert Regis, By  
George R. Jones, 425 Thirteenth Street, N.W.,  
Washington, D. C. 20004, NAtional 8-4304.

Edward A. Ruestow, 59-25 Little Neck Parkway, Little  
Neck 62, New York, Counsel for Appellant.

[fol. 87] Certificate of Service (omitted in printing).

Supplemental Certificate of Service—Filed February 3,  
1965 (omitted in printing).

[fol. 88] Clerk's Certificate to foregoing transcript  
(omitted in printing).

[fol. 89]

## SUPREME COURT OF THE UNITED STATES

No. 919, October Term, 1964

HAZELTINE RESEARCH, INC., et al., Petitioners,

v.

DAVID L. LADD, Commissioner of Patents.

## ORDER ALLOWING CERTIORARI—April 5, 1965

The petition herein for a writ of certiorari to the United States Court of Appeals for the District of Columbia Circuit is granted, and the case is placed on the summary calendar.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

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IN THE  
**Supreme Court of the United States**  
**October Term, 1964**

HAZELTINE RESEARCH, INC.

and ROBERT REGIS,

*Petitioners,*

*vs.*

DAVID L. LADD,  
Commissioner of Patents,

*Respondent.*

} No. -----

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE DISTRICT OF COLUMBIA**

Petitioners (Plaintiffs below), Hazeltine Research, Inc. and Robert Regis, respectfully pray that a Writ of Certiorari issue to the United States Court of Appeals for the District of Columbia to review a Judgment of that Court entered November 25, 1964, affirming a Judgment of the United States District Court for the District of Columbia entered February 14, 1964, dismissing Petitioners' Complaint, which sought a Judgment that Petitioners were entitled to receive Letters Patent on the invention claimed in claims 1, 2, and 3 of an application for United States Letters Patent Serial No. 704,770, filed December 23, 1957, and authorizing the Commissioner of Patents to issue Letters Patent to Plaintiffs on aforesaid invention, pursuant to Title 35 United States Code, Section 145 (66 Stat. 792).

## I. OPINIONS BELOW

The Opinion of the Court below appears at page 1a\* and is reported at — F. 2d — and 143 USPQ 337. The Opinion of the District Court appears at page 3A. It is also reproduced in the Joint Appendix,\*\* page 69A, and is reported at 226 F. Supp. 459 and 140 USPQ 444. The decision of the Board of Appeals of the Patent Office is reproduced at page 9A.

## II. JURISDICTION

The jurisdiction of this Court is invoked under Title 28 United States Code, Section 1254(1) (62 Stat. 928) and Title 28 United States Code, Section 2101(c) (63 Stat. 104); and under Rule 22(3) of the Rules of this Court.

The Judgment of the Court below was entered November 25, 1964.

No Petition for Rehearing was filed in the Court below and there has been no extension of time for filing this Petition. Jurisdiction of the District Court was invoked under Title 35 United States Code, Section 145 (66 Stat. 792) and under the Administrative Procedure Act of June 11, 1949, as amended (Title 5, United States Code, Section 1009).

The jurisdiction of the Court of Appeals to review the Judgment of the District Court was invoked under the provisions of Title 28 United States Code, Section 1291 (62 Stat. 869).

## III. REASONS RELIED UPON FOR GRANTING THE WRIT

1. There is a direct conflict between the decisions of the Courts of Appeals of the several Circuits on an important point of law which has not been, but should be, decided by this Court.

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\* Page numbers including the suffix "a" refer to the Appendix of this Petition.

\*\* For brevity, references to the Joint Appendix filed in the Court below are given as "JA".

2. The questions presented by this Petition recurrently arise in proceedings upon applications for Letters Patent within the United States Patent Office and in proceedings in the Courts to enforce such patents and are matters of great importance to the public.

#### IV. QUESTIONS PRESENTED

The questions presented are:

1. Whether a "copending patent",\* which is maintained in secrecy in the Patent Office until it issues, is a part of the general fund of knowledge or "prior art", as that term is used in Title 35 United States Code, Section 103, as of its filing date or as of its issue date.
2. Whether such a "copending patent", as of its filing date, is a bar to the grant of a patent or invalidates an issued patent only if it describes the entire invention of the patent application or patent in issue.

#### V. THE STATUTES INVOLVED

This Petition involves a consideration of the following statutes:

Title 35 U. S. Code, Section 102:

"§ 102. Conditions for patentability; novelty and loss of right to patent

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

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\* A "copending patent" is one issued after the filing date of a patent application or patent against which it is cited, but based upon an application filed before the patent application or patent in issue.

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

“(c) he has abandoned the invention, or

“(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

“(f) he did not himself invent the subject matter sought to be patented, or

“(g) before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.” (66 Stat. 797)

#### Title 35 U. S. Code, Section 103:

“§ 103. Conditions for patentability; non-obvious subject matter

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.” (66 Stat. 798)

**Title 35 U. S. Code, Section 122:****"§ 122. Confidential status of applications**

"Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." (66 Stat. 801)

**Title 35 U. S. Code, Section 145:****"§ 145. Civil action to obtain patent**

"An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant." (66 Stat. 803)

**VI. STATEMENT OF THE CASE**

Petitioner Robert Regis (Regis) on December 23, 1957, filed an application for Letters Patent, Serial No. 704,770, in the United States Patent Office (JA 7a-15a) for a Microwave Switch, which application was duly assigned to Petitioner Hazeltine Research, Inc. (Hazeltine) (JA 47a). All of the claims of that application were finally rejected by the Patent Office Examiner (JA 23a) "as being unpatentable over" Wallace et al Patent No. 2,822,526 (JA 54a) "in view of" Carlson Patent No. 2,491,644 (JA 50a) and

that rejection was affirmed by the Patent Office Board of Appeals (p. 9A; JA 65a).

Seeking a review of the Patent Office decisions, Petitioners, under the provisions of Title 35 U. S. Code, Section 145 (*supra*, p. 5), filed their Complaint in the District Court for the District of Columbia, seeking a Judgment that the Court authorize and direct the Commissioner of Patents to issue Letters Patent to Regis on his invention as described and claimed in his application (JA 1a).

The subject matter of the Regis patent application and the Wallace et al and Carlson patents is technically complex, but, fortunately, the issues raised on this Petition do not involve an understanding or even a consideration of such technical subject matter. Respondents in the Courts below did not contend that either of these two reference patents individually anticipates the Regis invention or precludes the grant of a patent thereon. What the Respondents below contended was that, as an engineering matter, it was obvious to combine the teachings of the Wallace et al and Carlson patents to produce the structure defined by Regis.

Petitioners' position is that the Wallace et al patent, as a matter of law, is not competent evidence to show whether or not the combination suggested by Respondents

" . . . would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ." (Title 35, U. S. Code, Section 103; *supra*, p. 4)

Petitioners' position is based on the fact that at the time Regis made his invention and filed a patent application thereon on December 23, 1957, the Wallace et al disclosure was contained solely in an application maintained in secrecy in the Patent Office in compliance with Title 35 U. S. Code, Section 122 (*supra*, p. 5). The Wallace et al disclosure, prior to its issuance on February 4, 1958, was

not available to contemporary workers in the art. That is, it was not available

" . . . at the time the invention was made to a person having ordinary skill in the art . . ." (Title 35 U. S. Code, Section 103; *supra*, p. 4)

The application for the Wallace et al patent having been filed on March 24, 1954, before Regis filed his application on December 23, 1957, but having first been made public when it issued on February 4, 1958, *after* Regis' filing date, is generally termed a "copending patent". This is consonant with the definition of the Trial Court (JA 70a; footnote 1).

## VII. ARGUMENT

### General

Section 102 of the Patent Act of 1952 (Title 35 U. S. Code 102; *supra* pp. 3-4) contains the basic provisions of the Patent Laws setting forth the conditions precedent to the grant of a patent. That Section states that "A person shall be entitled to a patent unless" certain bars exist. Respondents in the Courts below did not contend that the grant of a patent to Regis is barred by any of the circumstances set forth in this Section. The only portion of this Section 102 of possible relevance is subsection (e), reading:

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, \* \* \*"

The quoted subsection, by its explicit terms, applies only to a single copending patent in which an earlier inventor discloses "the invention"; that is, *the entire invention*—not just some part of it. Respondents in the Courts below did not contend, and the Courts did not find, that either the Wallace et al patent or the Carlson patent discloses "the invention" of Regis or that the disclosure of

either of those reference patents alone rendered the Regis claims unpatentable.

However, Section 103 of the Act (Title 35 U. S. Code, Section 103; *supra*, p. 4) is effectively a caveat to Section 102. It sets forth the criteria for determining whether or not a claimed invention is patentable over a group of prior patents or publications or both, no individual one of which discloses or describes "the invention", that is, *the entire invention*. Such prior patents and publications make up that general fund of knowledge which is collectively referred to as the "prior art"—a term used in Section 103, but nowhere explicitly defined in the patent statutes. It is this "prior art" which is used as a yardstick in measuring the quantum of advance represented by an asserted invention to determine its patentability.

A helpful guide in the interpretation of Section 103 is found in the Report from the Committee on the Judiciary of the House of Representatives, House Report 1923, 82nd Congress, May 12, 1952. That Report, in referring to Section 103, states:

"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. *An invention* which has been made, and *which is new in the sense that the same thing* has not been made before, *may still not be patentable if the difference* between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. *It refers to the difference between the subject matter* sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented." (p. 7; emphasis added.)

Here, we have a definition of the term "prior art", that is, "meaning what was known before as described in section 102". However, this reference back to Section 102 can only be to subsection 102(a), both because that subsection is the only one referring to what "was known \*\*\* before" and because the remaining subsections are obviously inapplicable; for example, subsection (c) recites only that the inventor has abandoned his invention.

Therefore, it becomes necessary to turn back to subsection 102(a) for a definition of what "was known \*\*\* before". Again, the Committee Report is instructive:

"Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty.

"*Subsection (a)* is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public. (p. 6)\*

"Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

"No change is made in these paragraphs other than that due to division into lettered paragraphs. *The interpretation by the courts of paragraph (a)* as being more restricted than the actual language would suggest (for example, 'known' has been held to mean 'publicly known') is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of Title 35 U. S. C., 1946 ed., § 72 (R. S. 4923)." (p. 17) (Emphasis added)

In brief, the Reviser's Notes on Section 103 equate the term "prior art" to "what was known before, as described in Section 102". But again, the Reviser's Notes on Section

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\* (Quoted with approval in *Rem-Cru Titanium v. Watson* (D. D.C., 1957) 152 F.Supp. 282; 114 USPQ 529.)

102 limit what was known before to what was *publicly* known. It follows that the term "prior art" is confined to *prior public knowledge*.

Whenever patents are combined in making a rejection, it is on the authority of Section 103, and it seems clear that the combination could not be obvious "to a person having ordinary skill in the art" until such time as patents to be combined have all issued and are available to persons skilled in the art, that is, are publicly known.

The "interpretation by the Courts" that prior knowledge, referred to in Section 102, "excludes various kinds of private knowledge not known to the public", is found in an unbroken line of authorities. For example, in the early case of *Pennock and Sellers v. Dialogue* (1829) 27 U. S. 1, 18, 19, 20, this Court said:

"By the very terms of the first section of our statute, the secretary of state is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c. &c. 'not known or used before the application?' \* \* \* (Emphasis Court's)

"We think, then, the true meaning must be, not known or used by the public, before the application \* \* \*,"

and referring to an earlier English Statute:

"The use here referred to has always been understood to be a public use, \* \* \*."

The same rule was enunciated by this Court in *Gayler et al. v. Wilder* (1850) 51 U. S. 477, in considering a case based upon the Patent Act of 1836, containing the same limitation upon the grant of a patent, that is, that the invention shall be "not known or used by others":

"The act of 1836, ch. 357, Sec. 6, authorizes a patent where the party has discovered or invented a new and useful improvement, 'not known or used by others before his discovery or invention' \* \* \*"

The clause in question qualifies the words before used and shows that *by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public.*" (pp. 496-497; emphasis added)

In summary, there are, *inter alia*, three distinct and independent bars to the grant of a patent on an invention:

1. The invention was not new, having been disclosed entirely or with inconsequential variations in an issued patent or printed publication bearing a date before the invention was made (Section 102(a)) or more than one year before a patent application thereon was filed (Section 102 (b)). In this case, Respondent did not contend in the Courts below that either of the reference patents cited by the Patent Office discloses the entire invention or comes within the provisions of these sections of the Patent Statutes.

2. Although the invention was new to the applicant for a patent, the complete invention actually had been made earlier by another who had filed an application thereon in the Patent Office prior to the application in question, which later issued as a patent (copending patent; Section 102(e)). This bar to the grant of a patent is solely and exclusively on the basis that the copending patentee was the "prior inventor" under the case of *Alexander Milburn v. Davis-Bournonville* (1926) 270 U. S. 390, the decision in which was codified by Section 102 (e).

3. While the invention in question was new, the quantum of newness, measured against the "prior art" as defined above, was not sufficient to support the grant of a patent (Section 103). This is the section of the Patent Statutes on which Respondent relied in the Courts below. The controversy arises, therefore, as to whether the "prior art", meaning "what was (publicly) known before", embraces copending patents which were *not publicly known* as of the dates of their filing in the Patent Office but, on the contrary, were maintained in complete secrecy under

Section 122 of the Patent Statutes (*supra*, p. 5). This is the gravamen of the two questions presented on this Petition (*supra*, p. 3).

Unfortunately, a considerable amount of confusion is found in a number of the decisions because the lines of demarcation between the foregoing distinct and different bars to the grant of a patent, based on different sections of the Statute, have not been maintained. Particularly, the term "prior art" has been used loosely and synonymously with "anticipation" and other bars to the grant of a patent embracing evidence falling within the several subsections of Section 102 and Section 103. It is the object of the present Petition to cut away that confusion and to establish an authoritative line of demarcation between the several bars to the grant of a patent set forth in Sections 102 and 103.

**POINT 1—There is a Direct Conflict between the Decisions of the Courts of Appeals of the Several Circuits on an Important Point of Law which has not been, but should be, Decided by this Court**

Prior to the enactment of the current Patent Act in 1952, there was a legion of conflicting decisions dealing with the question of whether a copending patent is a part of the "prior art", as that term is generally defined by the authorities, as of its filing date or of its issue date. These decisions are cited hereinafter. Since the conflict arose primarily from conflicting interpretations of the decision of this Court in *Alexander Milburn v. Davis-Bournonville*, *supra*, it was initially thought that the conflict was resolved upon passage of the 1952 Patent Act (Title 35, U. S. C.), Section 102(e) of which codified the rule of that decision consonant with Petitioners' position here.

Nevertheless, even after the 1952 Patent Act, the conflict has continued unabated in direct appeals from the Patent Office to the Court of Customs and Patent Appeals; in Civil Actions against the Commissioner of Patents under

Section 145 of the Act (*supra*, p. 5) such as the instant Action; and in patent infringement litigation.

Neglecting for the moment the decisions of the lower Courts, the question of the competence of a copending patent, as of its filing date, to show the state of the prior art has received conflicting answers in the several Federal Appellate Courts. In each of the following cases, the Appellate Court has held that a copending patent is *not* embraced within the prior art as of its filing date but only as of its issue date.

**DECISIONS AFTER THE 1952 PATENT ACT:**

*Weatherhead v. Drillmaster Supply* (C. A. 7, 1955)  
227 F. 2d 98; 107 USPQ 184;  
*Helene Curtis v. Sales Affiliates* (C. A. 2, 1956)  
233 F. 2d 148;  
*John Blue v. Dempster Mill* (C. A. 8, 1960) 275  
F. 2d 668; 124 USPQ 485.

**DECISIONS BEFORE THE 1952 PATENT ACT:**

*In re Spencer* (CCPA, 1931) 47 F. 2d 806; 8 USPQ  
565;  
*Stelos Company v. Hosiery Motor-Mend* (C. A.  
2, 1934) 72 F. 2d 405; 23 USPQ 35;  
*In re Youker* (CCPA, 1935) 77 F. 2d 624; 25 USPQ  
421;  
*Hazeltine Corp. v. Coe* (C. A. D. C., 1936) 85 F. 2d  
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*In re Walker et al.* (CCPA, 1938) 99 F. 2d 976;  
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*Comolite v. Davidovicz* (C. A. 2, 1940) 111 F. 2d  
121; 45 USPQ 241;  
*Old Town v. Columbia Ribbon* (C. A. 2, 1947) 159  
F. 2d 379; 72 USPQ 57;

*Conmar v. Universal Slide* (C. A. 2, 1949) 172 F. 2d 150; 80 USPQ 108;  
*Permo v. Hudson-Ross* (C. A. 7, 1950) 179 F. 2d 386; 84 USPQ 305;  
*Industrial Wire Cloth v. United Specialties* (C. A. 6, 1951) 186 F. 2d 426; 88 USPQ 338.

Thus, the Courts of Appeals of the Second, Sixth, Seventh, and District of Columbia Circuits and the Court of Customs and Patent Appeals have held that a copending patent is not embraced within the prior art as of its filing date. In *Weatherhead v. Drillmaster, supra*, Judge Swaim stated the point succinctly:

“In *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F. 2d 379, 72 USPQ 57, the same court, in an opinion by the same judge, held that the first of copending patents was *not* prior art as to the others, and that it could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention. *This is the position taken in most modern cases in the Courts of Appeals.* *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 1 Cir., 122 F. 2d 900, 913, 51 USPQ 198, 211; *Sherwin-Williams Co. v. Marzall*, D. C. Cir., 190 F. 2d 606, 89 USPQ 208.” (Emphasis added)

Unhappily, in addition to the decisions of the Courts below in the instant Action, an impressive array of decisions of the Federal Appellate Courts have held oppositely:

DECISIONS AFTER THE 1952 PATENT ACT:

*Syracuse v. H. Daust* (C. A. 8, 1960) 280 F. 2d 377; 126 USPQ 326;  
*In re Kander* (CCPA, 1963) 312 F. 2d 834; 136 USPQ 477;  
*In re Zenitz* (CCPA, 1964) 333 F. 2d 924; 142 USPQ 158;  
*In re Harry* (CCPA, 1964) 333 F. 2d 920; 142 USPQ 164.

## DECISIONS BEFORE THE 1952 PATENT ACT:

*Denaro v. Maryland Baking* (D. C. Md., 1930) 40 F. 2d 513; 5 USPQ 400 (Affirmed *per curiam* (C. A. 4, 1931) 40 F. 2d 1074; 10 USPQ 80);

*Minnesota Mining v. Coe* (C. A. D. C., 1938) 100 F. 2d 429; 38 USPQ 513 (Cert. den. 306 U. S. 662);

*L. Sonneborn Sons v. Coe* (C. A. D. C., 1939) 104 F. 2d 230; 41 USPQ 5;

*Dyer v. Coe* (C. A. D. C., 1941) 125 F. 2d 192; 52 USPQ 52;

*Western States v. S. S. Hepworth* (C. A. 2, 1945) 147 F. 2d 345; 64 USPQ 141;

*Sherwin-Williams v. Marzall* (C. A. D. C., 1951) 190 F. 2d 606; 89 USPQ 208.

Thus, the Courts of Appeals of the Fourth and the Eighth Circuits and the later decisions of the Court of Appeals of the District of Columbia Circuit and the Court of Customs and Patent Appeals have adopted the rule that a copending patent is competent evidence of the prior art as of its filing date.

This Court should resolve this important conflict of patent law.

The Respondent, in the Courts below, urged that this Court, in *Detrola v. Hazeltine* (1941) 313 U. S. 259, decided the questions presented on this Petition. A careful examination of that decision and of the petition and briefs on which the case was submitted shows clearly that these questions were neither presented nor decided in the *Detrola* case.

While, in *Detrola*, this Court did group together previously issued and copending patents as references and said that "All constituted prior art." (p. 265), this statement is footnoted to the *Alexander Milburn* case, *supra*, which involved solely the issue of prior inventorship (now codified in Section 102(e)), not the question of the quantum

of invention over the prior art (Section 103). The intent of this Court in the *Detrola* decision is thus clear—a copending patent can properly be employed in the same manner as in the *Alexander Milburn* case to establish prior invention by another. This is borne out by an analysis of the Court's actual holding in that case, namely:

" \* \* \* that Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, notwithstanding the fact that he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor," (p. 269)

In *Old Town Ribbon and Carbon, supra*, Judge Learned Hand, a recognized authority on the patent law, rendered his decision less than six years after the *Detrola* case and unquestionably accorded the decision of this Court the respect it was due. Notwithstanding the *Detrola* case, Judge Hand stated that a copending patent was not within the prior art and could invalidate claims of the patent in suit only on the issue of prior inventorship.

In any event, even if the *Detrola* decision did hold as urged by Respondent in the Courts below, to the extent that it is inconsistent with latest Congressional action, represented by the 1952 Patent Act, it must give way to that Act.

**POINT 2—The Questions Presented by this Petition Recurrently Arise in Proceedings upon Applications for Letters Patent within the United States Patent Office and in Proceedings in the Courts to Enforce such Patents and are Matters of Great Importance to the Public**

In addition to the twenty-four decisions, cited above, in each of which was presented and decided the question of the competence of a copending patent to show the state of the prior art as of its filing date, the many decisions of

the lower Courts and the Patent Office tribunals on this very question are a clear indication of the frequency with which it arises and of its importance to the patent system as a whole. There follows a partial chronological list of decisions of lower tribunals which include rulings on the questions here presented, without regard to the nature of the ruling:

*Ex parte Thomas*, 1918 C. D.\* 11;  
*Ex parte Allen*, 1919 C. D. 105;  
*Hazeltine Corp. v. Electric Service Engineering* (S. D. N. Y., 1926) 18 F. 2d 662;  
*In re Downs and Craver* (CCPA, 1930) 45 F. 2d 251; 7 USPQ 316;  
*American Tri-Ergon et al. v. T. E. Robertson* (Sup. Ct. D. C., 1931) 11 USPQ 168;  
*Allied Metal v. Standard* (E. D. N. Y., 1932) 57 F. 2d 296; 13 USPQ 50;  
*Ex parte Bowles* (Bd. App., 1934) 24 USPQ 266;  
*Ex parte Gilbert* (Bd. App., 1935) 28 USPQ 489;  
*Ex parte Graebner* (Bd. App., 1936) 31 USPQ 288;  
*Baltimore v. Oles* (D. Md., 1936) 13 F. Supp. 951; 29 USPQ 11 (Aff'd. on other grounds (C. A. 4, 1937) 89 F. 2d 279; 33 USPQ 267);  
*Aero v. Fenwick* (S. D. N. Y., 1937) 19 F. Supp. 846; 35 USPQ 82 (Reversed on other grounds (C. A. 2, 1938) 97 F. 2d 363; 38 USPQ 153);  
*Utah Radio v. Delco* (W. D. N. Y., 1938) 24 F. Supp. 328; 38 USPQ 400;  
*Western States v. Hepworth* (E. D. N. Y., 1943) 51 F. Supp. 859; 58 USPQ 102;  
*Barnes v. International Harvester* (N. D. Ill., 1944) 51 F. Supp. 254; 58 USPQ 131;  
*Robinson Aviation v. Barry* (D. Mass., 1952) 106 F. Supp. 514; 95 USPQ 78;  
*East Rutherford Syringes v. Omega* (D. N. J., 1957) 152 F. Supp. 497; 114 USPQ 147.

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\* Decisions of the Commissioner of Patents.

### VIII. CONCLUSION

It is submitted that the decisions of the Federal Appellate Courts on the evidentiary competence of a patent issued on an application filed before, but issued after, the date of invention or the date of the application of the patent *sub judice*, are in a hopeless state of confusion and that the great number of decisions of the Appellate and Trial tribunals attest to the frequency of occurrence and the importance of this question. This Court should resolve that confusion.

Respectfully submitted,

LAURENCE B. DODDS,  
*Attorney for Petitioners.*

*Of Counsel:*

EDWARD A. RUESTOW  
GEORGE R. JONES

## APPENDIX

# UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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No. 18,563

HAZELTINE RESEARCH, INC., *et al.*, APPELLANTS

v.

DAVID L. LADD, Commissioner of Patents, APPELLEE

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Appeal from the United States District Court  
for the District of Columbia

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Decided November 25, 1964

*Mr. Edward A. Ruestow*, with whom *Mr. George R. Jones* was on the brief, for appellants.

*Mr. S. William Cochran*, Attorney, United States Patent Office, with whom *Mr. C. W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before BASTIAN, WRIGHT and McGOWAN, Circuit Judges.

PER CURIAM: The question involved in this case is whether a copending patent is part of the "prior art" within the meaning of that term as used in 35 U.S.C. § 103, and whether a copending patent is a bar to a patent application only if it actually describes the invention for which patent is sought.

Having been unsuccessful in the Patent Office in their application for patent, appellants [plaintiffs] filed suit in the District Court to obtain a judgment authorizing ap-

pellee [defendant], Commissioner of Patents, to issue the patent applied for by them. The District Court, after a full hearing, rendered an opinion finding for appellee and against appellants, and dismissing the complaint. *Hazeltine Research, Inc. v. Ladd*, 226 F. Supp. 459 (D.D.C. 1964).

We are in agreement with the opinion of the District Court. Accordingly, it follows that the judgment of the District Court must be and is

*Affirmed.*

1-4

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

---

CIVIL ACTION

No. 1688-62

---

HAZELTINE RESEARCH, INC., and ROBERT REGIS,  
*Plaintiffs,*  
**vs.**

DAVID L. LADD, Commissioner of Patents,  
*Defendant.*

(Filed Feb. 14, 1964)

**OPINION**

This civil action was brought pursuant to 35 U.S.C. 145 to obtain judgment authorizing the defendant, Commissioner of Patents, to issue a patent containing claims 1 to 3 of an application Serial No. 704,770 filed December 23, 1957, by the co-plaintiff, Robert Regis. The invention relates to microwave switches.

The tribunals of the Patent Office rejected the claims as unpatentable over the Wallace et al patent No. 2,822,526, in view of the Carlson patent No. 2,491,644. Counsel for plaintiffs concedes that if Wallace et al is available as "prior art" under 35 U.S.C. 103, the combination of Wallace et al with Carlson negates the patentability of the claims. Thus, the sole issue before this Court is whether the Wallace et al patent is "prior art" within the meaning of that term as used in 35 U.S.C. 103.

Counsel for plaintiffs strongly contend that since Wallace et al was a "copending patent",<sup>1</sup> it is "prior art" only with regard to 35 U.S.C. 102(e),<sup>2</sup> and not with regard to 35 U.S.C. 103.<sup>3</sup> If that contention is correct, the judgment here must be in favor of the plaintiffs since neither the Wallace et al patent, nor the Carlson patent alone anticipates the invention described in the claims in suit.

Before specifically considering plaintiffs' contention, it may be noted that prior to the 1952 Patent Act, the Supreme Court in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, recognized that "copending patents" could be used to invalidate the claims involved in the infringement suit even though none of those patents anticipated the claims.

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<sup>1</sup> Although this term is indefinite, it will be used hereinafter to designate patents issued on applications filed *before*, but issuing *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable. For instance, in this case the Wallace, et al application was filed on March 24, 1954, the Regis application was filed on December 23, 1957, and the Wallace, et al application matured into a patent on February 4, 1958.

<sup>2</sup> This paragraph is a codification of the rule of the first important case in this area, *Alexander Milburn v. Davis-Bournonville*, 270 U.S. 390. Revisor's Note—35 U.S.C.A. 102.

The paragraph reads as follows:

"A person shall be entitled to a patent unless—

\* \* \* \* \*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the application (sic) for patent, . . . ."

<sup>3</sup> The pertinent portion of this section reads as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention having ordinary skill in the art . . . . (sic)

Moreover, in this Circuit, it was well settled that "copending patents", either singly or in combination with other "copending patents", or other patents, or both, are available as references to show that the claimed advance over the prior art required only the exercise of the skill of the art. *Sherwin-Williams Co. v. Marzall*, 190 F.2d 606, 89 U.S.P.Q. 208 (D.C. Cir. 1951); *Dyer v. Coe*, 125 F. 2d 192, 52 U.S.P.Q. 52 (D.C. Cir. 1941), and *Minnesota Mining & Manufacturing Co. v. Coe*, 100 F.2d 429, 38 U.S.P.Q. 513 (D.C. Cir. 1938). But see *Hazeltine Corp. v. Coe*, 87 F.2d 558, 31 U.S.P.Q. 405 (D.C. Cir. 1936).<sup>4</sup>

The Court of Customs and Patent Appeals had also consistently held that "copending patents" were available as references. *In re Downs*, 45 F.2d 251, 7 U.S.P.Q. 316 (C.C.P.A. 1930); *In re Seid*, 161 F.2d 229, 73 U.S.P.Q. 431 (C.C.P.A. 1947), and *In re Youker*, 77 F.2d 624, 25 U.S.P.Q. 421 (C.C.P.A. 1935).

Thus, prior to the Patent Act of 1952, it is clear that as far as the Patent Office and this Court were concerned, a "copending patent" could be used as evidence to show that claims are unpatentable because the differences between the claims' subject matter and the disclosure of the "copending patent" were within the ingenuity and skill possessed by an ordinary mechanic acquainted with the art.

Counsel for plaintiffs contends that the Patent Act of 1952 changed this area of the law. More specifically,

<sup>4</sup> It should be noted that *Minnesota Mining & Manufacturing Co.*, *supra*, and *Dyer*, *supra*, both distinguish the *Hazeltine* case by stating that it "merely held that . . . (since) all of the copending references relied upon therein failed, either singly or in combination to disclose the claims of the later applicant, they did not prevent the issuance of a patent to him as the first inventor. (Furthermore) . . . the Court held, on the merits, that the facts of that case clearly revealed invention." At 100 F.2d 429, 432.

counsel states that since 35 U.S.C. 103 sets forth that "a patent may not be obtained . . . if the difference between the (claimed) subject matter . . . and the prior art . . . would have been obvious *at the time the invention was made . . .*", (Emphasis added), a "copending patent" may not be considered a part of the prior art under Section 103 because "at the time the invention was made" the disclosure therein was not publicly available knowledge due to requirements of 35 U.S.C. 122.

However, counsel for plaintiffs overlooks the fact that "Section 103 . . . is not concerned with the psychological aspects of inventing, but rather with the legal concepts involving hypothetical situations in which the prior art is assumed to include those things dealt with in Section 102". *In re Kander*, 312 F.2d 834, 136 U.S.P.Q. 477 (C.C.P.A. 1963). In other words, that section contemplates an objective standard of patentability, and "the inventor may indeed have made an invention in the psychological sense, but it would nevertheless not be patentable if the quantum of novelty over the prior art material of which he may have been in total ignorance was not sufficient". Federico, *Commentaries On The New Patent Act*, 35 U.S.C.A., at p. 21. Thus, where the technology in a particular art has developed to such a state that "a person having ordinary skill in the art" would find that a certain invention was obvious in view of this state of the art, the invention is not patentable regardless of whether or not it would have been possible for that particular inventor to know the entire state of the art.

Therefore, in view of the fact that the "prior art" under 35 U.S.C. 103 is not limited to materials which an inventor knows or could reasonably be expected to know, the question of whether a copending patent is to be considered a part of the "prior art" under 35 U.S.C. 103 is a matter of policy. Because of the fact that the policy, the case law, prior to the 1952 Act was to include "co-

pending patents" in the prior art in situations analogous to those now covered by Section 103, it is the opinion of the Court that there would have to be clear, unmistakable language in the Patent Act of 1952, or in its legislative history<sup>5</sup> before a Court would be warranted in holding that "copending patents" are not "prior art" under 35 U.S.C. 103.

The Court has not found, nor has Counsel for plaintiffs directed its attention to any such language. The Patent Act is unclear on this point; however, the legislative history noted by the Court indicates that the draftsmen of the 1952 Act intended to have "copending patents" be considered as part of the prior art under Section 103. See *Legislative History—Title 35, United States Code* in 2 U. S. Code Cong. & Ad. News, at p. 2399. Moreover, one of the draftsmen<sup>6</sup> of the 1952 Act, states that "the antecedent of the words 'the prior art' (in 35 U.S.C. 103), . . . lies in the phrase 'disclosed or described as set forth in Section 102', and hence these words refer to material specified in Section 102 as the basis for comparison." Federico, *Commentary On The New Patent Act*, 35 U.S.C.A., p. 20.

While neither the Supreme Court nor the Court of Appeals in this Circuit have ruled on this specific point, the Court of Customs and Patent Appeals has held that the term "prior art" in 35 U.S.C. 103 is assumed to include "copending patents". *In re Gregg*, 244 F.2d 316, 113 U.S.P.Q. 526 (C.C.P.A. 1957), and *In re Kander*, *supra*. That Court in *In re Gregg*, *supra*, stated:

"It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it

<sup>5</sup> See generally, Rich, *Congressional Intent or, Who Wrote The Patent Act of 1952?*, in PATENT PROCUREMENT AND EXPLOITATION 61 (BNA 1963).

<sup>6</sup> *Ibid.*

was necessary to combine it with other references. (Citation omitted.) There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952." At p. 318.

In view of the above, the Court holds that the Patent Act of 1952 did not change the prior law and that "copending patents" are included in the "prior art", as that term is used in 35 U.S.C. 103.

Counsel for plaintiffs has also contended that if this Court holds, as it has above, that copending patents are prior art under Section 103, Section 102(e) will be rendered meaningless because there would be no need for it. That contention is not sound. If it were, the same rationale would apply, for example, to the publications and patents specified in 35 U.S.C. 102(a) and (b). However, it is beyond question that such publications and patents are a part of the prior art under 35 U.S.C. 103.

Therefore, for the reasons set forth above, the Court finds for the defendant and against the plaintiff, and hereby dismisses the Complaint in this case.

The foregoing Opinion includes Findings of Fact and Conclusions of Law.

Dated: February 14, 1964.

JOSEPH R. JACKSON  
*United States District Judge*

## Paper No. 16

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

BEFORE THE BOARD OF APPEALS

Mailed Mar. 28, 1962  
U.S. Patent Office, Board of Appeals*Ex parte* Robert Regis

Application for Patent filed December 23, 1957, Serial No. 704,770. Microwave Switch.

Messrs. Laurence B. Jodds, Edward A. Ruestow, and Andrew L. Ney for appellant.

Before McCann, Kreek and Keely, Examiners-in-Chief. Keely, Examiner-in-Chief.

This is an appeal from the final rejection of Claims 1, 2 and 3, all the claims now in the case.

Claim 1 is representative and reads as follows:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

The references relied upon are:

Carlson	2,491,644	Dec. 20, 1949
Wallace et al.	2,822,526	Feb. 4, 1958

The rejected claims relate to a microwave switch which is adequately described in appellant's brief to which reference is made.

The claims stand rejected as being unpatentable over Wallace et al. in view of Carlson.

It is asserted by the Examiner that appellant has conceded that if the patent to Wallace et al. is available as a reference then it may be combined with Carlson and that the combination negatives invention in the instant case.

It is the position of the Examiner that prior to the 1953 (sic) Patent Act copending patents either singularly or in combination were valid references. He contends that said Act has not changed this situation and he cites our decisions *Ex parte* Teague et al., 108 USPQ 380; *Ex parte* Machlanski, 111 USPQ 459; and *Ex parte* Kuzmitz, 113 USPQ 255 as well as the Court of Customs and Patent Appeals decision in *In re Gregg*, 44 CCPA 904, 1957 C.D. 284, 720 O.G. 227, 244 F. (2d) 316, 113 USPQ 526 as supporting his position.

Appellant challenged the rejection contending that Wallace et al. is not prior art and for this reason cannot be combined with Carlson.

It is urged by appellant that 35 U.S.C. 102 requires that an appellant must be granted a patent unless one of the prohibitions of the seven sub-paragraphs of this section applies. He considers sub-paragraphs (a), (e) as being the only ones applicable. Pointing to the term "the invention" of these paragraphs he argues that the quoted term requires that his complete device must be found in a single reference before Section 102 is applicable.

He submits that his arguments are fortified by the terms of 35 U.S.C. 103, which uses the following language in referring to 35 U.S.C. 102,

"... not identically disclosed or described as set forth in section 102 . . ."

He concludes that Section 102 restricts the prior art to a single reference, and that Section 103 was intended to supply the only exception.

Turning next to Section 103, he urges that if this Section relates to copending patents then it would be in conflict with Section 102(e) and the latter would be unnecessary. He contends that such an interpretation of the statutes is improper and that Section 102(e) is to stand alone in relation to copending patents.

He considers that his reasoning that Section 103 is inapplicable to copending patents is reinforced by Section 122 which requires that patent applications be kept in secrecy, as well as by numerous decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available until the patent issues.

We have reviewed the pertinent sections of the statutes and case law in the light of the Examiner's and appellant's remarks and as a result of our review are in full accord with the position of the Examiner.

It appears to us that the issues raised by appellant have been decided by the Court of Customs and Patent Appeals in *In re Gregg* as well as by us in our previous decisions cited above.

The arguments in appellant's brief appear to be pointless. On page 6, appellant admits that 35 U.S.C. 102(e) enacts the rule of *Milburn Co. v. Davis Bournonville Co.*, 1926 C.D. 303, 344 O.G. 817, 270 U.S. 390, which held that a patent was a reference for what it disclosed as of its filing date.

It is obvious that Wallace et al., as of his filing date, had the structure necessary for modifications in the light of Carlson to achieve the disputed claimed structure. Appellant has admitted that the modification is obvious. Under these circumstances the claimed structure was ob-

viously within the grasp of Wallace et al. about three years and nine months prior to appellant's entry into the field.

Section 103, as we view it, concerns itself only with the circumstances under which a reference that is not anticipatory of the claimed device or method may be used. This section complements sub-paragraphs (a), (b), (e) and (g) of 102 without indicating the type of evidence which will be used to establish obviousness, the qualification of the evidence being found in other sections of the statute and pertinent case law, as for example the cases cited above.

Accordingly, we will sustain the rejection of the claims.

We have carefully considered the contentions and arguments presented in appellant's brief but we are of the opinion that the Examiner's rejection was proper and it will be sustained.

The decision of the Examiner is affirmed.

**AFFIRMED**

/s/ L. P. McCann  
Examiner-in-Chief

/s/ Louis F. Kreek  
Examiner-in-Chief

/s/ J. E. Keely  
Examiner-in-Chief

Board of Appeals

In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 919

HAZELTINE RESEARCH, INC., ET AL., PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA  
CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The district court's opinion (Pet. App. 3a-8a)<sup>1</sup> is reported at 226 F. Supp. 459. The opinion of the Court of Appeals for the District of Columbia Circuit (Pet. App. 1a-2a) is not yet reported.

JURISDICTION

The judgment of the Court of Appeals was entered on November 25, 1964 (R. 84). The petition for a writ of certiorari was filed on February 18, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

<sup>1</sup> "Pet. App." refers to the appendix to the petition; "Pet." refers to the petition; and "R." refers to the record filed in this Court.

**QUESTION PRESENTED**

Whether "co-pending patents" constitute a part of the "prior art", within the meaning of that term, as used in 35 U.S.C. 103.

**STATUTE INVOLVED**

Section 103 of Title 35 provides:

*Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**STATEMENT**

Petitioner, Robert Regis, filed an application for a patent on a microwave switch on December 23, 1957 (R. 9-15). Three days before, he had assigned all interests in his invention and the application to Hazeltine Research, Inc., the other petitioner in this proceeding (R. 47). On June 24, 1959, the patent examiner denied the application on the ground that the claims set forth therein were "unpatentable over" the Wallace patent, No. 2,822,526, "in view of" the Carlson patent, No. 2,491,644 (R. 23). In terms of the language of Section 103 of the patent statute, the

petitioner's application was held not to have revealed a significant advance over "the prior art."

The Wallace patent was a "co-pending patent"; that is, it had been applied for prior to petitioner's application but had not been issued until after petitioner's application.<sup>2</sup> The examiner rejected petitioner's argument that a "co-pending patent" was an improper reference to determine the state of "prior art" (R. 23a), and, on March 28, 1962, the Board of Appeals of the Patent Office affirmed the examiner's decision (Pet. App. 9a-12a).

Petitioners then instituted this action in the district court, pursuant to 35 U.S.C. 145, seeking review of the adverse administrative determination (R. 1-5). On February 14, 1964, the district court dismissed petitioners' complaint (R. 75). The court stated that "the sole issue" before it was "whether the Wallace, et al. patent is 'prior art' within the meaning of that term as used in 35 U.S.C. 103."<sup>3</sup> It held that "co-pending patents" were "included in the 'prior art', as that term is used in 35 U.S.C. 103," basing its decision both upon the legislative history of the 1952 Act and upon the fact that prior to the enactment of the 1952 Act a "co-pending patent" could be used as evidence to show that claims are unpatentable (Pet. App.

<sup>2</sup> In this case, the Wallace application was filed on March 24, 1954; the Regis application was filed on December 28, 1957; and the Wallace application matured into a patent on February 4, 1958 (Pet. App. 4a).

<sup>3</sup> Petitioners conceded that if the Wallace patent was a part of "prior art" within the meaning of 35 U.S.C. 103, then the combination of Wallace with Carlson would negate the patentability of their claims (Pet. App. 8a).

5a-8a). The Court of Appeals for the District of Columbia Circuit affirmed, *per curiam* (Pet. App. 1a-2a).

#### **ARGUMENT**

The decision of the court below is correct. While the court's holding appears inconsistent with dicta expressed by several other appellate courts, there is no conflict with the holding of any other court of appeals. We do not believe that the question presented in this case is of sufficient importance to warrant further review by this Court in the absence of a true conflict of decisions.

1. Section 103 of Title 35 was enacted as a part of the Act of July 19, 1952, P.L. 593, 66 Stat. 792, which codified Title 35 of the United States Code. That section provides, in pertinent part, that "[a] patent may not be obtained though the invention is not identically disclosed or described \* \* \* if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art \* \* \*." In the instant case, the courts have held that the term "prior art," as used in 35 U.S.C. 103, is not limited to what petitioners knew or could have known; it includes the Wallace patent, which was filed before, but issued after, petitioners' patent application. In other words, "co-pending patents" were held to be a part of the "prior art" and thus available as references for the purposes of determining the patentability of a particular invention.

We believe that this holding is correct. Prior to the 1952 Act, this Court stated, in holding a patent invalid for want of an invention over the prior art, that "co-pending patents" could be used to establish the state of the prior art. *Detrola Corp. v. Haseltine Corp.*, 313 U.S. 259. In particular, the Court sustained the defendant's argument that the subject of the infringement proceeding [the Wheeler patent] "involved no invention in view of the prior art," holding that "patents issued before Wheeler's date of conception and others issued before the patent in suit on applications antedating his date of invention and pending when his application was filed \* \* \*. All constituted prior art." 313 U.S. at 265. See also *Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390; *Sherwin-Williams Co. v. Marzall*, 190 F. 2d 606 (C.A. D.C.); *application of Seid*, 161 F. 2d 229 (C.C.P.A.). Moreover, the decisions of the courts below are in complete accord with the construction given the phrase "prior art" in Section 103 of the 1952 Act by the Court of Customs and Patent Appeals, the tribunal which regularly hears and determines patent cases. See, e.g., *Application of Harry*, 333 F. 2d 920; *Application of Kander*, 312 F. 2d 834; *Application of Gregg*, 244 F. 2d 316. Finally, the legislative history of Section 103 appears to support the view expressed by both the Court of Customs and Patent Appeals<sup>4</sup> and by the court below (Pet. App. 7a) that

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<sup>4</sup> The Court of Customs and Patent Appeals has stated that "the legislative history of the 1952 Act makes it clear that 'co-pending patents' were intended to be part of the 'prior art.'" *Application of Harry*, *supra*, at p. 923, n. 1.

Congress intended "co-pending patents" to be a part of the "prior art." See S. Rep. No. 1979, 82d Cong., 2d Sess., pp. 5-6; H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7; see also Senate Subcommittee on Patents, Trademarks and Copyrights, *Efforts to Establish a Statutory Standard of Invention*, Study No. 7, 85th Cong., 1st Sess., p. 15; Hearings before Subcommittee No. 3 of the House Committee on the Judiciary on H.R. 3760, 82d Cong., 1st Sess., p. 221.

2. Petitioners contend that the holding of the court of appeals in the instant case is in conflict with *Weathervane Co. v. Drillmaster Supply Co.*, 227 F. 2d 98 (C.A. 7); *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148 (C.A. 2), certiorari denied, 352 U.S. 879; and *John Blue Company v. Dempster Mill Mfg. Co.*, 275 F. 2d 668 (C.A. 8) (Pet. 12-16). While there are statements in each of these cases which appear inconsistent with the holding below, in each case the claim of the patent-holder was rejected and the patent held invalid on an alternative ground. The statements do indicate that those circuits have or have had a view inconsistent with that of the District of Columbia Circuit, but they do not amount to holdings in conflict with the decision below, and we do not believe that the question presented in this case is of such general importance as to warrant further review by this Court when there is no real conflict of decisions. Finally, we note that the other decisions relied upon by the petitioners on pages 13 and 14 of the petition all involve cases decided prior to the enactment of Section 103 in 1952 and are thus not constructions of the provision here under review.

**CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted.

**ARCHIBALD COX,**  
*Solicitor General.*

**JOHN W. DOUGLAS,**  
*Assistant Attorney General.*

**SHERMAN L. COHN,**  
**LAWRENCE R. SCHNEIDER,**  
*Attorneys.*

MARCH 1965.

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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1965

**No. 57**

HAZELTINE RESEARCH, INC. and ROBERT REGIS,  
*Petitioners*,  
vs.  
DAVID L. LADD, COMMISSIONER OF PATENTS,  
*Respondent.*

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**BRIEF FOR PETITIONERS**

**I. OPINIONS BELOW**

The Opinion of the Court below (R. 82) is reported at 340 F.2d 786. The Opinion of the District Court (R. 69A) is reported at 226 F.Supp. 459. The decision of the Board of Appeals of the United States Patent Office (R. 42A) is not officially reported.

**II. JURISDICTION**

The jurisdiction of this Court is invoked under Title 28 United States Code, Section 1254 (1) (62 Stat. 928) and Title 28 United States Code, Section 2101(c) (63 Stat. 104); and under Rule 22(3) of the Rules of this Court.

The Judgment of the Court below was entered November 25, 1964; the Petition herein was filed on February 18, 1965, and granted on April 5, 1965.

### III. THE STATUTES INVOLVED

This Petition involves a consideration of the following statutes:

Title 35 U. S. Code, Section 102 (66 Stat. 797):

**“§ 102. Conditions for patentability; novelty and loss of right to patent**

“A person shall be entitled to a patent unless—

“(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant, or

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

“(c) he has abandoned the invention, or

“(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

“(f) he did not himself invent the subject matter sought to be patented, or

“(g) before the applicant’s invention thereof the invention was made in this country by another

who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Title 35 U.S. Code, Section 103 (66 Stat. 798):

**"§ 103. Conditions for patentability; non-obvious subject matter**

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Title 35 U.S. Code, Section 122 (66 Stat. 801):

**"§ 122. Confidential status of applications**

"Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

Title 35 U.S. Code, Section 145 (66 Stat. 803):

**"§ 145. Civil action to obtain patent**

"An applicant dissatisfied with the decision of

the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant."

#### IV. QUESTION PRESENTED

The sole question presented is:

Whether a "copending patent",\* which is maintained in secrecy in the Patent Office until it issues, is a part of the general fund of knowledge or "prior art", as that term is used in Title 35 United States Code, Section 103, as of its *filings date* or as of its *issue date*.

#### V. STATEMENT OF THE CASE

Petitioner Robert Regis (Regis), on December 23, 1957, filed an application for Letters Patent, Serial No. 704, 770, in the United States Patent Office (R. 7A-46A) for a Microwave Switch, which application was duly assigned to Petitioner Hazeltine Research, Inc. (Hazeltine) (R. 47A). All of the claims of that application were finally

\* A "copending patent" is one *issued after* the filing date of a patent application or patent *sub judice* but based upon an application *filed before* the filing date of such patent application or patent.

rejected by the Patent Office Examiner (R. 23A) "as being unpatentable over" Wallace et al. Patent No. 2,822,526 (R. 54A) "in view of" Carlson Patent No. 2,491,644 (R. 50A) and that rejection was affirmed by the Patent Office Board of Appeals (R. 42A).

Seeking a review of the Patent Office decisions, Petitioners, under the provisions of Title 35 U.S. Code, Section 145 (*supra*, pp. 3-4), filed their Complaint in the District Court for the District of Columbia, (R. 1A) requesting a Judgment that the Court authorize and direct the Commissioner of Patents to issue Letters Patent to Regis on his invention as described and claimed in his application (R. 7A).

The subjects matter of the Regis patent application and the Wallace et al. and Carlson patents are technically complex but, fortunately, the issues raised on this Petition do not involve an understanding or even a consideration of such technical subjects matter. Respondent, in the Patent Office proceedings (R. 34A — 35A; 43A) and in the Courts below, did not contend that either of these two reference patents individually anticipates the Regis invention or precludes the grant of a patent thereon.\* What the Respondent below contended was that, as an engineering matter, it was obvious to combine the teachings of the Wallace et al. and Carlson patents to produce the structure defined by the claims of the Regis application.

Petitioners' position is that the Wallace et al. patent, as a matter of law, is not competent evidence to show whether or not the combination suggested by Respondent

"\* \* \* would have been obvious at the time the invention was made to a person having ordinary

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\*In the event that the Court should be interested in the technical subjects matter of the Regis application (R. 7A) and the Wallace et al. and Carlson patents, brief summaries of their respective disclosures are included in Appendix I to this Brief.

skill in the art to which said subject matter pertains. \* \* \* (Title 35, U.S. Code, Section 103; *supra*, p. 3)

Petitioners' position is based on the fact that at the time Regis made his invention and filed a patent application thereon on December 23, 1957, (R. 7A) the Wallace et al. disclosure was contained solely in an application maintained in secrecy in the Patent Office in compliance with Title 35, U.S. Code, Section 122 (*supra*, p. 3). The Wallace et al. disclosure, prior to its issuance on February 4, 1958, (R. 54A) was not available to Regis or to other contemporary workers in the art. That is, it was not available

" \* \* \* at the time the invention was made to a person having ordinary skill in the art. \* \* \* (Title 35, U.S. Code, Section 103; *supra*, p. 3)

The application for the Wallace et al. patent having been filed on March 24, 1954, (R. 54A) before Regis filed his application on December 23, 1957, but having first been made public when it issued on February 4, 1958, *after* Regis' filing date, is generally termed a "coperating patent". This is consonant with the definition of the Trial Court (R. 70A; footnote 1).

## VI. ARGUMENT

### GENERAL

Respondent relied in the Courts below and relies here\* solely on Title 35, U.S. Code, Section 103 (*supra*, p. 3) to support its contention that a coperating patent is a part of the prior art as of its filing date and that, therefore, the Regis invention "would have been obvious" in the light of the disclosures of the Wallace et al. coperating patent and the Carlson prior art patent and that Regis is not entitled to the grant of a patent. However, for a proper construction of this Section 103, it is necessary to

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\* Brief for Respondent in Opposition to the Petition (BR., p. 2)

consider also Section 102 (*supra*, pp. 2-3), to which reference is made in Section 103.

Section 102 of the Patent Act of 1952 (Title 35, U.S. Code 102; *supra*, pp. 2-3) contains the basic provisions of the Patent Laws setting forth the conditions precedent to the grant of a patent. That Section states that "A person shall be entitled to a patent unless" certain bars exist. Respondent, in the Courts below, did not contend that the grant of a patent to Regis is barred by any of the circumstances set forth in this Section.

It is submitted that (1) by the terms of the Patent Statutes as interpreted with the aid of their legislative history, (2) by straightforward logic, and (3) by the rules of simple fairness, a patent *issued after* the filing date of a patent application or patent *sub judice* but based upon an application *filed before* the filing date of such patent application or patent is not, as of its filing date, competent evidence of the "prior art" from which the quantum of newness or unobviousness of an asserted invention is to be measured to determine its patentability.

**POINT 1. BY THE TERMS OF THE PATENT STATUTES,  
A COPENDING PATENT IS NOT COMPETENT  
EVIDENCE OF THE PRIOR ART AS OF ITS  
FILING DATE**

Each of the subsections of Section 102 (*supra*, pp. 2-3) refers to "the invention" (i.e., the entire invention, not just some part of it) in the singular. This Section effectively bars a patent to an applicant if the evidence shows that "the invention" was not first invented by the applicant.

Section 103 (*supra*, p. 3) is effectively a caveat to Section 102. It sets forth the criteria for determining whether or not a claimed invention is patentable over a

*group* of prior patents or publications or both, no individual one of which discloses or describes "the invention", that is, *the entire invention*. Such prior patents and publications make up that general fund of knowledge available to those skilled workers in the art which is collectively referred to as the "prior art"—a term used in Section 103 but nowhere explicitly defined in the Patent Statutes. It is this "prior art" which is used as a yardstick in measuring the quantum of advance represented by an asserted invention to determine its patentability.

A helpful guide in the interpretation of Section 103 is found in the Report from the Committee on the Judiciary of the House of Representatives, House Report 1923, 82nd Congress, May 12, 1952. That Report, in referring to Section 103, states:

"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. *An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent.* That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. *It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102.* If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented." (p. 7; emphasis added)

Here we have a definition of the term "prior art", that is, "meaning what was known before as described in section 102." However, this reference back to Section 102

can only be to subsection 102(a), both because that subsection is the only one referring to what "was known \*\*\* before" and because the remaining subsections are inapplicable. For example, subsection 102(b) was recently held to have "nothing whatever to do" with Section 103 in *In re Foster* (CCPA, 1965) ..... F.2d .....; 145 USPQ 166, 174\*; subsection 102(c) recites as a bar only that the inventor has abandoned his invention; subsection 102(d) raises as a bar that "the invention was first patented \*\*\* in a foreign country"; while subsection 102(f) refers to the situation in which the applicant did not himself invent the subject matter, that is, that he derived it from someone else.

For a definition of what "was known \*\*\* before" under subsection 102(a), again the Committee Report (*supra*, p. 8) is instructive:

"Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty

*"Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public. (p. 6)"*

"Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed. § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

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\* The rationale of the Court's holding is set out in the Opinion as follows:

"The determination of unobviousness, however, relates to the determination of whether a patentable invention has been *made*. Whether there has been a *loss of right to a patent* [under Sec. 102b] on such invention is a distinct and separate issue, with which section 103 per se has nothing whatever to do.  
\*\*\*" (Emphasis Court's)

\*\* Quoted with approval in *Rem-Cru Titanium v. Watson* (D. D.C., 1957) 152 F. Supp. 282, 285.

"No change is made in these paragraphs other than that due to division into lettered paragraphs. *The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, 'known' has been held to mean 'publicly known') is recognized but no change in the language is made at this time.* Paragraph (a) together with section 104 contains the substance of Title 35 U.S.C. 1946 ed., § 72 (R.S. 4923.)" (p. 17; emphasis added).

In brief, the Committee Report commentary on Section 103 equates the term "prior art" to "what was known before, as described in section 102". But, again, the Committee Report comment on Section 102 points out that "what was known before" refers to what was *publicly* known. It follows therefore, under the terms of the Statutes, the term "prior art" as used in Section 103 is confined to *prior public knowledge*.

The "interpretation by the Courts" that prior knowledge, referred to in Section 102, "excludes various kinds of private knowledge not known to the public", is found in an unbroken line of authorities. For example, in the early case of *Pennock and Sellers v. Dialogue* (1829) 27 U.S. 1, this Court said:

"By the very terms of the first section of our statute, the secretary of state is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c. &c. 'not known or used before the application' \* \* \*." (p. 18; emphasis Court's)

"We think, then, the true meaning must be, not known or used by the public, before the application \* \* \*." (p. 19)

and referring to an earlier English Statute:

"\*\*\* The use here referred to has always been understood to be a public use, \*\*\*." (p. 20)

The same rule was enunciated by this Court in *Gayler et al. v. Wilder* (1850) 51 U.S. 477, in considering a case based upon the Patent Act of 1836, containing the same limitation upon the grant of a patent, that is, that the invention shall be "not known or used by others":

"The act of 1836, ch. 357, Sec. 6, authorizes a patent where the party has discovered or invented a new and useful improvement, 'not known or used by others before his discovery or invention' \*\*\*. The clause in question qualifies the words before used and shows that *by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public.*" (pp. 496-497; emphasis added)

A more up-to-date statement of this same principle is found in *Minneapolis-Honeywell v. Midwestern Instruments* (E.D. Ill., 1960) 188 F.Supp. 248, 250, 252 (affirmed (C.A. 7, 1961) 298 F.2d 36, 38). In that case, it was urged by defendant that certain work carried on for the Government and having a security classification was a part of the prior art. In holding to the contrary and finding the patent in suit valid, the Trial Court said:

"\*\*\* The invention must cover something new (35 U.S.C. § 101) which is not in prior (35 U.S.C. § 102) *public* (*Rem-Cru Titanium, Inc. v. Robert C. Watson, Commissioner of Patents*, 152 F.Supp. 282, (D.C. 1957); *Block v. Nathan Anklet Support Co., Inc.*, 9 F.2d 311 (2nd Cir. 1925); *Gayler et al. v. Wilder*, 10 How. (51 U.S.) 476 1850) *knowledge.*\*\*\* (p. 250, f.n. 3; emphasis added)

\*\*\*\*\*

"Much reliance is also placed by the defendant upon the work carried on for the United States Government by the Department of Terrestrial Magnetism (abbreviated DTM) of the Carnegie Institution, in connection with work on a Magnetograph, in 1943. This work was classified as restricted for security purposes and was stipulated by counsel not to have been declassified until December 15, 1953, which date is subsequent to Heiland's date of conception and reduction to practice. It is therefore, not to be deemed part of the prior art. \* \* \*" (p. 252)

The Court of Appeals for the Seventh Circuit affirmed both the judgment and the ruling of the Trial Court, saying:

"The statute uses the words 'known or used.' This implies that the knowledge and use must be accessible to the public. *Block v. Nathan Anklet Support Co.*, 2 Cir., 9 F.2d 311; *Gillman v. Stern*, 2 Cir., 114 F.2d 28, cert. den. 311, U.S. 718. In the latter case, Judge Learned Hand for the Court, explained the distinction between secret knowledge or use and public knowledge or use."

Apparently the most recent pronouncement to the effect that prior knowledge within Section 102(a) must be public is in *In re Borst*, (CCPA, decided May 27, 1965) ..... F.2d ..... , 145 USPQ 554. In that case the question arose as to whether a document under secrecy classification by the Atomic Energy Commission was a publication within Section 102(a). In holding that it was not, the Court said:

"Another aspect of the court's discussion in *Schlittler* [In re Schlittler, 43 CCPA 986, 234 F.2d 882] involved the well-established principle that 'prior knowledge of a patented invention would not invalidate a claim of the patent unless such knowl-

edge was available to the public.' After reaffirming that principle, the court went on to state:

'Obviously, in view of the above authorities, the mere placing of a manuscript in the hands of a publisher does not necessarily make it available to the public within the meaning of said authorities.'

\* \* \* \* \*

"We shall consider first the public availability aspect of the Schlittler case. Although that portion of the Schlittler opinion is clearly dictum, we think it just as clearly represents the settled law. The knowledge contemplated by section 102(a) must be accessible to the public. In addition to Schlittler and cases cited therein, see, e.g., Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc., 298 F.2d 36, (7th Cir. 1961); Rem-Cru Titanium, Inc. v. Watson, 152 F. Supp. 282, (D.D.C. 1957).

"In the instant case, Samsel was clearly not publicly available during the period it was under secretary (secrecy) classification by the Atomic Energy Commission. \* \* \*"

Whenever the disclosures of two or more patents are considered collectively or "combined" in making a rejection, it is on the authority of Section 103 and, under Sections 102 and 103, such combination could not have been obvious "to a person having ordinary skill in the art" until such time as the patents to be combined *were all issued and were available to persons skilled in the art; that is, were publicly known. But copending patents are not publicly known nor are they available to those skilled in the art as of their filing dates—they are maintained in strict secrecy within the Patent Office under Section 122 of the Patent Act (supra, p. 3).*

In summary, there are, *inter alia*, two distinct and independent statutory bars to the grant of a patent on an invention:

1. The invention was not new, having been disclosed entirely or with inconsequential variations in an issued patent or printed publication bearing a date before the invention was made (Section 102(a)) or more than one year before a patent application thereon was filed (Section 102(b)). In this case, Respondent does not contend that either of the reference patents cited by the Patent Office discloses the entire Regis invention or that a patent to Regis is barred by the provisions of either of these Sections of the Patent Statutes.

2. While the invention in question was new, the quantum of newness, measured against the "prior art" as defined above, was not sufficient to support the grant of a patent (Section 103). This is the Section of the Patent Statutes on which Respondent relied in the Courts below and in its Brief in Opposition to the Petition herein (p. 2). The controversy arises, therefore, as to whether the term "prior art" as used in Section 103, meaning "what was (publicly) known before", embraces copending patents which were *not publicly known* as of the dates of their filing in the Patent Office but, on the contrary, were maintained in complete secrecy under Section 122 of the Patent Statutes (*supra*, p. 3). This is the gravamen of the question presented on this Petition (*supra*, p. 4).

Unfortunately, some confusion is found in a number of the decisions because the lines of demarcation between the foregoing distinct and different bars to the grant of a patent, based on different theories and on different Sections of the Statute, have not been maintained. Particularly, the term "prior art" has been used loosely and synonymously with "anticipation", a term not found in the Statutes, and with other bars to the grant of a patent, embracing evidence falling within the several subsections of Section 102 and Section 103.

Nevertheless, it is submitted that the better reasoned authorities *have* maintained a proper distinction between the several statutory bars to the grant of a patent and *have* correctly held that a copending patent is *not* competent evidence of the prior art while it is still a secret application in the Patent Office. Only after it issues as a patent does it become a part of the general public knowledge or "prior art".

Thus, *Helene Curtis v. Sales Affiliates* (C.A. 2, 1956) 233 F.2d 148, 156, 158, was an action for a declaratory judgment that a patent owned by defendant on a hair-waving method was invalid. The Court of Appeals, while finding the patent invalid on other grounds, agreed with defendant that the copending patent relied on by plaintiff was not a part of the prior art, saying:

"We think the defendant is right in its insistence that the second Speakman patent, which did not issue until after McDonough's filing date, should not be treated as part of the prior art for purposes of determining the issue of patentable invention in McDonough's claims. *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379; *Comolite Corp v. Davidovicz*, 2 Cir., 111 F.2d 121; *Stelos Co. v. Hosiery Motor-Mend Corp.*, 2 Cir., 72 F.2d 405. \* \* \*

\*\*\*\*\*

"Both Speakman's second U. S. Patent and the Evans and McDonough Patent did not go to issue until after the filing date of the patent in suit. On that account they could not be held to constitute part of the prior art or as anticipating patents under 35 U.S.C.A. § 102(a). Nevertheless, they were anticipatory under the doctrine of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, now codified in 35 U.S.C.A. § 102(e). *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*,

supra; *Stelos Co. v. Hosiery-Mend Corp.*, supra.  
\* \* \* (pp. 156, 158)

In *Weatherhead v. Drillmaster Supply* (C.A. 7, 1955) 227 F.2d 98, 101, the Trial Court had held that the '217 patent in suit

"\* \* \* does not disclose invention over 413, (an earlier filed copending patent to the same inventor) and that the specific ring disclosed in claim 12 of patent 413 was within the skill of and would have been obvious at the time of the invention claimed in patent 217 to any mechanic skilled in this art. \* \* \*"

The Court of Appeals, while finding the patent invalid for double patenting, that is, for claiming the same invention as the earlier patent to the same inventor, rejected the rationale of the Trial Court saying:

"In *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379, the same court, in an opinion by the same judge, held that the first of copending patents was *not* prior art as to the others, and that it could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention. This is the position taken in most modern cases in the Courts of Appeals. *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 1 Cir., 122 F.2d 900, 913; *Sherwin-Williams Co. v. Marzall*, D.C. Cir., 190 F.2d 606." (emphasis Court's)

For the convenience of the Court, there is repeated in Appendix II to this Brief a list of all Appellate decisions which have been found dealing with this issue since the landmark decision of this Court in *Alexander Milburn v. Davis-Bourronville* (1926) 270 U.S. 390. Prior to the decision of this Court in the *Alexander Milburn* case, the authorities were in such a state of hopeless confusion with

respect to the effect of copending patents that it is not fruitful to pursue them.

With the exception of one decision of the Court of Appeals of the Eighth Circuit, one decision of the Court of Appeals of the Fourth Circuit in 1931, and one decision of the Court of Appeals of the Second Circuit in 1945, the only Appellate decisions holding that a copending patent is a part of the prior art as of its filing date are from the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals. It appears that these two Courts have departed from the mainstream of the case law.

Respondent, in its Brief in Opposition to the Petition, urged that this Court, in *Detrola v. Hazeltine* (1941) 313 U.S. 259, had decided the question presented on this Petition. A careful examination of that decision and of the petition and briefs on which the case was submitted shows clearly that *this question was neither presented nor decided in the Detrola case*.

Petitioner's brief in the *Detrola* case discussed (pp. 15-25) a number of reference patents, each of which it alleged individually and completely disclosed the invention defined by the claims there in suit. While that brief did not use the exact term "prior invention", it is clear that each of the reference patents was urged by petitioner in that role. There is no reference whatever to the prior art or to the general state of the art against which an invention not so completely disclosed in any single prior patent or publication is measured to determine whether or not it would have been obvious to one skilled in the art, a requirement of prior case law codified in Section 103.

Respondent's brief in the *Detrola* case (pp. 47-56) met petitioner's attack against the claims in suit on precisely the same ground, that is, urging that none of the reference patents, individually and completely, disclosed the invention defined by the claims in issue.

While the *Detrola* case was decided prior to the enactment of the 1952 Patent Act, it is clear that both parties to that controversy considered the reference patents solely from the basis of individual and complete anticipation of the claims in issue by each of the reference patents and did not raise the question of whether their disclosures could be used collectively to establish the prior art against which the claims should be tested to determine whether the invention was one which would have been obvious to one skilled in the art.

While, in *Detrola*, this Court did group together previously issued patents and copending patents as references and said that "All constituted prior art." (p. 265), this statement is footnoted to the *Alexander Milburn* case, *supra*, which involved solely the issue of prior inventorship (now codified in Section 102(e)), not the question of the quantum of invention over the prior art (Section 103). The intent of this Court in the *Detrola* decision is thus clear—a copending patent can properly be employed in the same manner as in the *Alexander Milburn* case to establish prior invention by another. This is borne out by this Court's actual holding in that case, namely:

"\* \* \* that Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, notwithstanding the fact that he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, *he was not in fact the first inventor*, \* \* \*." (p. 269; emphasis added)

In *Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159 F.2d 379, Judge Learned Hand, a recognized authority on the patent law, rendered his decision less than six years after the *Detrola* case and unquestionably accorded the decision of this Court the respect it was due. Notwith-

standing the *Detrola* case, Judge Hand stated that a copending patent was not within the prior art and could invalidate claims of the patent in suit only on the issue of prior inventorship.

In any event, even if the *Detrola* decision did hold as urged by Respondent in the Courts below, to the extent that it is inconsistent with latest Congressional action, represented by the 1952 Patent Act, it must give way to that Act.

Respondent, in its Brief in Opposition to the Petition, contended that the *Helene Curtis* and *Weatherhead* cases, *supra*, as well as *John Blue v. Dempster Mill* (C.A. 8, 1960) 275 F.2d 668, contain only dicta in support of Petitioners' position that a copending patent is not prior art as of its filing date. A careful review of those decisions does not support Respondent's contention. In *Helene Curtis*, the Trial Court had held that a McDonough patent in suit "lacked patentable invention over" a group of patents constituting the prior art, which included a copending patent to one Speakman. The Court of Appeals explicitly reversed that finding in the excerpt quoted above (p. 15). The fact that the Court held the McDonough patent invalid on other grounds is irrelevant.

In *Weatherhead*, the Trial Court had held that a Kriedel patent in suit did not disclose invention over an earlier copending patent of the same inventor, that is, that the subject matter of the patent in suit would have been obvious to one skilled in the art in the light of the disclosure of that copending patent. The Court of Appeals reversed that holding, saying:

"\* \* \* It is clear, however, that copending applications on which patents are granted to the same inventor must pass *two* tests of validity. They must constitute invention over the prior art, and they must be 'different' from each other in order to avoid double patenting. If double patenting is found,

the later of the two patents is invalid." (p. 101; emphasis added)

The Court then went on to reverse the holding of the Trial Court that the Kriedel patent had failed to pass the first test but held the patent invalid for failing to pass the second test, that is, on the ground of double patenting. The holding of the Court of Appeals, relied upon by Petitioners (*supra*, p. 16), was *not* dictum.

In *John Blue, supra*, the Court of Appeals of the Eighth Circuit explicitly held that a prior copending patent to Blue was not prior art to the Blue and Johnston patent in suit (which was, therefore, not subject to attack under Section 103) although such copending patent could:

"\* \* \* nevertheless be used as defense material to prove that Blue and Johnston were not the original and first inventors or discoverors of the metering pump described in their patent. \* \* \*" (p. 672)

This was a holding of invalidity based on Section 102(e) (*supra*, p. 2). Again, the ruling of the Court that the copending patent was not in the prior art as of its filing date is an explicit ruling of the Court—not mere dictum.

The mere fact that in each of the foregoing cases "the patent was held invalid on an alternative ground" (Respondent's Brief in Opposition, p. 6) is irrelevant.

In summary, it is respectfully urged that the copending Wallace et al. patent 2,822,526 (R. 54A) is not, as of its filing date, competent evidence of the "prior art" as that term is used in Section 103 and, therefore, is not available as evidence from which the obviousness of the Regis invention is to be determined. The 1952 Patent Act excludes from the "prior art" referred to in Section 103 all that was not *publicly* known "at the time the invention was made", that is, at the time of the filing of the Regis application on December 23, 1957 (R. 7A). At that time, the Wallace et al. patent was not *publicly* known.

**POINT 2. BY STRAIGHTFORWARD LOGIC, A CO-PENDING PATENT IS NOT, AS OF ITS FILING DATE, COMPETENT EVIDENCE OF THE PRIOR ART**

Section 103 (*supra*, p. 3) establishes as the test of whether a patent should be withheld on an invention, the obviousness of the difference between that invention and the prior art to one skilled in the art.

Obviousness is thus a *fact* which must be proved to defeat a patent under Section 103. The Courts have established a number of criteria for showing lack of obviousness:

1. The satisfaction of a long felt want:

*Kaakinen et al. v. The Peelers Co.* (C.A. 9, 1962)  
301 F.2d 170

*Reiner v. I. Leon* (C.A. 2, 1960) 285 F.2d 501

*Tatko Bros. Slate v. Hannon* (C.A. 2, 1959) 270 F.2d 571, 573

*Kelley et al. v. Coe* (C.A. D.C., 1938) 99 F.2d 435

*Tietig et al. v. Ladd* (D. D.C., 1964) 228 F.Supp. 637.

2. The age of the prior art from which unobviousness is measured:

*Reiner v. I. Leon* (C.A. 2, 1960) 285 F.2d 501

*Tietig et al. v. Ladd* (D. D.C., 1964) 228 F.Supp. 637.

3. The over-all effort in devising and developing the invention, for example "how many tried to find the way":

*Reiner v. I. Leon* (C.A. 2, 1960) 285 F.2d 501

*Welsh Mfg. v. Sunware Prods.* (C.A. 2, 1956) 236 F.2d 225, 227

*Lyon v. Bausch & Lomb* (C.A. 2, 1955) 224 F.2d 530, 535 (cert. den. 350 U.S. 911)

*Bussemer et al. v. Artwire Creations* (S.D. N.Y., 1964) 231 F.Supp. 798.

4. The difficulty of the solution ultimately arrived at:

*E. J. Brooks v. Stoffel Seals* (C.A. 2, 1959) 266 F.2d 841, 843 (cert. den. 361 U.S. 883)  
*Bussemer et al. v. Artwire Creations* (S.D. N.Y., 1964) 231 F.Supp. 798.

5. The proximity between the field from which knowledge was taken and the field where it was applied:

*Potts v. Creager* (U.S. S.C., 1895) 155 U.S. 597, 606  
*Bussemer et al. v. Artwire Creations* (S.D. N.Y., 1964) 231 F.Supp. 798.

6. The general availability of the means used by the inventor in devising his invention:

*Reiner v. I. Leon* (C.A. 2, 1960) 285 F.2d 501, 504  
*Bussemer et al. v. Artwire Creations* (S.D. N.Y., 1964) 231 F.Supp. 798.

7. The commercial success of the invention, for example "how immediately was the invention recognized":

*Goodyear v. Ray-O-Vac* (U.S. S.C., 1944) 321 U.S. 275, 279  
*Marvel Specialty v. Bell Hosiery Mills* (C.A. 4, 1964) 330 F.2d 164.  
*Ekco Products v. Chicago Metallic* (C.A. 7, 1963) 321 F.2d 550  
*Shumaker v. Gem Mfg.* (C.A. 7, 1962) 311 F.2d 273  
*Reiner v. I. Leon* (C.A. 2, 1960) 285 F.2d 501  
*Baker-Cammack v. Davis* (C.A. 4, 1950) 181 F.2d 550  
*Charles Peckat et al. v. Jacobs* (C.A. 7, 1949) 178 F.2d 794  
*Wahl Clipper v. Andis Clipper* (C.A. 7, 1933) 66 F.2d 162, 165.

It seems clear that a copending patent, in the secret files of the Patent Office at the time the Regis invention was made, could not be used to show obviousness under the foregoing principles. Certainly, "knowledge was (not) taken" from a secret patent application (criterion 5). Certainly, such a secret Patent Office application had no "general availability" (criterion 6).

There is simply no logic in the contention that the obviousness of an invention to a man skilled in the art should be measured against secret knowledge unavailable to the public in general and to him in particular. The most that can be decided under such a set of facts is a hypothetical question — if the man skilled in the art *had had* the unavailable knowledge, would the invention in question *then* have been obvious to him. But there is no way of providing a correct answer to such an "iffy" question and the application of Section 103 does not rest upon the answer to such question.

It is submitted that, as a matter of straightforward logic, a copending patent is not, as of its filing date, competent evidence of the prior art.

**POINT 3. UNDER THE RULES OF SIMPLE FAIRNESS AND CONSONANT WITH THE PUBLIC INTEREST, A COPENDING PATENT CANNOT BE INCLUDED IN THE PRIOR ART TO SHOW THAT THE REGIS INVENTION WAS OBVIOUS UNDER SECTION 103**

One of the handicaps with which a serious worker and inventor is confronted is the legal fiction imputing to him knowledge of all information published or patented anywhere. He is charged with knowledge of the most arcane information, hidden in the most obscure publication in the most remote library in the United States or in a foreign country.

The Statute (Section 102(a), *supra*, p. 2) makes no reference to the general availability of the published knowledge to the inventor or to his actual acquaintance with it but merely denies him a patent if

"the invention was \*\*\* patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant, \*\*\*"

In this instance, the private interest of the inventor is submerged in the public interest. If the statute provided otherwise, it would put a premium upon ignorance. He who read the least and knew the least might be able to get a patent on matters of common knowledge to his more erudite peers. This would obviously *retard* the progress of the useful arts, not promote it, as encouraged by the Constitution and the Patent Laws.

However, to impute to an inventor knowledge hidden in the secret archives of the Patent Office and unavailable to him or to the public in general, is to compound the legal fiction to his detriment and does not serve any public interest.

The situation presented in the *Alexander Milburn* case (*supra*, p. 16), as codified in Section 102(e) (*supra*, p. 2), actually penalizes an inventor on account of such secret knowledge not available to him, but is easily distinguishable. There, but for the rule, a patent could issue to one who actually made an invention *after* the inventor of the copending patent, who could then take away the right of the earlier inventor to practice his own invention, a common law right arising from the creative act of invention. In such a situation, the public interest is not concerned with which of two rival inventors is awarded a patent. However, it becomes necessary to balance two conflicting private interests and simple justice favors the earlier of the two contestants, denying to the later inventor the right to a patent.

But the factual situation of the instant case presents no conflicting interests, private or public. If a patent is granted including the claims in issue, it cannot take away the right of the patentees Wallace et al. or their assignee, Aircraft Armaments, Inc., to continue to manufacture and sell the wave guide shutter described and claimed in their patent (R. 54A); it cannot take away the right of Carlson or his assignee, Bell Telephone Laboratories, to continue to manufacture and sell the attenuator described and claimed in his patent (R. 50A); nor can it take away the right of the public freely to practice the inventions of those patents after their respective dates of expiration. The only restraint which the grant of the claims in issue to Regis can bring upon those parties is to deny them the right to manufacture and sell the microwave switch described and claimed in the Regis application here in issue (R. 9A-15A), a right which neither of those parties ever had, because neither of them made the invention defined by the claims in issue, and which the public would not acquire upon the expirations of their respective patents.

Simple principles of equity and fair play require exclusion from the general fund of public knowledge, known as the prior art, secret knowledge completely unavailable to workers in the art and, therefore, as long as secret, not aiding in promoting the progress of the useful arts. A copending patent falls in that category until it actually issues as a patent and is available to all workers in the art and to the public at large.

## CONCLUSION

It is submitted:

1. That by the terms of the Patent Statutes, Patent No. 2,822,526 to Wallace et al. (R. 54A) is not within the prior art as that term is used in Title 35 U.S. Code, Section 103.

2. That since Respondent does not contend that Patent No. 2,822,526 to Wallace et al. alone discloses the invention described and claimed in the Regis application in issue under Title 35 U.S. Code, Section 102(e) and since it does not contend that the Regis invention is described in prior art Patent No. 2,491,644 to Carlson alone under Title 35 U.S. Code, Section 102(a) or Section 102(b), Respondent has not shown any ground for denying the grant of a patent to Regis including the claims in issue.

3. That the Judgment of the District Court and of the Court of Appeals should be vacated and the District Court ordered to enter a judgment pursuant to Title 35 U.S. Code, Section 145, authorizing the Commissioner of Patents to issue Letters Patent to Petitioners on the invention claimed in claims 1, 2, and 3 of the Regis application Serial No. 704,770, as prayed in the Complaint herein.

Respectfully,

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## APPENDIX I

**SUMMARIES OF THE REGIS INVENTION  
AND OF THE DISCLOSURES OF THE  
CARLSON PATENT 2,491,644 AND THE  
WALLACE ET AL. PATENT 2,822,526****THE REGIS INVENTION**

The Regis application Serial No. 704,770 was filed December 23, 1957, (R. 7A) and describes and claims a Microwave Switch. This is a device for connecting a microwave source such as a radio transmitter to a useful load device such as an antenna. A microwave is a very high frequency radio wave, the Regis specification mentioning a frequency of the order of 9,000 megacycles (9 billion cycles per second).

The problem to which the Regis invention is directed is that, for proper operation of such a microwave transmitter, its output load (impedance) must be maintained approximately constant and matched to the transmitter impedance. Therefore, it is not practicable simply to disconnect the transmitter from its useful load (antenna) as in ordinary circuits (R. 9A). Regis' solution to the problem was, in general, to devise a particular form of dummy load and gradually to make this dummy load effective at the transmitter as the connection to the useful load is gradually made ineffective.

Referring to Figs. 1 and 2 of the Regis drawing (R. 15A), there is shown schematically a microwave transmitter 10, which may be purely conventional, coupled to a microwave antenna 12, also conventional, through a wave guide 11. Such a wave guide physically is in the form of a hollow pipe and conducts microwaves much as an ordinary pipe conducts water. Extending through a longitudinal slot in the guide 11 is an elongated vane 13 which is tapered toward the end facing the transmitter and is of resistance material which has the property of absorbing microwaves and pre-

senting a load to the transmitter. At the remote end of the vane 13 is disposed a highly conductive transverse metal strip 15 which acts completely to block transmission of microwaves through the guide 11.

As the vane 13 and strip 15 are gradually lowered through the slot into the guide 11, the resistance material of the vane absorbs more and more of the energy from the transmitter so that the signal reaching the shorting strip 15 is attenuated. What signal energy does reach the strip 15 is reflected by it back towards the transmitter but, in the process, is further attenuated by the vane 13. Thus, the load on the transmitter is gradually and smoothly diverted from the antenna 12 to the vane 13 and the strip 15 acting as a dummy load, thus avoiding any disruption to the normal operation of the transmitter.

#### **PATENT 2,491,644 — CARLSON (R. 50A)**

This patent discloses a piece of laboratory test equipment called an "attenuator" which is calibrated to indicate directly the amount of attenuation which it effects in a microwave signal passing down a hollow wave guide, this indication being given on the calibrated scale 57 (Fig. 5; R. 50A).

Referring to Figs. 1 to 4 of the drawings, (R. 51A) an elongated wave guide 10 has two opposed longitudinal slots 13 and 14 in which is disposed a vane 16 of resistance material mounted on a pivot shaft 15. The Carlson invention resides in the particular configuration of the vane 16 so that equal increments of angular movement of the vane 16 produce equal increments of attenuation, that is, the attenuation varies linearly with the angular movement of the vane. With such an arrangement, the scale 57 (Fig. 5) is uniform, facilitating laboratory measurements.

Carlson was not confronted with the problem of disconnecting the load from a microwave transmitter and, in fact,

his attenuator cannot effect disconnection of his output from his input because his construction lacks the shorting strip at the remote end of the resistance vane.

**PATENT 2,822,526 — WALLACE ET AL. (R. 54A)**

This patent discloses what is termed a "shutter" for interrupting the flow of microwave energy through a wave guide. In the arrangement of Figs. 1 and 2 (R. 54A), a wave guide 1 of rectangular cross-section has a slot 7 in its lower wall. Mounted adjacent the slot 7 is a rotatable semi-cylindrical block 14 of resistance material of dimensions such that when it is turned through an angle of 180° from that shown in the figures, it completely blocks the wave guide channel and absorbs the greater portion of the microwave energy flowing through the guide.

The construction of Figs. 3 and 4 of the Wallace et al. patent (R. 55A) is similar except that the block 19 of resistance material is of a quarter-cylindrical shape and, when the shutter is in closed position, a portion 26 of the metallic mounting for the block 19 extends across the wave guide, producing some shorting and reflecting effect on the microwave energy passing through the block 19.

While the Wallace et al. shutter secures results generally similar to that achieved by the Regis invention, its construction is essentially different from that described and claimed in the Regis application. The claims here in issue (R. 33A) define a microwave switch including an attenuating vane of resistance material tapered toward the source of energy in combination with a highly conductive strip at the remote end of the vane.

## APPENDIX II

**DECISIONS OF APPELLATE COURTS SINCE  
 ALEXANDER MILBURN v. DAVIS-BOURNONVILLE  
 (1926) 270 U. S. 390 DEALING WITH THE RELATION  
 OF CO-PENDING PATENTS TO THE PRIOR ART**

In each of the following cases, the Appellate Court has held that a copending patent is *not* embraced within the prior art as of its filing date but only as of its issue date:

**Decisions After the 1952 Patent Act:**

*Weatherhead v. Drillmaster Supply* (C.A. 7, 1955)  
 227 F.2d 98

*Helene Curtis v. Sales Affiliates* (C.A. 2, 1956)  
 233 F.2d 148

*John Blue v. Dempster Mill* (C.A. 8, 1960) 275  
 F.2d 668.

**Decisions Before the 1952 Patent Act:**

*In re Spencer* (CCPA, 1931) 47 F.2d 806

*Stelos Co. v. Hosiery Motor-Mend* (C.A. 2, 1934)  
 72 F.2d 405

*In re Youker* (CCPA, 1935) 77 F.2d 624

*Hazeltine Corp. v. Coe* (C.A. D.C., 1936) 85 F.2d  
 558

*In re Walker et al.* (CCPA, 1938) 99 F.2d 976

*Comolite v. Davidovicz* (C.A. 2, 1940) 111 F.2d 121

*Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159  
 F.2d 379

*Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d  
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*Permo v. Hudson-Ross* (C.A. 7, 1950) 179 F.2d 386

*Industrial Wire Cloth v. United Specialties* (C.A.  
 6, 1951) 186 F.2d 426.

Thus, the Courts of Appeals of the Second, Sixth, Seventh, and District of Columbia Circuits and the Court

of Customs and Patent Appeals have held that a copending patent *is not* embraced within the prior art as of its filing date.

In addition to the decisions of the Courts below in the instant Action, the following decisions of the Federal Appellate Courts have held oppositely:

**Decisions After the 1952 Patent Act:**

*Syracuse v. H. Daust* (C.A. 8, 1960) 280 F.2d 377  
*In re Gregg* (CCPA, 1957) 244 F.2d 316  
*In re Kander* (CCPA, 1963) 312 F.2d 834  
*In re Zenitz* (CCPA, 1964) 333 F.2d 924  
*In re Harry* (CCPA, 1964) 333 F.2d 920.

**Decisions Before the 1952 Patent Act:**

*Denaro v. Maryland Baking* (D. Md., 1930) 40 F.2d 513 (Affirmed *per curiam* (C.A. 4, 1931) 40 F.2d 1074)  
*Minnesota Mining v. Coe* (C.A. D.C., 1938) 100 F.2d 429 (cert. den. 306 U.S. 662)  
*L. Sonneborn Sons v. Coe* (C.A. D.C., 1939) 104 F.2d 230  
*Dyer v. Coe* (C.A. D.C., 1941) 125 F.2d 192  
*Western States v. S. S. Hepworth* (C.A. 2, 1945) 147 F.2d 345  
*In re Seid* (CCPA, 1947) 161 F.2d 229  
*Sherwin-Williams v. Marzall* (C.A. D.C., 1951) 190 F.2d 606.

Thus, the Courts of Appeals of the Fourth and the Eighth Circuits and the later decisions of the Court of Appeals of the District of Columbia Circuit and the Court of Customs and Patent Appeals have adopted the rule that a copending patent *is* competent evidence of the prior art as of its filing date.

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# In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 57

HAZELTINE RESEARCH, INC., ET AL., PETITIONERS

COMMISSIONER OF PATENTS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF  
APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

## BRIEF FOR THE COMMISSIONER OF PATENTS

### OPINIONS BELOW

The opinion of the district court (R. 69-74) is reported at 226 F. Supp. 459. The opinion of the court of appeals (R. 82-83) is reported at 340 F. 2d 786.

### JURISDICTION

The judgment of the court of appeals was entered on November 25, 1964 (R. 83). The petition for a writ of certiorari was filed on February 18, 1965 and granted on April 5, 1965 (R. 85). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

### QUESTION PRESENTED

Whether a "copending patent"—i.e., a patent applied for before the invention and application in issue but granted after the application in issue—is a relevant

reference in determining whether there has been a patentable advance in the art under Section 103 of the Patent Act.

#### STATUTES INVOLVED

Title 35 of the United States Code provides in pertinent part:

##### § 101: Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

##### § 102: Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent \*\*\*.

##### § 103: Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought

to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

#### STATEMENT

On December 23, 1957, petitioner Robert Regis filed an application for a patent on a microwave switch (R. 9-15).<sup>1</sup> The application was denied by the patent examiner on June 24, 1959, on the ground that the claims set forth therein were "unpatentable over" a patent (No. 2,822,526) issued to Wallace in 1958, "in view of" a 1949 patent issued to Carlson (No. 2,491,644) (R. 23). It is conceded that if Regis' application is judged against the Wallace and Carlson patents, it does not disclose a patentable advance within Section 103 of the Act (35 U.S.C. 103) (precluding patents on developments "obvious" in light of the "prior art" "to a person having ordinary skill in the art"); the question presented is whether the Wallace patent was, in fact, properly employed as a reference relevant to the patentability of Regis' claims.

The Carlson patent had been issued on December 20, 1949, well before Regis' application and invention, and was thus indisputably part of the art in light of which Regis' claim to a patent was to be judged. The Wallace patent, however, was a "copending pat-

<sup>1</sup> Three days before Regis filed his application, he assigned his entire interest in the invention and the application to petitioner Hazeltine Research, Inc. (R. 47).

ent" with Regis; that is, although Wallace had applied for a patent prior to the Regis invention and application, Wallace's patent was not issued until after the Regis application was filed.\* Petitioners argued before the Patent Office that such a "co-pending patent" was an improper reference to determine whether Regis' invention was a patentable advance in the art under Section 103. (R. 22, 26-32). The examiner rejected this contention (R. 23) and his decision was upheld by the Board of Appeals of the Patent Office (R. 42-45).

Petitioners then instituted the present action in the district court pursuant to Section 145 of the Act (35 U.S.C. 145), seeking to compel the Commissioner of Patents to issue a patent on the invention described in Regis' application (R. 1-4). The district court dismissed petitioners' complaint (R. 75). After noting petitioners' concession that, if the Wallace patent was a relevant reference, the combination of Wallace

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\* The Wallace application was filed on March 24, 1954. The Regis application was filed on December 23, 1957. A patent was issued on the Wallace application on February 4, 1958 (R. 34).

With regard to Regis' invention date, his complaint (R. 2) alleged merely that it had been "[p]rior to December 23, 1957" (the date of his application). However, the Examiner's Answer before the Patent Office Board of Appeals (R. 35) reveals that Regis "has not sworn back of either reference under the provision of Rule 131 [37 C.F.R. 1.131]," giving an applicant whose claim is rejected upon the basis of a reference to a domestic patent an opportunity to allege "a completion of the invention in this country before the filing date of the application on which the domestic patent issued. \* \* \*". Hence it is assumed throughout (which petitioners do not dispute) that Regis' alleged invention, as well as Regis' application, was made after Wallace's application.

with Carlson would negate the patentability of Regis under Section 103 (R. 69), the court held that "copending patents" were "included in the 'prior art', as that term is used in 35 U.S.C. 103." The court based its decision upon two considerations: (1) prior to the enactment of the Patent Act of 1952, a copending patent would have clearly been a reference relevant to show that claims were unpatentable for failure to make a significant advance in the art; (2) the 1952 Act, as shown by its legislative history, did not change the law in this respect (R. 70-74). The court of appeals affirmed, *per curiam* (R. 82-83).

#### ARGUMENT

##### *Introduction and Summary*

The single question raised by petitioners in this case concerns the use which may be made, in judging the patentability of an alleged invention under Section 103 of the Patent Act (35 U.S.C. 103), of disclosures of prior inventions contained in "copending patents." A copending patent, for this purpose, is a patent on a prior invention which was already *applied for* at the time of the invention and application in issue, but which is not *issued* until after the filing date of the application in issue; a period of time exists, therefore, when the two applications are "copending" before the Patent Office and neither has been granted. The Wallace patent in this case was, for a short time, such a copending patent with respect to the Regis application which is the subject matter of the litigation. The Wallace application was filed in 1954—

before Regis' alleged invention.<sup>2</sup> The Wallace patent did not issue, however, until February, 1958, a little more than one month after Regis' patent application was filed in December, 1957. The two patents were thus copending for the short period between Regis' filing date in December, 1957, and Wallace's patent date in February, 1958.

In these circumstances, the Patent Office, the district court and the court of appeals have held that the patentability of Regis' alleged invention must be judged in light of the disclosures of the copending Wallace patent just as if Wallace's patent had issued before, rather than a few weeks after, Regis' invention. It is conceded that, so judged, the Regis invention is not patentable, since the differences between it and the Wallace patent, viewed in light of a 1949 patent issued to Carlson, would have been obvious "to a person having ordinary skill in the art" within the doctrine of *Hotchkiss v. Greenwood*, 11 How. 248, codified in Section 103 of the 1952 Patent Act. Thus the sole question is whether Wallace was correctly used as a reference relevant in judging the patentability of Regis under Section 103. We submit that it was.

The Patent Office and the courts below invoked the principle—established by this Court's 1926 decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390—that, for the purpose of judging the

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<sup>2</sup> See footnote 2, *supra*, p. 4.

patentability of a subsequent invention, a copending and ultimately issued United States patent *dates from the time when the application was filed* rather than from the date when the patent is ultimately issued. The instant case comes within this rule because Wallace invented and filed before Regis did, although Wallace's application was not finally processed until after Regis had applied for a patent. The principle of the *Milburn* case, originally a judicial gloss upon the patent statute, has since been explicitly codified in Section 102(e) of the 1952 Patent Act (35 U.S.C. 102(e)), providing that a patent shall not issue if "the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent." The 1952 Act thus treats copending patents as equivalent to previously issued patents, which are relevant references under Section 102(a) (35 U.S.C. 102(a)).

Although petitioners appear to concede the general validity of the *Milburn* principle under the 1952 Patent Act, they seek to limit its applicability to a special class of cases. Specifically, petitioners urge that while the *Milburn* rule applies when a copending patent discloses the *exact* invention claimed in an application on a subsequent "invention," the rule does not apply when the subsequent application contains

some difference from, or variation upon, the copending patent. This is so, petitioners argue, even though the difference or variation, as in this case, is an insignificant one which would not constitute a patentable advance over the copending patent under Section 103.

Petitioners' argument rests principally upon the language used by Congress in 1952 in codifying the rule precluding patents upon variations obvious "to a person having ordinary skill in the art." Congress stated in Section 103 that the relevant references in judging such obviousness were those in the "prior art" at the date of the invention in issue. In petitioners' view, the words "prior art" must be taken to refer only to patents already *issued* as described in Section 102(a) of the Act, and cannot refer to copending patents as described in Section 102(e). Thus petitioners urge that copending patents are not "prior art"—and hence are not relevant—for purposes of judging patentability under Section 103.

We show below that the limitation which petitioners would thus place upon the use of copending patents is novel and wholly unwarranted. While there was—and there remains—some confusion in the use of the term "prior art" in judicial opinions in the lower courts, it was, as we show, entirely clear before the 1952 Act that disclosures of prior inventions in copending patents (whether or not such patents were technically labelled "prior art") were competent,

under the rule of this Court's *Milburn* decision, to negate patentability for lack of a significant advance in the art under *Hotchkiss v. Greenwood*. When the *Milburn* and *Hotchkiss* rules were codified in Sections 102(e) and 103 of the 1952 Act there was no suggestion in either the statute or the legislative history that a limiting change in this use of copending references was intended; nor has any case or commentary since the 1952 Act suggested such a purpose. Thus the result which obtained before 1952 continues to govern today, as several decisions of the lower courts have held. In short, copending patents remain relevant references in determining whether an application discloses a significant advance in the art. Indeed, any other rule would create a danger of numerous overlapping patents prejudicial to the public and to legitimate prior inventors.

Finally, Congress' use of the term "prior art" in Section 103 of the 1952 Act, upon which petitioners principally rely, is fully consistent with the use of copending patents in Section 103 cases. Whatever confusion once existed in the lower courts, this Court had made it clear in 1941 that copending patents "constituted prior art," *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, 265, and it is reasonable to suppose that Congress so understood the term when it incorporated it in Section 103. Hence "prior art" in Section 103 includes copending references as described in Section

102(e) as well as previously issued references as described in Section 102(a).

## I

### PRIOR TO THE 1952 PATENT ACT, COPENDED PATENTS WERE UNQUESTIONABLY RELEVANT REFERENCES IN DETERMINING WHETHER SUBSEQUENT INVENTIONS DISCLOSED A PATENTABLE ADVANCE IN THE ART

It has always been assumed, as petitioners acknowledge, that an invention is unpatentable if the identical invention, achieved at a prior time by another inventor, is claimed in a copending patent application. This result follows not from any special rule as to copending patents, but from the basic and guiding principle that priority is determinative. This rule of prior invention is now codified in Section 102(g) of the Patent Act (35 U.S.C. 102(g)), which provides that an applicant shall not be entitled to a patent if, "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." Section 135 of the Act (35 U.S.C. 135) provides for so-called interference proceedings to determine the factual issue of priority when a question is raised in that regard.

While the problem of copending *identical* patents has thus always been solved in principle by a straightforward application of the rule of priority of invention, the answer was not always so clear in cases where the copending applications did not claim a patent on exactly the same invention, but where the

disclosures in the prior copending patent nevertheless would, if considered to be part of the relevant art, affect the patentability of the subsequent patent by showing it to be an insignificant advance in the art. A rule for such cases—similar to the rule applied to identical claims—was, however, established by this Court in 1926 in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390. It is this rule, now codified in Section 102(e) of the Act, which disposes of the present case.

In the *Milburn* case, the copending patentees were Clifford and Whitford. (Both patents were issued by the Patent Office, the question of the validity of Whitford's patent being raised against his assignee in infringement proceedings). Clifford, the prior inventor and applicant, "gave a complete and adequate description of the thing patented to Whitford [the subsequent inventor and applicant], but \* \* \* did not claim it." 270 U.S. at 399. Clifford's disclosures were not revealed prior to Whitford except in Clifford's patent application; hence they did not come within the rule now codified in Section 102(a) of the Act (35 U.S.C. 102(a)), that patentability must be judged in light of disclosures actually patented or published before the invention in question. In the district court, Judge Learned Hand held Whitford's patent valid despite the disclosures in Clifford's prior copending patent. In Judge Hand's view, copending applications were properly used only to show that a prior inventor was entitled to the patent claimed. Since Clifford did

not *claim* the disclosures later claimed by Whitford (although he described Whitford's claims) Clifford was not a prior inventor competing for the same patent and his copending disclosures, not otherwise part of the known art prior to Whitford's invention, could not bear upon the patentability of Whitford. See 297 Fed. 846, 851-854. The court of appeals affirmed. 1 F. 2d 227.

In a unanimous opinion written by Mr. Justice Holmes, this Court reversed. The Court held that copending patents were relevant not only to resolve competing claims between inventors claiming the same invention, but also to determine whether a subsequent inventor has made a patentable invention—regardless of the identity of his claims with those made by other inventors. The Court reached this result by considering as immaterial the delays occasioned in the Patent Office between the filing and issuing date of a patent application. It observed that if Clifford's patent had actually issued before Whitford applied, his disclosures would have been part of the relevant art by which Whitford's claims would be judged, even though Clifford did not claim Whitford's "invention." This being true, "a sound distinction cannot be taken between that case and a patent applied for before but not granted until after a second patent is sought. The delays of the patent office ought not to cut down the effect of what has been done. \* \* \* Clifford had done all that he could do to make his description public. \* \* \* We see no reason in the words or policy of the law for allowing

Whitford to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Clifford had shown knowledge inconsistent with the allowance of Whitford's claim \* \* \* (270 U.S. at 400-401). Thus, the Court concluded, since the prior Clifford patent ultimately issued, the question whether to issue an additional subsequent patent to Whitford must be decided in light of Clifford.

As stated in the Reviser's Note accompanying the incorporation of the *Milburn* decision into the 1952 Act (as Section 102(e)), *Milburn* means that, "for the purpose of anticipating a subsequent inventor," "a United States patent disclosing an invention dates from the date of filing the application." Under this standard, the Regis invention in this case was unpatentable, since it disclosed no patentable advance over Wallace, which had been previously filed in the Patent Office.

Although there is a factual difference between the *Milburn* case and the present one, the cases are not distinguishable. The prior Clifford application (involved in *Milburn*) did not claim the subject matter of Whitford's patent, but did give "a complete and adequate description of the thing patented to Whitford" (270 U.S. at 399). In the instant case, Wallace and Carlson did not thus completely describe the Regis invention; they did, however, make claims, in light of which Regis' invention is unpatentable as an insignificant advance in the art. The theory of the *Milburn* case applies equally to both situations. Delays

within the Patent Office are to be ignored and the Wallace patent deemed prior to Regis' invention. Regis is, consequently, unpatentable whether identically disclosed by Wallace and Carlson or merely an insignificant advance over those two patents.

That the *Milburn* doctrine of copending patents thus applies to the present case was demonstrated beyond doubt by the Court's express holding, in 1941, in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, that "copending patents," regardless of whether they partially or completely disclose the claimed subject matter, constitute a part of the prior art by which patentability must be judged. The *Detrola* case involved the alleged infringement of a patent issued to Wheeler on a radio circuit. In an infringement proceeding instituted by Hazeltine, Wheeler's assignee, this Court stated (313 U.S. at 264-265; emphasis added):

The defendant insisted that the [Wheeler] patent involved no invention in view of the prior art and cited patents issued before Wheeler's date of conception and others issued before the patent in suit on applications antedating his date of invention and pending when his application was filed [i.e., copending patents].

Some of these were for transmission systems and some for receiving systems. Several disclosed automatic amplification control. All constituted prior art. [Footnote citing *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390.]

Indisputably, the copending patents referred to in *Detrola* were of the type involved in the instant case, i.e., patents not identical with the subsequent invention, but in light of which that invention would have been obvious to one skilled in the art within the doctrine of *Hotchkiss v. Greenwood, supra*, and Section 103 of the Act. For, after analyzing in detail the relationship between Wheeler's patent and the prior art cited against Wheeler, including copending patents, the Court concluded, with special emphasis upon the copending elements in the prior art, that (313 U.S. at 269; emphasis added) :

Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, *notwithstanding the fact he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor, since his advance over the prior art, if any, required only the exercise of the skill of the art.*<sup>4</sup>

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<sup>4</sup> Petitioners contend that the question whether copending patents which partially disclose the claimed subject matter constitute prior art was neither presented to, nor decided by the Court, in *Detrola* (Pet. Br., pp. 17-18). While the briefs filed with the Court did not specifically raise the question, it is nevertheless clear that the issue was raised by the facts of the case and that the Court explicitly passed on this issue in considering copending patents revealing only partial elements of Wheeler's "invention." Moreover, shortly after *Detrola*, in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 89, the Court again made explicit use of a copending patent which, it said, "differed from Mead [the application in question] in several respects."

The same result was also reached in lower court decisions prior to 1952. In the footnote, we list fourteen cases which we have found in the courts of appeals and the United States Court of Customs and Patent Appeals, decided after the *Milburn* case, which clearly used one or more copending patents to determine patentability in situations where the individual copending patents were recognized as not completely disclosing the subsequent invention, but as only partially disclosing it so as to negate patentability under the rule of *Hotchkiss v. Greenwood*.<sup>5</sup>

The language of many of these cases reads directly upon the present case. Indeed, in *Western States Mach. Co. v. S. S. Hepworth Co., supra*, at 348-349 Judge Learned Hand addressed himself directly to—

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<sup>5</sup> *Sherwin Williams Co. v. Marzall*, 190 F. 2d 606 (C.A.D.C.); *United Specialties Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C.A. 6); *Permo, Inc. v. Hudson-Ross, Inc.*, 179 F. 2d 386 (C.A. 7); *Conmar Products Corporation v. Universal Slide Fastener Co.*, 172 F. 2d 150 (C.A. 2); *Application of Seid*, 161 F. 2d 229 (C.C.P.A.); *Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F. 2d 345, 348-349 (C.A. 2), certiorari denied, 325 U.S. 873; *Dyer v. Coe*, 125 F. 2d 192 (C.A.D.C.); *L. Sonneborn Sons, Inc. v. Coe*, 104 F. 2d 230 (C.A.D.C.); *Minnesota Mining & Mfg. Co. v. Coe*, 100 F. 2d 429, 430-431 (C.A.D.C.); *In re Walker*, 99 F. 2d 976 (C.C.P.A.); *In re Youker*, 77 F. 2d 624 (C.C.P.A.); *In re Williams*, 62 F. 2d 86 (C.C.P.A.); *Ottinger v. Ferro Stamping & Mfg. Co.*, 59 F. 2d 640 (C.A. 6); *Denaro v. Maryland Baking Co.*, 50 F. 2d 1074 (C.A. 4) (adopting the opinion of the district court reported at 40 F. 2d 513 (D. Md.)). See also *Old Town Ribbon & Carbon Co. v. Columbia Ribbon & Carbon Mfg. Co.*, 159 F. 2d 379 (C.A. 2) where it is not clear from the opinion whether or not the disclosures in the copending patent were identical or partially anticipatory, but where the opinion clearly shows that that factor is irrelevant.

and explicitly rejected—the distinction which petitioners now seek to create—that copending patents may only be used to show an identical prior invention, but not to show a non-patentable advance in the art. At the outset, Judge Hand notes that the *Milburn* decision (reversing his decision as district judge) now “makes it proper to speak of a prior application as ‘prior art’” (147 F. 2d at 348). Judge Hand then recognizes the contention—made here by petitioners—that “no application will serve to invalidate the later invention except one that contains in its disclosure all that is in the later application”; that a copending application, in other words, “could not be used merely as an encroachment upon the field which the later invention occupied, even although it left unoccupied too little to support a patent” (*ibid.*). Judge Hand goes on (at 348-349):

It is of course possible to reason in this way, but it appears to us to involve the same presupposition which the Supreme Court overruled in *Alexander Milburn Co. v. Davis-Bournonville Co.*, *supra* \* \* \*. That decision—as we understand it—meant to disregard the fact that an earlier application did not at the moment enrich the art; it proceeded upon the assumption—perhaps not fully expressed, but implied—that since its disclosure would eventually fall into the public demesne quite as much as though it were presently published, the interval during which it remained secret should be disregarded. True, that was not necessary for the protection of the first inventor, who needed only that his own claims should be valid; but

*once the first application is treated as prior art when it fully anticipates, there seems to be no reason to deny it whatever effect it could have as prior art, if it were literally such. [Emphasis added.]*

Petitioners, on the other hand, point to no case prior to 1952 where a copending patent was rejected as a reference on the ground which they now urge, namely, that it contained only a partial, rather than a complete, disclosure of the patent in issue. They do suggest that, prior to 1952, a number of cases "held that a copending patent is *not* embraced within the prior art as of its filing date but only as of the issue date." (Pet. Br., p. A-4). From this, petitioners reason that copending patents are not "prior art"—that is, are not valid references—in judging patentability under Section 103, which makes an invention nonpatentable "if the differences between the subject matter sought to be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art \* \* \*." [Emphasis added.]

While most of the cases cited by petitioner do contain general statements that copending patents are not "prior art," it is clear from a study of the complete opinions cited that these dicta represent merely a confusion of terminology in the use of the words "prior art" and not a recognition of rule limiting the use of copending patents as relevant references in judging the patentability of subsequent inventions. Indeed in all but one of the cases upon which peti-

tioners rely, the copending patents involved were, in fact, actually used to judge patentability despite the courts' statements that they were not part of the "prior art." The one exception is *In re Spencer*, 47 F. 2d 806 (C.C.P.A.) which does not contain the general statement that copending patents are not part of the prior art, and which, although it rejects a reference as relevant in judging patentability, apparently does so on the ground that the reference was filed after, rather than before, the patent in issue. See 47 F. 2d at 807. In all the remaining cases, one or more copending patents were used as relevant references. In some cases, *e.g.*, *United Specialties Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C.A. 6), this was done without explicit recognition that use of a copending reference raised any issue of law.<sup>6</sup> In other cases, the opinions contain express recognition that copending references are valid in judging patentability. In *Old Town Ribbon & Carbon Co. v. Columbia Ribbon & Carbon Mfg. Co.*, 159 F. 2d 379, 382 (C.A. 2), for example, Judge Learned Hand, after citing the *Milburn* case, states that "[a]ccordingly we are to treat the disclosure in Foster's [copending] specifications \* \* \* precisely as though it had appeared in a printed publication before Lewis and Menihan [the patent in issue] had filed their application. The validity of the claims in suit therefore depends upon whether they can survive this disclosure \* \* \*." Finally, five of the cases cited by petitioners

<sup>6</sup> Thus, in the *United Specialties* case, the copending Hinkle reference (186 F. 2d at 428) was used in a group along with other, clearly prior, references.

as stating that copending patents are not "prior art" under the doctrine of Section 103, are included in the citations, compiled above in footnote 5, wherein copending patents were used prior to 1952 although they contained only partial, rather than identical, disclosures of the patent in suit, thus directly rebutting petitioners' argument. (*United Specialities Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C.A. 6); *Permo, Inc. v. Hudson-Ross, Inc.*, 179 F. 2d 386 (C.A. 7); *Conmar Products Corporation v. Universal Slide Fastener Co.*, 172 F. 2d 150 (C.A. 2); *In re Walker*, 99 F. 2d 976 (C.C.P.A.); *In re Youker*, 77 F. 2d 624 (C.C.P.A.)).

Hence it is clear that statements in the opinions cited by petitioners, that copending patents are not "prior art," are not directed toward the use of copending patents as references relevant to patentability. Any such view would, indeed, be inconsistent with the uniform course of decisions in this and the lower courts. These statements merely reflect, we submit, the view that, as a matter of terminology, copending references are not *prior art* since they are not made public until after the patent in issue; they are, nevertheless *relevant art* since, under *Milburn*, they are constructively deemed issued on their application dates. "Prior art" was not a statutory term prior to 1952 (it appears only in Section 103, which was added in 1952) and this verbal confusion therefore was wholly irrelevant to the decision of the cases where it occurs. In any event, the verbal uncertainty was resolved by this Court's explicit decision in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, 265, that co-

pending patents were to be viewed as "prior art." See also, e.g., *Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F. 2d 345, 349 (C.A. 2), *supra*, pp. 16-18.

## II

### THE PATENT ACT OF 1952 DID NOT LIMIT THE USE OF COPENDED PATENTS AS REFERENCES RELEVANT TO PATENTABILITY

We have shown above that, prior to the Patent Act of 1952, it was clear beyond doubt that copending patents were relevant references, as of their filing dates, in determining the patentability of subsequent inventions whether or not competing inventors were involved in a contest for the same patent. This was true whether the copending prior reference disclosed the exact invention in the application in issue (as in *Alexander Milburn Co. v. Davis Bournonville Co.*, 270 U.S. 390) or whether it merely disclosed matter, in light of which the application in issue failed to disclose an advance beyond what would have been obvious to one skilled in the art (as in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259). Although some confusion existed as to whether the then non-statutory term, "prior art," was properly used in referring to such relevant copending patents (since such patents were not in the public domain prior to the subsequent invention), there was no doubt of their relevance and this Court, in the *Detrola* case, had indeed included copending patents within the label, "prior art."

We believe it clear, moreover, that no change was made by the 1952 Patent Act. Urging the contrary,

petitioners rely upon Section 103 of the 1952 Act, which, for the first time, expressly incorporated into the statute the rule of *Hotchkiss v. Greenwood*, 11 How. 248, under which changes within the ordinary skill of the art are not patentable. Section 103 reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Petitioners are mindful of the fact that, in addition to codifying the *Hotchkiss* rule for the first time in 1952, Congress also codified, in Section 102(e), the rule of *Alexander Milburn Co. v. Davis-Bournonville Co.*, *supra*, under which copending patents had uniformly been used as relevant references in cases falling under the *Hotchkiss* rule. As part of Section 102, subsection (e) is, indeed, one of a group of references made specifically relevant in judging patentability. Petitioners argue, despite the explicit incorporation of copending patents among these references, that Section 103 must be considered separately and that it looks only to "prior art" in determining whether an advance is patentable. "Prior art" in petitioners' view, cannot be deemed as a matter of language to refer to all the references listed in Sec-

tion 102, but only to those prior *public* references in Section 102(a), *i.e.*, matter "known or used by others in the country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant ~~for~~ patent."

The short answer to petitioners' argument is that, in codifying *Milburn* and *Hotchkiss* in 1952, Congress showed no purpose, either within the statute or in the legislative history, to decrease the role of copending patents under those decisions; hence their previous use as relevant references was retained. That codification alone was intended is apparent: Thus the Reviser's Note to Section 102(e), codifying *Milburn*, states that "Paragraph (e) is new and enacts the rule of *Milburn v. Davis-Bourbonville*, 270 U.S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor." The Reviser's Note to Section 103, codifying *Hotchkiss*, states that the section incorporates a rule as to "lack of invention or lack of patentable novelty" which "has been followed since at least as early as 1850." If, as petitioners argue, the 1952 Act—for the first time—meant to exclude the use of copending patents in Section 103 cases, the Reviser surely would have noted the change.

We conclude, therefore, that "prior art" in Section 103 means to refer—as this Court held in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259—to copending references as well as to all of the other references set forth in the subsections of Section 102. There is no basis for limiting the reference to subsection (a) of Sec-

tion 102 alone. Explicit confirmation of this conclusion that "prior art" refers generally to all of the references described in Section 102 is contained in the Committee Reports accompanying Section 103, where it is stated that the section "refers to the difference between the subject matter to be patented and the *prior art*, meaning what was known before *as described in section 102*" (emphasis added). H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess., p. 6 (1952). Indeed, P. J. Federico, Examiner-in-Chief of the Patent Office and an active participant in the 1952 revision, could not have made this clearer when he stated, with regard to this question, that "[t]he antecedent of the words 'the prior art' \* \* \* lies in the phrase 'dislosed or described as set forth in Section 102' and *hence these words refer to material specified in Section 102 as the basis for comparison.*" (*Commentary on the New Patent Act*, incorporated in Title 35, United States Code Annotated, at pp. 1, 20; emphasis added.) Hence "prior art," as that term is used in Section 103, refers to all of the references described in Section 102, including the copending references defined in subsection (e).<sup>1</sup>

<sup>1</sup> An additional element in the legislative history supports the conclusion that "prior art" in Section 103 refers to all the references described in Section 102, including the copending references defined in subsection (e). The version of Section 103 originally introduced into the First Session of the Eighty-Second Congress (H.R. 3760) would have provided that (emphasis added):

A patent may not be obtained though the invention is not identically disclosed or described in the *prior art set forth in section 102* of this title, if the differences between the subject matter sought to be patented and *that prior art* are such that the subject matter as a whole would have been

The cases decided since the 1952 Act where the question has been fully considered uniformly adopt this construction. For example, in *Application of Harry*, 333 F. 2d 920, 923 n. 1, the Court of Customs and Patent Appeals said that "the legislative history of the 1952 Act makes it clear that 'copending patents' were intended to be part of the 'prior art' [within the meaning of Section 103].". See also *Application of Kander*, 312 F. 2d 834 (C.C.P.A.); *Application of Gregg*, 244 F. 2d 316, 319 (C.C.P.A.) and the decision

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. \*\*\*

Had this version directly become law, it would have been clear beyond doubt from the face of the statute that the "prior art" by which advances in the art were to be judged under Section 103 was "the prior art set forth in section 102"—hence, that it included the copending art described in Section 102(e).

The changes made in Section 103 before enactment, however, indicate that the final version of the bill was meant to broaden even further—rather than to narrow—the "prior art" relevant under that section. These changes were made in response to a suggestion by the Bar Association of the City of New York that the language of the proposed Section 103 be changed so as "to make it clear that all prior art is here meant and not merely the prior art referred to in section 102 which is limited to anticipatory art." Senate Subcommittee on Patents, Trademarks and Copyrights, *Effects To Establish a Statutory Standard of Invention*, Study No. 7, 85th Cong., 1st Sess. p. 15. Specifically, the Association recommended that this be accomplished through the substitution of the word "as" for the phrase "in the prior art" in the original bill and by the substitution of the word "the" in place of the word "that" immediately following the conjunction "and" in the original. Hearings Before Subcommittee No. 3 of the House Committee on the Judiciary, 82d Cong., 1st Sess., p. 221 (1951). These changes were made and incorporated into the final bill as enacted. Thus "the prior art" in Section 103 indubitably means to include copending references as described in Section 102(e).

of the district court in this case (226 F. Supp. 459; R. 69, 73), with which the court of appeals, affirming *per curiam*, agreed.

Petitioners cite three cases allegedly to the contrary: *Weatherhead v. Drillmaster Supply Co.*, 227 F. 2d 98 (C.A. 7); *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148 (C.A. 2); and *John Blue Co. v. Dempster Mill Mfg. Co.*, 275 F. 2d 668 (C.A. 8) (see Petitioner's Brief at p. A-4 and pp. 15-20). The *John Blue* case reveals nothing in petitioner's favor beyond some continuing confusion regarding terminology; the copending patent there involved was, in fact, used as a relevant reference to judge patentability. Thus after noting that the Blue Patent, cited against the patent in issue, was copending, the court said: "It is true that the application for the Blue Patent cannot be considered as prior art in the technical sense, but it is a widely recognized rule that the application for such patent can nevertheless be used as defense material to prove that Blue and Johnson were not the original and first inventors or discoverers \* \* \*" (275 F. 2d at 672). *Weatherhead*, it is true, does contain a statement that a copending patent "could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention" (227 F. 2d at 101) and similar language appears in *Helene Curtis* (see 233 F. 2d 156). These statements are dicta since, in both cases, the claims at issue were ultimately held unpatentable in the light of the prior art. In addition the *Weatherhead* case involved a situation of double patenting

by a single inventor, where special considerations apply which are inapplicable when different copending patentees are involved; and *Helene Curtis* contains the statement, seemingly in contradiction to the dictum relied upon by petitioners, that copending patents were "anticipatory under the doctrine of *Alexander Milburn Co. v. Davis-Bournonville Co.*, \* \* \* now codified in 35 U.S.C.A. § 102(e)" because "a portion of each of these patents falls within the area of" the invention in issue (233 F. 2d at 158). Finally, neither of these decisions makes reference to this Court's decision in *Detrola Corp. v. Hazeltine Corp.*, *supra*, explicitly holding copending patents "prior art" for purposes of showing lack of patentable invention over the art; nor do they refer to the explicit legislative history to the same effect accompanying the 1952 Patent Act. To the extent that these dicta mean to indicate a preclusion of the use of copending patents as relevant art under Section 103, therefore, we submit that they are plainly erroneous.

Finally, petitioners argue that "[s]imple principles of equity and fair play" require that copending patents not be included in the art relevant under Section 103. (Pet. Br., pp. 23-25). Since such copending patents must "be kept in ~~accordance~~ by the Patent Office" (35 U.S.C. 122) petitioners urge that a worker skilled in the art would not, in fact, be aware of them before his subsequent invention and, hence, that his invention should not be judged in their light.

It is true that under the rule applied to copending patents since the *Milburn* decision, inventors who may

have every reason to believe that they have arrived at a patentable invention may be denied patents because of information disclosed in copending patents of which they could not have known. The test of patentability, however, is not whether the applicant believes that he has made an invention in the subjective sense (see *Radio Corporation of America, et al. v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 11-14; *Sewall v. Jones*, 91 U.S. 171, 180; *Evans v. Eaton*, 3 Wheat. 454, 513-514; see also Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 21); it is whether the invention represents a significant advance over the art, objectively viewed. (See H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess., p. 6 (1952)). Thus, whether or not the inventor actually knew, or could have known, of the "prior art" material at the time he made his invention is irrelevant. The relevant question is whether his "invention," if patented, would constitute a significant contribution in light of other elements available to the public at the time his patent would issue, and a prior copending patent which is ultimately issued would be such a previously publicly available development.

This precise situation confronted the Court in *Milburn*. There, as here, a copending application, the existence of which the later applicant could not have known, disclosed the subject matter of the subsequent application. Notwithstanding the rule requiring the secrecy of patent applications, the Court held the teachings of the prior copending application relevant in testing the patentability of the later application.

Petitioners' suggestion (Pet. Br., p. 24) that "unfairness" in the *Milburn* case was overbalanced by the need to reward the prior of two rival inventors, is not borne out. In *Milburn*, the prior copending patentee did not claim the invention claimed in the subsequent application, and the two inventors were not rivals. It was this factor which led the district court and court of appeals, to hold the subsequent patent valid and it was the relevance of the presence of such a competing prior patentee which this Court explicitly rejected in reversing those decisions below. See pp. 11-13, *supra*.

Petitioners, on the other hand, ignore the unjustifiable burdens upon the public and the prior inventor that would potentially be caused by the issuance of two or more overlapping patents which, except for non-patentable variations, would cover the same subject matter. If both the Wallace and Regis patents were to issue, for example, a member of the public wishing to use the single patentable innovation embodied in both might have to obtain licenses from both patentees, and Wallace, the prior inventor, might have to obtain a license from Regis in order to make use of Regis' non-patentable variation. In addition, the Regis patent would improperly extend the monopoly on the basic invention vis-a-vis the general public beyond the statutory period previously awarded to Wallace. For these reasons, as well as those made explicit in the *Milburn* decision and the legislative history of the 1952 Act, the copending and ultimately issued Wallace patent was properly used to judge the patentability of Regis' application under Section 103 of the Patent Act.

## CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted,

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OCTOBER 1965.

2000, May

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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1965

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No. 57

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HAZELTINE RESEARCH, INC. and ROBERT REGIS,  
*Petitioners*,  
vs.

DAVID L. LADD, COMMISSIONER OF PATENTS,  
*Respondent*.

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**REPLY BRIEF FOR PETITIONERS**

**I. INTRODUCTION**

There are two faulty arguments that pervade Respondent's Brief\* and tend seriously to confuse rather than to clarify the single issue before the Court. The first untenable argument is that a copending patent negatives "patentability" of a later filed patent application under *all* sections of the Patent Act which establish the conditions for patentability. The second erroneous argument is based on the false assumption that at any time the Patent Office or other cognizant tribunal finds it necessary to supply a deficiency in the disclosure of a copending patent by reference to the prior art, e.g., to prior issued patents, the deficiency thus supplied is inevitably "insignificant".

Further, Respondent's Brief includes a number of statements and arguments which are believed to be erroneous or misleading. These will be taken up in order after discussion of the two foregoing main points.

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\* For brevity, the Brief for the Commissioner of Patents, Respondent, is cited as BR

## II. COPENDING PATENTS NEGATIVE PATENTABILITY OF LATER FILED PATENT APPLICATIONS ONLY UNDER SECTION 102(e) OF THE PATENT ACT.

The "conditions for patentability", expressed negatively, are set forth in the seven subsections of Section 102 and in Section 103 of the Patent Act (Title 35, U.S.C., Sections 102, 103; BP, pp. 2-3\*). Under Section 102(e), "patentability" of an invention claimed in a patent application is negated by an earlier-filed copending patent describing "the invention", the copending patent showing that the later applicant was not the first inventor. Under Section 103, "patentability" of an invention claimed in a patent application is negated by showing that such invention represents but an obvious departure from the prior art. These are the two premises of Respondent's false syllogism. Other subsections of Section 102 set forth other bars to patentability of inventions.

From the foregoing two correct premises, Respondent jumps to the false conclusion that copending patents are "relevant" to "patentability" *generally* under the Patent Act and *specifically* under Section 103. It has been shown previously (BP, pp. 7-20) that copending patents are not within the term "prior art" as that term is used in Section 103.

Respondent repeatedly cites decisions or authorities enunciating the *specific* principle that copending patents may be employed to negative "patentability" under Section 102(e) (or under the principle of *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390, codified by Section 102(e)) but then erroneously relies upon these authorities for the proposition that such copending patents can be utilized to negative "patentability" *generally* under all sections of the Patent Act dealing with "con-

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\* For brevity, the Brief for Petitioners is cited herein as BP .

ditions for patentability." A few examples will illustrate this over-generalization. Thus Respondent argues:

"The Patent Office and the courts below invoked the principle—established by this Court's 1926 decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390—that, for the purpose of judging the *patentability* [emphasis added] of a subsequent invention, a copending and ultimately issued United States patent *dates from the time when the application was filed* [emphasis Respondent's] rather than from the date when the patent is ultimately issued. \* \* \* \* (BR, pp. 6-7)

But it is recognized that the *Alexander Milburn* case decided *only* that such a copending patent may be used to show that the inventor of the application in issue was not the first inventor, now covered by Section 102(e).

Again, Respondent argues:

"\* \* \* The principle of the *Milburn* case, originally a judicial gloss upon the patent statute, has since been explicitly codified in Section 102(e) of the 1952 Patent Act (35 U.S.C. 102(e)), providing that a patent shall not issue if 'the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.' The 1952 Act [impliedly including all sections and subsections of the Patent Act establishing conditions for patentability] thus treats copending patents as equivalent to previously issued patents, which are relevant references under Section 102(a) (35 U.S.C. 102(a))." (BR, p. 7)

The final sentence of the foregoing excerpt from Respondent's Brief is clearly a *non sequitur*.\*

\* This false argument is reiterated elsewhere throughout Respondent's Brief:

"• • • it was • • • entirely clear before the 1952 Act that disclosures of prior inventions in copending patents • • • were competent, under the rule of this Court's *Milburn* decision, to negate *patentability* for lack of a significant advance in the art under *Hotchkiss v. Greenwood*. • • •" (pp. 8-9; emphasis added)

"• • • Indeed in all but one of the cases upon which petitioners rely, the copending patents involved were, in fact, actually used to judge *patentability* despite the court's statements that they were not part of the 'prior art.' • • •" (pp. 18-19; emphasis added)

"• • • *In re Spencer*, 47 F.2d 806 (C.C.P.A.) • • • does not [emphasis Respondent's] contain the general statement that copending patents are not part of the prior art, and • • •, although it rejects a reference as relevant in judging *patentability*, [emphasis added] apparently does so on the ground that the reference was filed after, rather than before, the patent in issue. • • •" (p. 19)

"Hence it is clear that statements in the opinions cited by petitioners, that copending patents are not 'prior art,' are not directed toward the use of copending patents as references *relevant to patentability*. • • •" (p. 20, emphasis added)

"• • • copending references are not *prior art* since they are not made public until after the patent in issue; they are nevertheless *relevant art* • • •" (p. 20; emphasis Respondent's)

"• • • prior to the Patent Act of 1952, it was clear beyond doubt that copending patents were *relevant* references, as of their filing dates, in determining the *patentability* of subsequent inventions • • •" (p. 21; emphasis added)

"• • • Although some confusion existed as to whether the then non-statutory term, 'prior art,' was properly used in referring to such *relevant* copending patents • • • there was no doubt of their *relevance* • • •" (p. 21; emphasis added)

"• • • Congress also codified, in Section 102(e), the rule of *Alexander Milburn Co. v. Davis-Bourbonville Co.*, *supra*, under which copending patents had uniformly been used as *relevant* references in cases falling under the *Hotchkiss* rule. • • •" (p. 22; emphasis added) [*Hotchkiss v. Greenwood* (1850) 11 How. 248, did not involve a consideration of copending patents at all; it stands only for the principle that an invention is not patentable if it was obvious in the light of admitted prior art, now codified in Section 103.]

"• • • As part of Section 102, subsection (e) is, indeed, one of a group of references made specifically *relevant* in judging *patentability*. • • •" (p. 22; emphasis added)

Thus Respondent has introduced serious confusion into the case by repeated references to authorities applying copending patents under Subsection 102(e) of the Patent Act but arguing that such holdings extend the applicability of copending patents to *all* sections of the Patent Act dealing with conditions for patentability.

### III. RESPONDENT'S POSITION RESTS ON THE FALSE PREMISE THAT REFERENCES TO THE PRIOR ART TO SUPPLY DEFICIENCIES OF AN INCOMPLETE DISCLOSURE OF A COPENDING PATENT ARE INEVITABLY "INSIGNIFICANT"

Respondent repeatedly and mistakenly states Petitioners' position, asserting it to be that a copending patent cannot be used to negative patentability of an invention which is only an *insignificant* variation of the disclosure of a copending patent. Thus Respondent argues:

“\* \* \* Specifically, petitioners urge that while the *Milburn* rule applies when a copending patent discloses the *exact* [emphasis Respondent's] invention claimed in an application on a subsequent ‘invention,’ the rule does not apply when the subsequent application contains *some* difference from, or variation upon, the copending patent. This is so, petitioners argue, *even though the difference or variation, as in this case, is an insignificant one* which would not constitute a patentable advance over the copending patent under Section 103.” (pp. 7-8; emphasis added)

“\* \* \* The *John Blue* case reveals nothing in petitioners' favor beyond some continuing confusion regarding terminology; the copending patent there involved was, in fact, used as a *relevant* reference to judge *patentability*. \* \* \*” (p. 26, emphasis added)

“\* \* \* Notwithstanding the rule requiring the secrecy of patent applications, the Court [in *Alexander Milburn, supra*] held the teachings of the prior copending application *relevant* in testing the *patentability* of the later application. \* \* \*” (p. 28; emphasis added)

Petitioners have not taken, and do not take, any such position. A copending patent will bar the grant of a patent for an invention which represents only an insignificant variation thereover in the same way that a single prior art patent will preclude the grant of a patent on an insignificant variation thereover under Section 102(a), without reference to any additional prior art.

A simple example may serve to illustrate. Assume, *arguendo*, that the Wallace et al. patent (R. 54A) disclosed everything claimed by Regis except for a simple cabinet to house it. Putting anything in a cabinet or a housing is a matter of such common knowledge and such an insignificant variation that no citation of prior art showing the use of a cabinet would be required. As stated in *Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d 150, 153, any "competent worker in the field" \* \* \* would have found the means at hand". Under such an assumption, the invention of the Wallace et al. copending patent and the Regis invention would, in effect, be the *same* invention and, under Section 102(e), Wallace et al. would bar the grant of a patent to Regis.

*But the factual situation of this case is not within the foregoing assumption nor is it within Respondent's above-quoted statement.* The Regis invention is not an insignificant variation of the disclosure of the Wallace et al. patent and neither the Patent Office nor the Courts below ever contended that it was. The Patent Office rejected the Regis claim to a patent solely "as being unpatentable over Wallace et al. in view of Carlson" (R. 20A, 23A, 43A). As pointed out previously (BP, pp. A-2, A-3), the Wallace et al. patent (R. 54A) discloses a shutter for interrupting the flow of microwave energy through a waveguide while the Carlson patent (R. 50A) discloses a piece of laboratory test equipment, called an attenuator, calibrated to indicate the amount of attenuation of a microwave signal passing down a hollow waveguide. There is no indication whatever that

the technical disclosure of the Carlson patent, which the Patent Office proposed to add to that of Wallace et al., is an insignificant one. The presumption is that it is not, for Carlson was granted a patent on it.

Respondent further introduces confusion into the case by reiterating this factual misstatement at several points of its Brief:

“\* \* \* the answer was not always so clear in cases where the copending applications did not claim a patent on *exactly* the same invention, but where the disclosures in the prior copending patent nevertheless would, if considered to be part of the relevant art, affect the patentability of the subsequent patent by showing it to be *an insignificant advance* in the art. \* \* \*” (pp. 10-11; emphasis added)

“\* \* \* In the instant case, Wallace and Carlson did not thus completely describe the Regis invention; they did, however, make claims, in light of which Regis' invention is unpatentable as *an insignificant advance* in the art. \* \* \*” (p. 13; emphasis added)

“\* \* \* Regis is, consequently, unpatentable whether identically disclosed by Wallace and Carlson or *merely an insignificant advance* over those two patents.” (p. 14; emphasis added)

#### IV. MISCELLANEOUS COMMENTS

Respondent cites (BR, p. 16) a large number of cases which it asserts supports its position that a copending patent is prior art as of its filing date. The majority of these cases were previously cited by Petitioners (BP, p. A-5). However, it is submitted that the following cases, included by Respondent, do not support this position, or support it only with qualification:

*Industrial Wire Cloth v. United Specialties* (C.A. 6, 1951) 186 F.2d 426

*Permo v. Hudson-Ross* (C.A. 7, 1950) 179 F.2d 386

*Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d 150

*In re Youker* (CCPA, 1935) 77 F.2d 624

*Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159 F.2d 379

*Western States v. S. S. Hepworth* (C.A. 2, 1945) 147 F.2d 345.

In the event the Court is interested in considering the actual holdings in these cases, an analysis of the facts and the ruling of each is included in the Appendix to this Reply Brief. These analyses answer fully Respondent's misinterpretation of the *Western States Machine* decision (BR, pp. 16-18) and the *Old Town Ribbon* decision (BR, p. 19) as well as its criticism of Petitioners' citation of a number of these cases as supporting their position (BR, p. 20).

Respondent's Brief contains a number of inaccurate or misleading statements which require comment. It is believed that the errors can be pointed out most readily by setting out the criticized statements and the comments thereon in parallel columns.

<i>Respondent's Statement</i>	<i>Comment</i>
1. "It has always been assumed, as petitioners acknowledge, that an invention is unpatentable if the identical invention, achieved at a prior time by another inventor, is claimed in a copending patent application. This result follows <i>not from any special rule</i> as to copending patents, but from the basic and guiding principle that priority is determinative. * * *" (p. 10; emphasis added)	In fact there is a "special rule" applying to copending patents—namely Section 102(e) of the Patent Act. However, Petitioners agree that the "guiding principle (of) priority is determinative". That is why the Wallace et al. patent is not a bar to the grant of a patent on the Regis application for the Patent Office never contended that Wallace et al. were prior inventors of the Regis invention.

## Respondent's Statement

## Comment

2. "• • • *Milburn* means that, 'for the purpose of anticipating a subsequent inventor,' 'a United States patent disclosing an invention dates from the date of filing the application.' Under this standard, the *Regis* invention in this case was unpatentable, since it disclosed no patentable advance over *Wallace et al.*, which had been previously filed in the Patent Office." (p. 13)

3. "Indisputably, the copending patents referred to in *Detrola* were of the type involved in the instant case, *i.e.*, patents not identical with the subsequent invention, but in light of which that invention would have been obvious to one skilled in the art within the doctrine of *Hotchkiss v. Greenwood, supra*, and Section 103 of the Act. • • •" (p. 15)

4. "• • • Indeed, P. J. Federico, Examiner-in-Chief of the Patent Office and an active participant in the 1952 revision, could not have made this clearer when he stated, with regard to this question, that '[t]he antecedent of the words "the prior art" • • • lies in the phrase "disclosed or described as set forth in Section 102" and hence these words refer to material specified in Section 102 as the basis for comparison.' (*Commentary on the New Patent Act*, • • • emphasis added.) • • •" (p. 24)

The last sentence is untrue. The Patent Office never contended that the *Regis* invention "disclosed no patentable advance over *Wallace et al.*" and it is not a fact. It held only that if to the invention of *Wallace et al.* were added the invention of *Carlson*, then, and only then, would the combination anticipate the *Regis* invention.

As previously pointed out (BP, pp. 17-19), each of the reference patents relied on by defendant in the *Detrola* case was held individually to show that *Wheeler* was *not the first inventor*. The doctrine of *Hotchkiss v. Greenwood* was not involved and was not referred to by this Court in the *Detrola* decision.

This reference to a definition of the term "prior art" in Section 103 is merely one unofficial commentator's view. Moreover, this commentator, immediately following the quoted sentence, quotes with tacit approval the portion of the same Committee Report which is relied upon by Petitioners (BP, p. 8). As there pointed out, the Committee Report defines the term "prior art" as meaning what "was known before as described in Section 102" that is, in Section 102(a), which is the only subsection referring to what "was known • • • before".

## Respondent's Statement

## Comment

5. "This precise situation confronted the Court in *Milburn*. There, as here, a copending application, the existence of which the later applicant could not have known, disclosed the subject matter of the subsequent application. \* \* \*" (p. 28; emphasis added)

6. "• • • Petitioners' suggestion (Pet. Br., p. 24) that 'unfairness' in the *Milburn* case was overbalanced by the need to reward the prior of two rival inventors, is not borne out. In *Milburn*, the prior copending patentee did not claim the invention claimed in the subsequent application, and the two inventors were not rivals. \* \* \*" (p. 29)

7. "Petitioners, on the other hand, ignore the unjustifiable burdens upon the public and the prior inventor that would potentially be caused by the issuance of two or more overlapping patents which except for *non-patentable variations*, would cover the same subject matter. If both the Wallace and Regis patents were to issue, for example, a member of the public wishing to use the *single patent*

This statement is but a reiteration of Respondent's contention that the Wallace et al. copending patent "disclosed the subject matter of the subsequent application" of Regis. The Patent Office never so contended (*supra*, pp. 6-7) and it is not a fact.

This is a serious distortion of Petitioners' position as stated in their Brief:

"• • • There, but for the rule, a patent could issue to one who actually made an invention *after* the inventor of the copending patent, who could then take away the right of the earlier inventor to practice his own invention, a common law right arising from the creative act of invention. \* \* \*" (p. 24; emphasis in original)

Petitioners' position includes no question of any *reward* to a prior inventor.

At this point, Respondent merely rings the changes on its unfounded and untrue assertion that the Regis and Wallace et al. disclosures are for a "single patentable innovation". The Patent Office never so contended and it is not a fact (*supra*, pp. 6-7). If the Regis patent were granted, neither the public nor Wallace et al. would require a license thereunder to utilize the invention of the Wallace et al.

*Respondent's Statement**Comment*

*able innovation* embodied in both might have to obtain licenses from both patentees, and Wallace, the prior inventor, might have to obtain a license from Regis in order to make use of Regis' non-patentable variation. In addition, the Regis patent would improperly extend the monopoly on the basic invention vis-a-vis the general public beyond the statutory period previously awarded to Wallace.  
 \* \* \* (p. 29; emphasis added)

patent. Moreover, the Regis patent, being for an invention admittedly not disclosed by Wallace et al., would not extend the monopoly of that patent vis-a-vis the general public.

## V. CONCLUSION

In conclusion, it is submitted that nothing in Respondent's Brief is an adequate basis for refusal of the relief sought by Petitioners and that such relief should be granted.

Respectfully,

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**APPENDIX**

This Appendix is an analysis of authorities erroneously cited by Respondent in support of its position that a co-pending patent is competent evidence of the "prior art" as of its filing date:

*Industrial Wire Cloth v. United Specialties* (C.A. 6, 1951) 186 F.2d 426. This case involved three patents of one Zander filed on February 25, 1932, April 12, 1933, and February 19, 1934, respectively. The three patents were held invalid over a group of prior art patents, that is, patents issued before the filing dates of any of the Zander patents. Defendant also urged as anticipation of all of the three patents, copending patents to Hinkle, issued March 29, 1932, and Garner, issued February 14, 1933. In rejecting this defense, the Court said:

"While we do not agree with the district court that a prior but co-pending application belongs in the prior art, *Toledo Plate & Window Glass Co. v. Kawneer Mfg. Co.*, 237 F. 364 (C.C.6), when the issues do not involve priority of conception and putting into practice, we do agree that Zander's second and third patents are invalid. \* \* \* \* (p. 429-430) [That is, the Zander patents filed April 12, 1933, and February 19, 1934, after the issuance of the Hinkle and Garner patents which were not copending with these two later Zander patents.]

*Permo v. Hudson-Ross* (C.A. 7, 1950) 179 F.2d 386. The Semple patent in suit was filed January 28, 1942. Defendant alleged that it was invalid over five patents, all copending with the application for the Semple patent, which defendant urged constituted "prior art." In rejecting this defense, the Court said:

"But it is not necessary for us here to determine whether the co-pending applications of the patents hereinbefore described should be considered as prior

art in the technical sense, for it is a widely recognized rule that even though such co-pending application which ripens into a patent may not be a part of the prior art in its usual sense, the application for such patent can nevertheless be used to prove that the patentee of the patent in suit was not the original and first inventor or discoverer of any material or substantial part of the thing patented. (Citing cases) \* \* \* (p. 389)

The Court then went on to affirm the decision of the District Court to the effect that each of the patents cited by defendant individually and independently showed:

“\* \* \* Semple was not the original or first inventor or first discoverer of any material or substantial part of the thing patented \* \* \*.” (p. 390)

*Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d 150. This action involved two patents on slide fasteners (zippers), one to Wintritz and one to Ulrich. As to the Wintritz patent, the Court held that a copending patent to Poux showed that Wintritz was not the first inventor, saying:

“It is true that Poux was not a part of the prior art when Wintritz filed his application; but he was a prior inventor, and the validity of Wintritz’s invention depends upon the same considerations as though Poux had been in the prior art; i.e., whether the steps he took beyond Poux, — his variations upon Poux’s theme, — were of themselves an invention. \* \* \* (p. 152)

\* \* \*

“\* \* \* taken merely as a conception, Poux was the prior inventor, for Poux’s disclosure was for a process in two separate steps. A competent workman in the field who wished to follow Poux would have found the means at hand in Sundback’s machine. These claims are also invalid.” (p. 153)

The essence of the last-quoted excerpt is that Wintritz and Poux described essentially the same invention—any difference in the Wintritz disclosure over the Poux disclosure was an insignificant one as to which any “competent workman in the field \*\*\* would have found the means at hand \*\*\*.” The Court then held the Ulrich patent invalid upon either of two prior art patents which were *not* copending.

*In re Youker* (CCPA, 1935) 77 F.2d 624. In this case, the Patent Office had rejected the application in issue on three copending patents. The decision of the Court is ambiguous. It includes a correct statement of the law:

“It appears that the patents to Seguy, Howard et al. and Dickson were not issued until after appellant had filed his application. Therefore, they are not technically a part of the prior art, \*\*\* they show prior invention of their subject-matter and we must assume that appellant may not properly be held to be the first inventor of anything disclosed by them or of anything not patentably distinct from them. *In re Smith*, 17 C.C.P.A. (Patents) 752, 36 F.(2d) 522.” (p. 624)

Moreover, the opinion includes a further statement seeming to hold that *each* of the cited reference patents individually and independently showed that Youker was not the first inventor and thus, to apply the rule previously stated:

“In view of the concessions of appellant, it is not deemed necessary to recite in detail the disclosures of each reference. His brief concedes that his steps 1, 2, and 3, as above set forth, are taught by at least three of the references, viz., Seguy, Howard et al. and Shevlin.” (p. 625)

Later in the opinion, nevertheless, the Court did express approval of a holding of the Patent Office that it would

have been obvious to modify the structure of one of the copending patents in view of the teaching of another, which necessarily requires a consideration of them as a part of the prior art. This portion of the opinion appears to be inconsistent with the correct principle previously set forth in the opinion.

*Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159 F.2d 379. This action involved a Lewis et al. patent on a "hectograph" copy sheet. Judge Hand held the patent claims in issue invalid because a copending patent to one Foster showed that he was the prior inventor. In so doing, the Court said:

"\*\*\* we hold that Foster's patent No. 2,060,190, issued on November 10, 1936, upon an application filed January 10, 1935, is a 'prior invention' to the patent in suit, \*\*\*. (p. 380)

"Foster filed his application over twenty months before Lewis and Menihan filed theirs, but his patent did not issue until after they had filed, and his disclosure was therefore not prior art; if it is to invalidate their claims it must be because he was the 'prior inventor.' \*\*\*" (p. 381)

Judge Hand continued by analyzing the decision of this Court in the *Alexander Milburn* case, *supra*, pointing out that one must look to the *disclosure* of a copending patent, not to its claims, to determine whether the patentee was a prior inventor, drawing an analogy to the disclosure in a prior publication or prior public use, neither of which, of course, includes any patent claims at all. It is in this light that Judge Hand continued with the statement quoted in Respondent's Brief (p. 19):

"\*\*\* Accordingly we are to treat the disclosure in Foster's specifications of the past practice of using double sheets to prepare a 'master sheet' for use in Ritzerfeld's machine precisely as though it had ap-

peared in a printed publication before Lewis and Menihan had filed their application. The validity of the claims in suit therefore depends upon whether they can survive this disclosure, \* \* \*." (p. 382)

In the context of Judge Hand's preceding discussion, it is clear that in the last-quoted statement he was adverting merely to the fact that in considering the anticipatory effect of a copending patent, the claims of that patent are to be disregarded. There is nothing in Judge Hand's decision which suggests that a copending patent is competent as of its filing date, to show anything other than that a later applicant for the same invention was not the first inventor.

*Western States v. S. S. Hepworth* (C.A. 2, 1945) 147 F.2d 345. This case involved four patents relating to centrifuge mechanisms. The first patent, No. 1,758,901 to Roberts, filed May 13, 1930, the Court termed the "control patent." Defendant urged as an anticipation of that patent a patent to Carlson 1,669,927, granted May 18, 1928, virtually two years before the filing date of the Roberts patent and therefore not a copending patent at all. While the opinion includes an extended philosophical discussion of the rationale of the decision of this Court in *Alexander Milburn, supra*, the final holding of the Court was that the patent was valid but not infringed.

While Petitioners listed this *Western States* decision as one holding *contra* to its position (BP, A-5), actually the language so stating is pure dictum since the patent was held to be valid. Consequently, the dictum in the *Western States* opinion must give way to a clear and correct statement and application of the law by the same Court and the same Judge in the *Old Town Ribbon* case decided approximately two years later.

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IN THE  
Supreme Court of the United States  
OCTOBER TERM, 1965

No. [REDACTED]

57

HAZELTINE RESEARCH, INC. and ROBERT REGIS,  
*Petitioners*,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS,  
*Respondent*.

On Certiorari to the United States Court of Appeals for the  
District of Columbia Circuit

MOTION FOR LEAVE TO FILE BRIEF AS AMICUS CURIAE  
AND BRIEF IN SUPPORT OF PETITIONER

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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1965

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No. 919

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HAZELTINE RESEARCH, INC. and ROBERT REGIS,  
*Petitioners*,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS,  
*Respondent*.

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On Certiorari to the United States Court of Appeals for the  
District of Columbia Circuit

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**MOTION FOR LEAVE TO FILE BRIEF AS AMICUS CURIAE  
IN SUPPORT OF PETITIONER**

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Irwin M. Aisenberg, pursuant to rule 42 of the Revised Rules of the Supreme Court of the United States, respectfully moves for leave to file, in the above-entitled case, his brief *amicus curiae*, annexed hereto, which supports the position of Hazeltine Research, Inc. and Robert Regis, petitioners herein. Pursuant

to Rule 42, the consent to file brief amicus curiae was requested of the parties, but was denied.

The interest of amicus is purely academic, although it was initiated a number of years ago in connection with actual cases in private practice. Said cases have since been terminated, and amicus is now a corporate patent counsel with no cases involving the subject issue.

Amicus has extensively researched the sole point of law in issue, including a review of every published court decision directed thereto since *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390, and a review of the legislative history of Title 35 U.S. Code, Section 102 (66 Stat. 797) and Section 103 (66 Stat. 798). His analysis and reasoning are materially different than their counterparts in the Petitioners' brief.

Historically, the issue has most often been attacked from the standpoint of facts peculiar to individual cases without due consideration of the "overall picture". As a result the case law provides many conflicting views with no uniform rational analysis. To resolve existing conflicts, the particular facts of the case should be evaluated in the light of the entire law on the subject issue. Petitioners' brief is directed to the specific facts of their case; the amicus brief considers the pertinent case and statutory law from a broader viewpoint. The assimilation of the particular facts within the framework of the broader viewpoint will provide guidelines which others can understand and follow and will resolve the conflicts engendered by the unduly limited viewpoint of prior lower court decisions.

Moreover, the analysis and reasoning of amicus are based in part on analogies beyond those considered in said Petitioners' brief. In the legislative history of

the current statutory provisions in issue, for example, one of the proposed bills illustrated the intent to exclude copending patents from a precursor to Title 35 United States Code, Section 103. The fact that a copending patent of a patentee (or applicant for U.S. Letters Patent) cannot be employed as prior art is also significant in the consideration of the sole question before the Court. These points and others not covered by the Petitioners' brief are presented in the appended brief. Since they lead to conclusions contrary to the position of the Commissioner of Patents, it is considered unlikely that they will be offered in the brief of the Solicitor General.

The amicus brief provides the perspective for the evaluation of the point of law before the Court; it is directed to the background and very foundation from which the ultimate decision will conclude.

For the reasons stated, amicus respectfully requests leave to file the attached brief in support of the Petitioners.

Respectfully submitted,

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IN THE

**Supreme Court of the United States**

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On Certiorari to the United States Court of Appeals for the  
District of Columbia Circuit

  
**BRIEF AMICUS CURIAE**

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**INTRODUCTORY STATEMENT**

Such portions of the brief of Hazeltine Research, Inc. and Robert Regis, petitioners herein, setting forth the Opinions Below, the Jurisdiction, the Statutes Involved, the Question Presented and the Statement of the Case are adopted.

The interest of the amicus in this cause is fully set forth in the motion preceding this brief.

**SUMMARY OF ARGUMENT**

A patent issued subsequent to the filing date of an application for United States Letters Patent is *not* "prior art" with respect to the application within the meaning of Title 35 U.S. Code, Section 103 (66 Stat. 798).

**ARGUMENT****THE STATUS OF COPENDED PATENTS FOR PRECLUDING PATENTABILITY**

One of the most difficult concepts of patent law is the status of subject matter described, but not claimed, in a patent. It is clear from the landmark decision in *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390, that the validity of a patent can be negated by subject matter constructively reduced to practice in a copending patent, i.e. a patent filed prior to but issued subsequent to the filing date of the subject patent. The theory upon which patentability is precluded is that the patentee is not the *first inventor* [Title 35 U.S. Code, Section 102(e) (66 Stat. 797)] of the claimed invention because said invention was previously constructively reduced to practice by another prior to the patentee's earliest provable date.

**Constructive Reduction to Practice**

Constructive reduction to practice is accorded the same status as an actual reduction to practice for the purpose of negating first inventorship. Of the essence is that any subject matter relied upon in a copending patent must be constructively reduced to practice therein. Not all subject matter disclosed in a patent satisfies the requirements.

A description of an invention in a formal application for United States Letters Patent, which description is sufficient to support an allowable claim to the invention, renders the application a constructive reduction to practice (See "Walker on Patents", Deller's Edition, Baker Voorhis and Co., 1937, Vol. II, Sec. 204) of said invention, effective as of the filing date of said application. A copending continuing United States application containing a description of the said invention sufficient to support an allowable claim thereto is also a constructive reduction to practice, of said invention; the effective date of the constructive reduction to practice, however, is the filing date of the parent copending application, even though the parent application may have been either abandoned or patented *subsequent* to the filing date of the continuing application.

A constructive reduction to practice in the United States exists only a) while the application containing same or a continuation thereof is pending in the United States Patent Office, and/or b) after either has issued as a United States Patent. [But, see *James B. Clow and Sons, Inc. v. U. S. Pipe and Foundry Co.* (C.A. 5, 1963) 313 F. 2d 46, (C.A. 5, 1965) 146 USPQ 320, and *United Chromium, Inc. v. General Motors Corporation et al.* (C.A. 2, 1936) 85 F. 2d 577.] The effective date of a constructive reduction to practice of a claimed invention may be prior to the actual filing date in the United States if the requirements of Title 35 U.S. Code, Section 119 (66 Stat. 800) are satisfied.

The test for sufficiency of compliance of an application with Title 35 U.S. Code, Section 112 (66 Stat. 798) to constitute a constructive reduction to practice is what the application as a whole communicates to one skilled in the art. The application need not expressly

set forth matters commonly understood by person skilled in the art [*Carnegie Steel Co., Ltd. v. Cambria Iron Co.*, (1902) 185 U.S. 403; *In re Johnson* (1960) 48 CCPA 733, 282 F. 2d 370; *Lafon v. Zirm and Pongratz* (PO Bd. Pat. Inter, 1962) 141 USPQ 442; *Stauffer Chemical Co. et al. v. Watson* (D.D.C., 1954) 119 F. Supp. 312; *The Webster Loom Co. v. Higgins et al.* (1882) 105 U.S. 580].

#### **Identity of Invention vs. Patentability Over**

There are two further concepts of patent law which are inextricably "tangled" with and are much less developed than the issue at hand. What has been for years a "catch-all" phrase: "unpatentable over", includes both. [See *In re Sebek and Spero* (1965) 52 CCPA, 44, 46.] 146 USPQ 44, 46.]

The same invention can be expressed by a plurality of people in different terms and even with different limitations. [See *In re Siu* (1955) 42 CCPA (Patents) 864, 222 F. 2d 267.] No matter how an invention is claimed, one is not entitled to a patent therefor if the *same* invention was constructively reduced to practice earlier by another because the claimant is not the first inventor of said invention. This is a concept of identity of invention upon which 35 U.S.C. 102(e) and the Milburn decision are based. In fact the entire Section (Title 35 U.S. Code, Section 102) is directed to the identity of the invention.

The other concept concerns a plurality of inventions, one of which is "not patentable over" the other(s). All new and distinct inventions are not patentable. The test for patentability for new and distinct inventions is provided by 35 U.S.C. 103. It is thus seen

that Section 103, directed to distinct inventions, is conceptually incompatible with Section 102, directed to the same invention.

#### **First Inventorship**

The issue of first inventorship is the sole subject matter with which 35 U.S.C. 102(e) is concerned. Disclosures of other inventions in copending patents cannot negate first inventorship, and disclosures which are not constructively reduced to practice in copending patents cannot negate first inventorship because they do not constitute evidence that another was a prior inventor of the same invention. A disclosure of a mere concept does not constitute prior inventorship.

#### **Prior Art**

When a term of art is employed by many who are unskilled in the art and without assistance from the art-skilled, only confusion can develop. When the term has a generic as well as a specific meaning and is employed in the statute without definition in spite of the fact that it is variously defined in the very case law which is allegedly codified, the inevitable chaos can only be awaited.

Where the term was apparently employed for convenience in *Detrola v. Hazeltine* (1941) 313 U.S. 259, no record arguments could be found either in support or in derogation of the meaning accorded said term by this Honorable Court. There is no reason to suspect that the particular usage, which was not critical to the issues presented in the Detrola Case, was any more in the legislative intent which went into the

formulation and enactment of 35 U.S.C. 103 than the later usage by the Honorable Learned Hand [*Old Town Ribbon and Carbon Co., Inc. v. Columbia Ribbon and Carbon Mfg. Co., Inc. et al.* (C.A. 2, 1947) 159 F. 2d 379; *Conmar Products Corp. v. Universal Slide Fastener Co., Inc. et al.* (C.A. 2, 1949) 172 F. 2d 150]. The Honorable Judge Hand, in his latest decisions concerned with the point in question, made it unequivocally clear that copending patents are not prior art.

The CCPA has maintained that a patent issued on an applicant's copending application is not "prior art" [*In re Heinle* (CCPA, 1965) 145 USPQ 131.] This conclusion is difficult to understand if the Statute equates a patent (as of its filing date) with a publication of the same date. If an applicant publishes, he must file his application within one year after the date of publication to avoid a statutory bar; Heinle waited seven years before filing his continuation-in-part. It is submitted that a copending patent either is or is not "prior art", irrespective of who is the applicant thereof. The legal fiction with respect to copending patents arises because an applicant's own copending patent cannot negate first inventorship in the applicant. Since this is the only statutory justification for the use of a copending patent, fictions had to be devised when copending patents (of others) were employed other than to negate first inventorship. The "first inventorship" construction of Section 102(e) is wholly consistent with the established practice concerning an applicant's own copending patent. The exclusion of copending patents from "prior art" under Section 103 and the limitation thereof to the issues of first

inventorship are supported by the construction of the statute as a whole and avoids many of the fictions and complexities which are otherwise necessitated.

#### **The Development of the 1952 Act**

On January 10, 1950, Representative Joseph R. Bryson (M.C., Chairman, Subcommittee No. 4) presented a preliminary draft (Rep. Joseph R. Bryson, "Proposed Revision and Amendment of the PATENT LAWS," Preliminary Draft with Notes, Committee Print, U.S. Government Printing Office, Washington, D. C.) of a proposed bill for a general revision and codification of the patent laws. Section 22,<sup>1</sup> Section 23,<sup>2</sup>

<sup>1</sup> Conditions for patentability. Novelty and loss of right to patent

An invention shall not be considered new or capable of being patented if

(a) the invention was known or used by others in this country, or patented or described in any printed publication in this or any foreign country, before the invention thereof by the applicant for patent, or if

(b) the invention was patented or described in any printed publication in this or any foreign country or in public use or on public sale in this country, more than one year prior to the date of the application for patent in the United States, or if

(c) the invention is proved to have been abandoned, or if

(d) the invention was first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country.

<sup>2</sup> Conditions for patentability, lack of invention

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 22 of this title, if the differences between the subject matter sought to be patented and said material are such that the subject matter as a whole would be obvious to an ordinary person skilled in the art.

and Section 24<sup>a</sup> are of particular interest to the discussion at hand. The reference of Section 23 (a predecessor of 35 U.S.C. 103) to section 22 clearly did not include copending patents, which were separately provided for in Section 24. The distinct treatment is evidence that copending patents were not considered available with respect to the issue of presence or absence of "patentable invention". Section 103 of H.R. 9133<sup>a</sup> corresponds in general to section 23 of the preliminary draft.

The general part of the Committee Report (P. J. Federico, "Commentary on the New Patent Act", 35

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<sup>a</sup> Undisclosed prior knowledge or use

Whenever it appears that an applicant for patent, at the time of making his application, believed himself to be the original and first inventor of the thing patented, the same shall not be refused, or if granted, held to be void, solely on account of the invention having been known or used by some other person, before his invention thereof (without having been patented or described in a printed publication or in public use or on sale, as specified in section 22 a and b of this title), unless

- (a) it was disclosed or used in the United States by such other person in such manner that it had become available to the public, or described in a printed publication, before the date of the application for patent, or
- (b) it was described in a patent granted on an application filed in the United States before the invention thereof by the aforementioned applicant, or
- (c) it was patented in the United States.

<sup>4</sup> Conditions for patentability, nonobvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 102 of this title, if the differences between the subject matter sought to be patented and said material are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

U.S.C.A., Sec. 1-110, pp. 20 and 21) states with reference to section 103:

“. . . An invention which has been made, and is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was *known* before is not considered sufficiently great to warrant a patent. . . . Section 103 . . . refers to the difference between the subject matter sought to be patented and the prior art, meaning what was *known* before as described in Section 102. . . .” (Emphasis added.)

Mr. Federico continues to explain:

“. . . The newness, that is the difference over what was previously known, must be sufficient in character, or in quantity, or in quality, in order that the new thing may be patented. This requirement has commonly been referred to as the requirement for the presence of invention; when the requirement is not present, it is stated that the subject matter involved lacks inventions. The comparison is between the subject matter claimed to be patentable and what is disclosed or described in the *available* statutory prior art material, and it is irrelevant whether the claimant knew or did not know this prior art material. The inventor may indeed have made an invention in the psychological sense, but it would nevertheless not be patentable if the quantum of novelty over the prior art material of which he may have been in total ignorance was not sufficient. This requirement for invention with which we are here concerned is more of a legal concept than a psychological one. . . .” (Emphasis added.)

In *Stanley Works v. Rockwell Mfg. Co.* (C.A. 3, 1953) 203 F. 2d 846, the Court states that Section 103, which provides in effect that an invention which has

been made, and which is new in the sense that it has not been made before, may still not be patentable if the difference between the new thing and what was *known* before is not considered sufficiently great to warrant a patent, is merely a codification of decisional patent law. [See also *Joseph Bancroft & Sons Co. v. Brewster Finishing Co.* (D.N.J., 1953) 113 F. Supp. 714.]

The interpretation of what was *known* before should be consistent with the definition of "known" arrived at by the CCPA in *In re Schlittler et al.* (1956) 43 CCPA 986, 234 F. 2d 882. [This was modified on May 27, 1965, by the CCPA in *In re Borst*, 145 USPQ 554. (See also *In re Taub, Wendler and Slaters* (CCPA, 1965) 146 USPQ 384.)] It must be further appreciated that the issue of first inventorship is entirely different from that of patentability over references. The two should not be either confused or combined. 35 U.S.C. 103 applies only to the latter.

#### Combining Disclosures of Copending Patents

Whether disclosures of copending patents can be combined with other such disclosures or with disclosures from prior art cannot be considered in a vacuum. It is this fact, perhaps more than any other, which has contributed most to the difficulties of those who insist upon convenient generalities. For any disclosure in a copending patent to be available as of the patent's effective U. S. filing date, it must be constructively reduced to practice in the copending patent and it must, in the proposed combination, preclude first inventorship in subject matter defined by the claims of another.

There is a ground for rejecting claims of an applicant for U.S. Letters Patent which provides a good basis for understanding the issue at hand. This re-

jection is founded on the fact that the claims define only an old or exhausted combination. The Examiner usually follows such a rejection by an indication of novelty in a particular subcombination which should be claimed specifically if it constitutes the applicant's invention.

If, for example, an applicant claims an automobile with a specific novel carburetor capable of delivering 75 miles per gallon of regular gasoline, the Examiner can reject the claimed automobile as an old combination and suggest that the applicant direct his claims to the novel carburetor, if such is his invention. If the carburetor *per se* also lacks novelty, the applicant is not the first inventor of the claimed invention; he is neither the first inventor of the combination, i.e. the automobile, nor the first inventor of the subcombination, i.e. the carburetor. His first inventorship would be precluded whether said combination and/or said subcombination were constructively reduced to practice in one or a plurality of copending patents as long as any residue is either known or described in available publications.

It is this use of a copending patent, either by itself, in combination with another copending patent, or in combination with a publication which can preclude patentability. The preclusion is based solely on negating first inventorship. There is no real authority for using a copending patent for any other purpose.

#### **Conclusion**

Based on a review of every published decision since the Milburn Case and concerned with the status of copending patents for precluding patentability and in-

validating issued patents and based on a study of the briefs and records before the courts in presumably landmark cases which led to some of said decisions, copending patents are available to preclude patentability to a subsequent inventor of subject matter constructively reduced to practice therein. Copending patent disclosures cannot be combined with other disclosures except for the very limited purpose of precluding first inventorship of the invention claimed by another.

Copending patents are not "prior art" within the meaning of that expression in 35 U.S.C. 103. Section 103 defines the quantum of novelty of a new and distinct invention to warrant patentability thereof. First inventorship in a new and distinct invention cannot be negated by a copending patent which discloses only other inventions, no matter how closely related such other inventions may be. No logically consistent rationale to the contrary is found in any of the reviewed case law. The Statute, which is merely a codification of the case law, certainly does not alter these conclusions.

The instant rationale and preceding interpretation of the totality of case law and statute is wholly consistent with the virtually uncontroverted position that copending patents of the same inventor are *not* "prior art", with *reasoned* decisions and developments throughout the years since Milburn, with the latest holdings on the subject by the Honorable Learned Hand, the Circuit Court of Appeals judge who had by far the greatest understanding, appreciation and experience with respect to the issue, with the words of the Statute and the development thereof, and with the in-

tent clearly expressed by the Honorable United States Supreme Court in its Detrola decision.

For the foregoing reasons, amicus curiae submits that the judgment for the Court of Appeals should be reversed.

Respectfully submitted,

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September 1965

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IN THE  
**Supreme Court of The United States**  
OCTOBER TERM, 1965

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**No. 57**

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HAZELTINE RESEARCH, INC. and ROBERT REGIS,  
*Petitioners,*

vs.

EDWARD J. BRENNER,  
COMMISSIONER OF PATENTS,

*Respondent.*

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**PETITION FOR REHEARING**

*To the Honorable Chief Justice and the Associate Justices  
of the Supreme Court of the United States*

Pursuant to Rule 58, Your Petitioners, by their undersigned attorney, respectfully pray for rehearing and reconsideration of the Decision of this Honorable Court dated December 8, 1965 (— U.S. —) affirming the Judgments of the Courts below.

This Petition is based on the ground that this Court's Opinion is bottomed upon its view of what the law *should be* but is in derogation of Section 103 of the Patent Act of 1952 (Title 35, U.S. Code)\*, the most recent Congres-

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\* Hereinafter referred to as the "Act".

sional pronouncement of the relevant law. This is a new ground advanced by the Court *sua sponte* for affirming the Judgments of the Courts below and one which Petitioners have not had, but should have, an opportunity to refute.

Respondent, in the Courts below and here, rested its case principally on two contentions:

(a) The contention that, because a copending patent "negatives" or is "relevant to" patentability of a later filed application under Section 102(e) of the Act, it is therefore "relevant to patentability" under all other subsections of Section 102 and also under Section 103. This error in Respondent's reasoning is answered in the Reply Brief for Petitioners\*, pages 2-5.

(b) The erroneous contention that the invention defined by the Regis claims in issue represented an "insignificant advance" over the disclosure of the Wallace patent alone. The error in this contention is corrected at PRB, pp. 5-7. It is contrary to the express finding of the Trial Court:

"\* \* \* neither the Wallace et al patent, nor the Carlson patent alone anticipates the invention described in the claims in suit." (R. 70A)

The Court, in its Opinion, did not adopt either of these erroneous contentions of Respondent.

The Opinion of the District Court (R. 69A), affirmed by the Court of Appeals *per curiam* (R. 82), was based on essentially three *different* premises:

(a) An erroneous interpretation of *Detrola v. Hazelton* (1941) 313 U.S. 259 (R. 70A).

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\* The Reply Brief for Petitioners is hereinafter referred to as PRB—.

(b) The decisions of a number of Appellate Courts (R. 71A) holding contrary to the better reasoned authorities.

(c) A finding that the 1952 Patent Act did not change the law as enunciated by the Appellate Court decisions which it cited (R. 72A-74A).

This Court's Opinion did not adopt or refer to any of the foregoing bases of the District Court's Opinion.

On the other hand, the rationale of this Court's Opinion, as understood by Petitioners, is that, since the copending patentee Wallace filed his application in the Patent Office prior to Regis, the only reason that that patent was not a part of the public knowledge as of the time Regis made his invention was because of the time inevitably required by the Patent Office to process the Wallace application into a patent. The Court further reasoned that, as a matter of public policy, such a copending patent *should be* treated as though it were published as of the date when it was filed in the Patent Office.

Petitioners respectfully urge that the foregoing basis of the Court's Opinion is directly contrary to the express provisions of Section 103 of the Act, as set forth in detail below.

Petitioners heretofore have not had an opportunity to respond to this new ground for denying a patent to Regis and Petitioners should not be foreclosed from such opportunity.

**POINT 1. THIS COURT'S OPINION IS BOTTOMED UPON ITS VIEW OF WHAT THE LAW *SHOULD BE* BUT IS IN DEROGATION OF SECTION 103 OF THE PATENT ACT OF 1952 (Title 35, U.S. Code).**

In support of its rationale that a copending patent *should be* treated for all purposes as of its filing date, the

Court quotes from *Alexander Milburn v. Davis Bourneville* (1926) 270 U.S. 390:

“\* \* \* ‘The delays of the patent office ought not to cut down the effect of what has been done . . . [The first applicant] had taken steps that would make it public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached. We see no reason in the words or policy of the law for allowing [the second applicant] to profit by the delay . . .’ At p. 401.” (pp. 3-4)

In the *Alexander Milburn* case, the issue was *solely* whether a copending patent to one Clifford could be used to show that a later applicant, Whitford, was not the *first inventor* of a single invention disclosed by both parties. This Court emphasized that that was the only issue which it was deciding, saying:

“\* \* \* The fundamental rule we repeat is that the patentee must be the first inventor.” (p. 402)

When applied to the facts of that case, there can be no quarrel with the ruling in the *Alexander Milburn* decision.

However, this Court’s Opinion *extends* the ruling in *Alexander Milburn* to the case in which the copending patent (Wallace) *does not disclose the invention* claimed by the later applicant, but *only a part of it*. In order to meet the Regis claims, it becomes necessary to add to Wallace’s invention the invention of Carlson. This is not an insignificant addition, as evidenced by the grant of a patent on it to Carlson.

We are not here concerned with the question of whether such an extension of the ruling in the *Alexander Milburn* case would have been in consonance with the Patent Statutes at the time of that decision (1926). It is clear however, that such an *extension* of the rule of *Alexander*

*Milburn* is in *direct conflict* with Section 103 of the Act now in effect. Section 103 reads:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole *would have been obvious at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

(Emphasis added)

In this case, the "time the invention was made" is the filing of the Regis application in December, 1957. Inescapably, for the subject matter of the Regis application to have been obvious to the man skilled in the art in December, 1957, the knowledge (prior art) from which obviousness is determined must have been available to him and to other workers in the art. It is simply unrealistic to say that an invention would have been obvious to one skilled in the art in the light of subject matter held in secrecy in the Patent Office (Title 35, U.S. Code, Section 122) of which the skilled artisan *could not possibly have knowledge* and knowledge of which could not be imputed to him.

Thus, even though the Regis invention might have been obvious to one skilled in the art *after the Wallace patent issued in 1958*, *it could not have been obvious to the skilled artisan in 1957* when the Regis invention was made, and that is the test established by Section 103 of the Act.

The Court urges that the "basic reasoning" of the *Alexander Milburn* decision that a copending patent disclosing the complete invention of a later applicant *should be extended to apply to a situation in which the copending*

patent discloses only a part of the invention, quoting in support of this reasoning from *Alexander Milburn*:

“\* \* \* ‘The delays of the patent office ought not to cut down the effect of what has been done.’ P. 401.” (p. 4)

In the factual situation of the *Alexander Milburn* case, the “delays of the Patent Office” and the date of issuance of the copending patent did not in any way affect the fact or the date of the *prior invention* by the copending patentee, the *sole issue* decided in that case. The copending patent merely provided proof of the date and the nature of the *prior invention*—the delay in the Patent Office was immaterial. In recognition of this state of affairs, the *Alexander Milburn* decision was codified in Section 102(e).

On the other hand, when the critical fact is the extent of the knowledge of persons skilled in the art “*at the time the invention was made*”, the extent of such knowledge cannot be *retroactively* changed by adding to it at a later date, *nunc pro tunc*, secret knowledge that was in fact *not* available “*at the time the invention was made*”. It is unrealistic to attribute to one skilled in the art at a particular date knowledge that did not become available until a later date. Whether the delay in the transfer of the knowledge from the secret category to the public domain is due to delay in the Patent Office or to other causes is of no importance.

Petitioners have shown (Brief for Petitioners, pp. 21-25) that the extension of the *Alexander Milburn* decision effected by the Court’s Opinion, putting the information in a secret patent application in the same category as general public knowledge (prior art), violates straightforward logic; it violates the rules of simple fairness; and it serves no public interest. It is submitted that for these reasons such an extension of the *Alexander Milburn* rule *should not* be the law. Moreover, Congress has not seen fit to make it law. Section 103 of the Act, which is

controlling here, simply does not reach such an extension of the *Alexander Milburn* ruling for the reasons pointed out above.

**POINT 2. AN INVENTION MAINTAINED IN SECRECY IN A COPENDED PATENT APPLICATION IS ON ALL FOOURS WITH AN INVENTION INCORPORATED IN A SECRET PROCESS.**

There is another facet of the issue raised by this Petition and that is the relationship between an invention in a pending patent application held in secrecy *by the Patent Office* and an invention maintained in secrecy *by the owner*, often referred to as a secret process. No instance is known to Petitioners in which a secret process has been included in the prior art. At the hearing in this case, in response to a question from the Court, counsel for Respondent effectively conceded that a secret process is not a part of the prior art.

But the "delays of the Patent Office" referred to by Mr. Justice Holmes in the *Alexander Milburn* case, *supra*, in transferring secret information in a copending patent application to the public domain by issuance of the patent, are to a large extent within the control of an applicant for a patent and his attorney. It is a matter of common knowledge that there are various devices by which the pendency of a patent application has been, and may be, materially prolonged. One of the restraints upon such practice is the desire of the patent owner to issue the patent promptly and thus make it available as a part of the prior art to show obviousness of later inventions of competitors.

The ruling of the Court that the subject matter of such a pending application is within the prior art and is thus available to anticipate the invention of a competitor, no matter how long the issuance of the patent is delayed, destroys the restraint on prolonging the pendency of such an application. In fact, such a ruling creates an *inducement* to applicant to keep his application pending, and thus in

secrecy from his competitors, as long as possible, with the foreknowledge that he will not be prejudiced by such a prolonged pendency.

It is in the public interest that patents issue as promptly as possible, since their inventions go into the public domain seventeen years after issue. It is submitted that the ruling of the Court is contrary to public interest in encouraging the prolongation of the pendency of patent applications by applicants and their attorneys.

**POINT 3. BY THE ESTABLISHED RULES OF STATUTORY CONSTRUCTION, A COPENDING PATENT IS NOT EMBRACED IN THE PRIOR ART REFERRED TO IN SECTION 103.**

There is a cardinal principle of statutory construction which also precludes bringing copending patents, as of their filing date, within the purview of Section 103 of the Act. As the Court's Opinion states (p. 4), the relevance of copending patents, as decided in the *Alexander Milburn* case, was codified by Section 102(e) of the Act, which deals specifically and exclusively with copending patents. Section 103 on the other hand, is general in scope referring to various kinds of prior art, including prior patents, prior publications prior public uses, etc.

It has been consistently held that where a given situation is explicitly covered by a specific section of a statute, another section of the statute of general scope will not be construed to include that specific fact situation. Thus, in *Fourco Glass v. Transmirra Products* (1957) 353 U. S. 222, this Court stated the question presented:

"The question presented is whether 28 U.S.C. §1400 (b) is the sole and exclusive provision governing venue in patent infringement actions, or whether that section is supplemented by 28 U.S.C. §1391 (c)." (p. 222)

As the Court noted, Section 1400 of Title 28 is titled "Patents and Copyrights" while Section 1391 is titled "Venue Generally". In holding that general Section 1391 (c) did not apply to the specific type of action dealt with in Section 1400(b), this Court enunciated the rule:

"We think it is clear that §1391(c) is a general corporation venue statute, whereas §1400(b) is a special venue statute applicable, specifically, to *all* defendants in a particular type of actions, i.e., patent infringement actions. In these circumstances the law is settled that 'However inclusive may be the general language of a statute, it "will not be held to apply to a matter specifically dealt with in another part of the same enactment. \* \* \* Specific terms prevail over the general in the same or another statute which otherwise might be controlling,'" *Ginsberg & Sons v. Popkin*, 285 U. S. 204, 208.' *MacEvoy Co. v. United States*, 322 U. S. 102, 107.' (Emphasis Court's; pp. 228-229)

The ruling in the *Fourco Glass* case is squarely applicable here. Copending patents are "specifically dealt with" in Section 102(e) of the Act. Section 103 is a general section constituting "another part of the same enactment" (66 Stat. 797, 798). It is contrary to established statutory construction to extend general Section 103 to embrace the factual situation dealt with specifically in Section 102(e). As a consequence, a copending patent "specifically dealt with" in Section 102(e) cannot be carried over into the prior art referred to in general Section 103.\*

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\* While Section 103 does contain a reference to Section 102, it is only to the effect that even if the seven subsections of Section 102 do not bar the grant of a patent, still the inventor may not receive a patent if his invention was obvious as defined in Section 103. Section 103 *does not* refer to Section 102 for a definition of the "prior art".

**CONCLUSION**

For the reasons stated above, it is submitted that the Judgment of the District Court and the Judgment of the Court of Appeals should be vacated and the District Court ordered to enter a judgment pursuant to Title 35, U.S. Code, Section 145 authorizing the Commissioner of Patents to issue Letters Patent to Petitioners on the invention claimed in claims 1, 2 and 3 of the Regis application Serial No. 704,770, as prayed in the Complaint herein.

Respectfully,

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**CERTIFICATE**

I hereby certify that the foregoing Petition for Re-hearing is presented in good faith and not for delay.

LAURENCE B. DODDS

# SUPREME COURT OF THE UNITED STATES

No. 57.—OCTOBER TERM, 1965.

Hazeltine Research, Inc., et al., Petitioners, v. Edward J. Brenner, Commis- sioner of Patents.	On Writ of Certiorari to the United States Court of Appeals for the District of Colum- bia Circuit.
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[December 8, 1965.]

MR. JUSTICE BLACK delivered the opinion of the Court.

The sole question presented here is whether an application for patent pending in the Patent Office at the time a second application is filed constitutes part of the "prior art" as that term is used in 35 U. S. C. § 103, which reads in part:

"A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art . . . ."

The question arose in this way. On December 23, 1957, petitioner Robert Regis filed an application for a patent on a new and useful improvement on a microwave switch. On June 24, 1959, the Patent Examiner denied Regis' application on the ground that the invention was not one which was new or unobvious in light of the prior art and thus did not meet the standards set forth in § 103. The Examiner said that the invention was unpatentable because of the joint effect of the disclosures made by patents previously issued, one to Carlson (No. 2,491,644) and one to Wallace (No. 2,822,526). The Carlson patent had been issued on December 20, 1949, over eight years prior to Regis' appli-

cation, and that patent is admittedly a part of the prior art insofar as Regis' invention is concerned. The Wallace patent, however, was pending in the Patent Office when the Regis application was filed. The Wallace application had been pending since March 24, 1954, nearly three years and nine months before Regis filed his application and the Wallace patent was issued on February 4, 1958, 43 days after Regis filed his application.<sup>1</sup>

After the Patent Examiner refused to issue the patent, Regis appealed to the Patent Office Board of Appeals on the ground that the Wallace patent could not be properly considered a part of the prior art because it had been a "co-pending patent" and its disclosures were secret and not known to the public. The Board of Appeals rejected this argument and affirmed the decision of the Patent Examiner. Regis and Hazeltine, which had an interest as assignee, then instituted the present action in the District Court pursuant to 35 U. S. C. § 145 to compel the Commissioner to issue the patent. The District Court agreed with the Patent Office that the co-pending Wallace application was a part of the prior art and directed that the complaint be dismissed. 226 F. Supp. 459. On appeal the Court of Appeals affirmed *per curiam*. 340 F. 2d 786. We granted certiorari to decide the question of whether a co-pending application is included in the prior art, as that term is used in 35 U. S. C. § 103. 380 U. S. 960.

Petitioners' primary contention is that the term "prior art," as used in § 103, really means only art previously publicly known. In support of this position they refer to a statement in the legislative history which indicates that prior art means "what was known before as described

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<sup>1</sup> It is not disputed that Regis' alleged invention, as well as his application, were made after Wallace's application was filed. There is, therefore, no question of priority of invention before us.

in section 102."<sup>2</sup> They contend that the use of the word "known" indicates that Congress intended prior art to include only inventions or discoveries which were already publicly known at the time an invention was made.

If petitioners are correct in their interpretation of "prior art," then the Wallace invention, which was not publicly known at the time the Regis application was filed, would not be prior art with regard to Regis' invention. This is true because at the time Regis filed his application the Wallace invention, although pending in the Patent Office, had never been made public and the Patent Office was forbidden by statute from disclosing to the public, except in special circumstances, anything contained in the application.<sup>3</sup>

The Commissioner, relying chiefly on *Alexander Milburn Co. v. Davis-Bourbonville Co.*, 270 U. S. 390, contends that when a patent is issued, the disclosures contained in the patent become a part of the prior art as of the time the application was filed, not, as petitioners contend, at the time the patent is issued. In that case a patent was held invalid because, at the time it was applied for, there was already pending an application which completely and adequately described the invention. In holding that the issuance of a patent based on the first application barred the valid issuance of a patent based on the second application, Mr. Justice Holmes, speaking for the Court, said, "The delays of the patent office ought not to cut down the effect of

<sup>2</sup> H. R. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952).

<sup>3</sup> 35 U. S. C. § 122 states: "Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

what has been done . . . . [The first applicant] had taken steps that would make it public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached. We see no reason in the words or policy of the law for allowing [the second applicant] to profit by the delay . . . ." At p. 401.

In its revision of the patent laws in 1952, Congress showed its approval of the holding in *Milburn* by adopting 35 U. S. C. § 102 (e) which provides that a person shall be entitled to a patent unless "(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent." Petitioners suggest, however, that the question in this case is not answered by mere reference to § 102 (e), because in *Milburn*, which gave rise to that section, the co-pending applications described the same identical invention. But here the Regis invention is not precisely the same as that contained in the Wallace patent, but is only made obvious by the Wallace patent in light of the Carlson patent. We agree with the Commissioner that this distinction is without significance here. While we think petitioner's argument with regard to § 102 (e) is interesting, it provides no reason to depart from the plain holding and reasoning in the *Milburn* case. The basic reasoning upon which the Court decided the *Milburn* case applies equally as well here. When Wallace filed his application, he had done what he could to add his disclosures to the prior art. The rest was up to the Patent Office. Had the Patent Office acted faster, had it issued Wallace's patent two months earlier, there would have been no question here. As Justice Holmes said in *Milburn*, "The delays of the patent office ought not to cut down the effect of what has been done." P. 401.

To adopt the result contended for by petitioners would create an area where patents are awarded for unpatentable advances in the art. We see no reason to read into § 103 a restricted definition of "prior art" which would lower standards of patentability to such an extent that there might exist two patents where the Congress has plainly directed that there should be only one.

*Affirmed.*